



香港國際仲裁中心

Hong Kong International Arbitration Centre

.hk Domain Name Dispute Resolution

ARBITRATION PANEL DECISION

Complainant: Xerox Corporation

Respondent: Wang Bin Wei

Case Number: DHK-0700016

Contested Domain Name: <xerox.hk>

Panel Member: Dr Clive Trotman

1. Parties and Contested Domain Name

The Complainant is Xerox Corporation, 800 Long Ridge Road, Stamford, CT 06904, USA. The Complainant's representative is Eugene Ito Low, of Messrs Johnson Stokes & Master, 19/F Prince's Building, 10 Chater Road, Central, Hong Kong.

The Respondent is Wang Bin Wei, Guangdong 510660, the People's Republic of China.

The disputed domain name is <xerox.hk>.

2. Procedural History

A complaint in respect of the disputed domain name <xerox.hk> was filed with the Hong Kong International Arbitration Centre (HKIAC) and was received on 9 June, 2007. The Registrar, Hong Kong Domain Name Registration Company Ltd., was notified on the Complaint on 9 June, 2007. The Registrar confirmed the registrant to be Wang Bin Wei with the contact details given above.

The Respondent was notified of the Complaint by email on 26 June 2007. On 23 June 2007 the Respondent had claimed to the Complainant's representative that he had sold the domain name.

On 20 July 2007 the HKIAC declared that no formal Response to the Complaint had been received. On 16 August 2007 the Parties were notified that Dr Clive Trotman

has been appointed Panelist to hear the dispute and had filed a declaration of impartiality and independence.

On 20 August 2007 the Centre received a communication from the Respondent requesting that the language of the proceedings should be Chinese. On 21 August 2007 the Centre replied to the Respondent in English and Chinese pointing out that the language of the Registration Agreement was English.

On 22 August 2007 the Panel issued Procedural Order No. 1 to both Parties, inviting the Respondent to make submissions on the matter of language within five days (through the Centre) and inviting the Complainant to reply to any such submission within a further five days.

The Respondent replied on 23 August 2007 and the Complainant on 31 August 2007.

Paragraph 11 of the Rules of Procedure in part formulates the language of the arbitration proceedings as follows:

- (a) Unless otherwise agreed by the Parties, the language of the arbitration proceedings shall be the language of the Registration Agreement, subject always to the authority of the Arbitration Panel to determine otherwise, having regard to all the circumstances of the arbitration proceeding.

The Panel notes, among other considerations, that the English version of the registration agreement prevails over the Chinese version (clause 19.6 of the registration agreement); the Respondent has provided contact details in English but not the optional contact details in Chinese; previous correspondence to the Respondent in English has been replied to in English; the domain name has been parked on a predominantly English language website. The Panel finds no sufficient reason to depart from the principle enshrined in paragraph 11 of the Rules of Procedure that the language of the arbitral proceedings shall be, in this case, English, and the Panel so decides.

3. Factual Background

For the Complainant

According to the Complainant, Xerox Corporation, it owns eight trademark registrations for the name XEROX in Hong Kong, and numerous similar trademark registrations world-wide. The Xerox Corporation is well known in the field of photocopiers, document management technology and other goods and services. The scale of the Complainant group is that it operates in 160 locations worldwide (including Hong Kong) with a total of around 53,700 employees and in 2006 had revenue of US\$16 billion.

For the Respondent

No significant information has been provided by the Respondent.

4. Parties' Contentions

The Complainant

The Complainant contends that its operations in Hong Kong are conducted by its affiliated company, Fuji Xerox (Hong Kong) Limited, established in 1964 and formerly known as Rank Xerox (Hong Kong) Ltd and Xerox (Hong Kong) Limited. Fuji Xerox (Hong Kong) Limited is a leading provider of goods and services in knowledge and document management solutions in Hong Kong and now has more than 500 employees.

The Complainant contends that it has rights in the trademark XEROX on account of its registrations of the trademark in Hong Kong and world-wide, and under common law arising out of its extensive use and advertising of the trademark. Furthermore it owns of over 900 domain names incorporating the trademark, including "xerox.com", and "xerox.com.hk" (registered in 1997) through Fuji Xerox (Hong Kong) Limited.

The Complainant contends that the disputed domain name is identical or confusingly similar to its trademark and to the Complainant's domain names "xerox.com" and "xerox.com.hk".

The Complainant contends there is no reason why the Respondent may reasonably have any rights or legitimate interests in registering or using the disputed domain name. The disputed domain name is not the name of the Respondent and there is no evidence to suggest that the Respondent is commonly known by that name. There is no evidence of any use of or demonstrable preparations to use the disputed domain name or a corresponding name in connection with a *bona fide* offering of goods or services. Furthermore the domain name is parked with Sedo and has advertisement links to products related to those of the Complainant.

The Complainant contends that the mere incorporation of advertisements and advertising links does not constitute a legitimate use in connection with a *bona fide* offering of goods or services. The Complainant cites: *Hewlett-Packard Company v World Wide Web Home Player*, NAF Case No. FA 96267; *MSNBC Cable, LLC v. Tsys.com*, WIPO Case No. D2000-1204; *Computer Doctor Franchise Systems, Inc. v. The Computer Doctor*, NAF Case No. FA 95396; *Encyclopaedia Britannica, Inc. v Shedon.com*, WIPO Case No. D2000-0753; *ESPN, Inc. v. Danny Ballerini*, NAF Case No. FA 95410; *Multimatic, Inc v. Heinz Jakob/Effekta*, eResolution Case No. AF-0264.

The Complainant submits that the Respondent has registered and is using the disputed domain name in bad faith because the WHOIS search reveals that the Respondent has not given his or her full address and contact details for the registration record. This

demonstrates the Respondent's intention to evade being located. Furthermore, given the Complainant's substantial fame in Hong Kong and throughout the world, it is most unlikely that the Respondent is unaware of the Complainant's rights in the trademark. The Respondent has knowledge of the Complainant's rights in the trademark since on the Respondent's website on 27 February 2007 the trademark word "XEROX" was clearly depicted (the Complainant cites *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. D2000-0003).

It is contended that because the Respondent has made no legitimate use of the disputed domain name and must have been aware of the Complainant's rights in the trademark, both registration and use are in bad faith. The Respondent has registered the trademarked word "XEROX" as a domain name with the intention of confusing users into thinking the Respondent's website is related to or authorised by the Complainant. The Respondent was riding on the Complainant's goodwill in order to attract, for commercial gain, Internet users to the Respondent's website which contains merely advertisements and advertising links. The disputed domain name is parked with Sedo, such that Internet users who visit the website and select the displayed advertising links may generate revenue for the Respondent.

The Respondent's website also directed users to websites offering goods and services similar to and in competition with those of the Complainant, thereby damaging the Complainant's business.

The Respondent has offered the disputed domain name for sale for variously USD 5,000 or EUR 5,000, showing that the Respondent has registered it solely or primarily for sale at a profit.

A cease and desist letter was sent on 13 February 2007 by the Complainant's solicitors to the Respondent at the contact details revealed in the WHOIS search results. The Complainant's solicitors received an email reply on 19 February 2007 from the email address domainmylife@yahoo.com.cn. The email reply appears to deny ownership of the disputed domain name. The Complainant submits that this is an attempt by the Respondent to evade the Complaint.

The Complainant requests that the disputed domain name be transferred to the Complainant.

The Respondent

The Respondent has not submitted a formal Response.

5. Findings

According to Paragraph 4a of the HKDNR Domain Name Dispute Resolution Policy (the "Policy") which is applicable hereto, the Complainant has the burden of proving that:

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

(1). Identical/confusing similarity

The Complainant has submitted documentary evidence that it has rights in the trademark XEROX in Hong Kong.

The disputed domain name is <xerox.hk>. The domain designator “.hk”, being an inevitable part of the domain name, is of no consequence for the determination of confusing similarity. What remains is “xerox”, which is identical to the Complainant’s trademark. The Panel finds for the Complainant in respect of paragraph 4a(i) of the Policy.

(2). Rights or Legitimate Interests of Respondent

The Complainant must prove that the Respondent has no rights or legitimate interests in the domain name and the Complainant thereby has the task of proving a negative. As is conventional, the Complainant has made out a *prima facie* case by asserting that it has not granted the Respondent any right to use or legitimate interest in the disputed domain name and is unaware of any rights the Respondent could have, such as the Respondent being commonly known by that name or having made demonstrable preparations to use it in a *bona fide* manner. The onus is therefore upon the Respondent to establish relevant rights or legitimate interests. No Response has been received. The Panel finds no evidence in the terms of paragraph 4c of the Policy that the Respondent has used or made demonstrable preparations to use the domain name or a corresponding name in connection with a *bona fide* offering of goods or services; or been commonly known by the domain name; or made a legitimate noncommercial or fair use it. The Panel finds for the Complainant in terms of paragraph 4a(ii) of the Policy.

(3). Bad faith

The Complainant must prove that the disputed domain has been registered and is being used in bad faith. Four typical circumstances are exemplified in the Policy. The last is most pertinent to the present case:

- (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.

According to the evidence, supported by a screen print of the website to which the disputed domain name resolved on 27 February 2007, the website, under the prominent heading “XEROX.HK” provides links to other businesses in the sphere of office goods and services. The Complainant has stated that it has not authorised that use of its trademark by the Respondent. The reasonable conclusion is that the Respondent has set up the website in order to collect fees or commissions from the ultimate owners of links in return for referring Internet users to them, a device known as “click-through”. In other words, some Internet users who find their way to the Respondent’s website by mistake are likely to believe that it is endorsed by or connected with the Complainant, but are then delivered to competitors of the Complainant. The Respondent stands to collect revenue by riding on the goodwill of the Complainant. The Panel find this to be bad faith in terms of paragraphs 4b(iv) and thereby 4a(iii) of the Policy.

The circumstances listed in paragraph 4b of the Policy are without limitation and bad faith may be found alternatively. The holding of a domain name featuring a well known trademark in circumstances without plausible explanation is widely held to be, in and of itself, evidence of bad faith (*Guccio Gucci S.p.A. v. Mark O ‘Flynn*, WIPO Case No. D2001-0270; *The Caravan Club v. Mrgsale*, NAF Case No. FA 95314; *America Online Inc. v. Chinese ICQ Network*, WIPO Case No. D2000-0808; *Zwack Unicum Rt. v. Erica J. Duna*, WIPO Case No. D2000-0037; *Banca Sella S.p.A. v. Mr. Paolo Parente*, WIPO Case No. D2000-1157; *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163; *Comerica Inc. v. Horoshiy, Inc.*, WIPO Case No. D2004-0615; *Société des Hôtels Méridien v. LaPorte Holdings, Inc.*, WIPO Case No. D2004-0849). The Panel accepts that the trademark XEROX is world famous, and observes that it is a contrived and unique mark. The Panel finds ample evidence of bad faith in the Respondent’s appropriation of the trademark XEROX.

On 13 February 2007 the Complainant sent a cease and desist letter by email addressed to the Respondent. On 19 February 2007 a reply from the Respondent’s email address stated that the Complainant had not contacted the right person. An email from the Respondent’s address dated 23 June 2007 but with a cover sheet dated 6 July 2007, and evidently in reference to the dispute, named a purported new owner of the domain name and said the change of ownership happened “before you send me the first letter”, which in the light of the foregoing is taken to mean before 13 February 2007. The message implied some unexplained slowness by the Registrar to change the ownership and said that when “the HKDNR allows to change the owner, he will change it”. It is noted that according to paragraph 11.5 of the Registration Agreement between registrant and Registrar, a change of registrant is not recognised unless in compliance with clause 11 of the Agreement.

The Panel is not convinced by the Respondent's explanation of a delay in Registrar acceptance of a change of ownership, that would have amounted to four months, and notes that the Centre's request for Registrar verification was replied to in two days. The Panel is satisfied that the Centre and the Complainant acted properly in accordance with the Rules in naming the registrant of record as the Respondent and in sending communications to the contact details provided by the registrant. It may further be noted that on 11 June 2007 the domain name, whilst held in the name and address of the Respondent, was thereby locked by the Registrar and could not be transferred or deleted (until the conclusion of this proceeding). The Panel finds the totality of the Respondent's actions in respect of its identification to be an attempt to avoid the service of the cease and desist letter and the service of the Complaint, and to be evidence of bad faith ((*Ebay, Inc. v. Ebay4sex.com and Tony Caranci*, WIPO Case No. D2000-1632).

6. Conclusions

The Arbitration Panel finds the disputed domain name <xerox.hk> to be identical to the trademark XEROX in which the Complainant has rights. The Respondent does not have rights or legitimate interests in the disputed domain name. The disputed domain name was registered and is used in bad faith. In accordance with paragraph 4h of the Policy the domain name <xerox.hk> shall be transferred to the Complainant.

Dated 14 September 2007

Dr Clive Trotman