



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

**.hk Domain Name Dispute Resolution**

ARBITRATION PANEL DECISION

Complainant: Microsoft Corporation

Respondent: Wong Sai Chen

Case Number: DHK-0800034

Contested Domain Name: 微軟.HK / 微软.HK

Panel Member: Anthony Wu

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**1. Parties and Contested Domain Name**

The Complainant is Microsoft Corporation at One Microsoft Way, Redmond, Washington 98052-6399, USA. Its authorised representative is Baker & McKenzie (Attn: Nathan Lau) of 14th Floor, Hutchison House, 10 Harcourt Road, Hong Kong.

The Respondent is Wong Sai Chen and no address has been given at WHOIS database.

**2. Procedural History**

On 25/4/2008, the Hong Kong International Arbitration Centre (“HKIAC”) received a Complaint form in English filed by the Microsoft Corporation (the “Complainant”)

pursuant to the HKDNR Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Hong Kong Domain Name Registration Company Limited (HKDNC) on 30 November 2006, the HKDNR Domain Name Dispute Resolution Policy Rules of Procedure, approved by HKDNR on 30 November, 2004 (the Rules of Procedure) and the HKIAC Supplemental Rules.

The HKDNC was notified of the Complaint on 25/4/08 and on 29/4/08 it provided the name of the domain holder and the contact information for the domain. The domain was also put into Blacklist which means the domain could not be transferred or deleted during the period. It was however not possible to identify the language of the registration agreement the applicant selected.

On 30/5/08, HKIAC by email notified the Respondent of the Complaint and provided copy of the Complaint to the Respondent. The Respondent was asked to submit a Response to the Complaint within 15 business days from 30/5/08 to submit a Response to the Complaint. The Respondent filed his Response in Chinese on 9/6/08.

On 11/7/08, the HKIAC appointed Mr Anthony Wu to serve as Panelist and notified the parties of the appointment. All documents submitted by the parties were sent to the Panelist by letter dated 15/7/2008. The decision was to be rendered by 1 August 2008.

On the language of the proceedings, it falls to be considered under Rule 11 of the Rules of Procedure. I note that the Registrar was not able to confirm the language of the agreement. Having regard to all circumstances of the case, in particular that the Respondent was able to respond to the Complaint with no difficulty, I determine that the language of proceedings shall be in English.

### **3. Factual Background**

#### For the Complainant

The complainant is the largest provider of computer software and related products and services worldwide. Since its inception in 1975, the Complainant has created software and developed services for use in education, the workplace and the home. The Complainant's products and services include computer operating systems, client-server applications, computer and video games, business and consumer productivity applications, software programming tools, interactive media programs, Internet platform and development tools, computer input devices, online information and entertainment services, electronic commerce services and computer publications.

The Complainant's "MICROSOFT" name and mark is also universally known as "微軟" in traditional Chinese characters and "微软" in simplified Chinese characters (collectively, "the Chinese MICROSOFT Marks"). The Complainant has been using the Chinese MICROSOFT Marks since at least 1997 worldwide.

The Complainant has also registered the Chinese MICROSOFT Marks in China and Taiwan. The Complainant has spent substantial time, effort and money advertising and promoting the Chinese MICROSOFT Marks throughout the world. As a result, the Chinese MICROSOFT Marks have become distinctive and well known and the Complainant has developed an enormous amount of goodwill in the Marks.

According to the Complainant, the only known information on Respondent is from the WHOIS search, which lists the Respondent's name as "Wong Sai Chuen". The only available contact information on Respondent is the e-mail address "acl@easymailz.com". The Complainant had hired investigators in an attempt to contact the Respondent, but the e-mail address provided by the Respondent is not in operation. An online telephone directory search on 13 February 2008 on "Wong Sai Chuen" revealed 2 listings on the name. Attempts to call the numbers listed proved futile as the person(s) on the other end of the calls all hang up the lin

#### For the Respondent

The Respondent did not provide any of his background in his Response.

#### 4. Parties' Contentions

##### The Complainant

The Complainant's contentions are as follows:

##### *Identical/Confusingly Similar*

Through its registration and use of the Chinese MICROSOFT Marks as trade and service marks in Hong Kong, the Complainant has rights in the trade and service marks comprising the Chinese characters “微軟” and “微软”.

The Respondent's Domain Name consists of the Chinese characters “微軟 / 微软” with the top level domain extension “.hk”.

Courts and administrative panels have recognized that consumers expect to find a trademark owner on the Internet at a domain name address comprised of the company's name or mark. See *Panavision Int'l, L.P. v. Toepfen*, 141 F.3d 1316, 1326 (9th Cir. 1998) ("A customer who is unsure about a company's domain name will often guess that the domain name is also the company's name.... [A] domain name mirroring a corporate name may be a valuable corporate asset, as it facilitates communication with a customer base.") (internal citations omitted); see also *Dr. Michael Crichton v. Alberta Hot Rods*, WIPO Case No. D2002-0872, at § 6C (November 25, 2002).

7.8 When comparing a disputed domain name and a trade mark, the addition of the “.com” suffix is treated as a domain name indicator and has no bearing in determining whether the domain name is identical or confusingly similar to the trade mark. Rather, one looks at the second-level domain for such a determination, since the “.com” suffix is merely descriptive of the registry services and is not an identifier of a source of goods or services. See *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. D2002-1064, at § 6(b) (January 20, 2003). It is “generally accepted that the addition of “.com” does not take away the identity or confusing similarity” between the domain name and the complainant's trade and service marks.

See *Croatia Airlines d.d. v. Modern Empire Internet Ltd*, WIPO Case No. D2003-0455, at § 6A (August 21, 2003). Similarly in the present case, it is submitted the top level domain extension “.hk” should be disregarded when comparing the Domain Name to the Complainant’s Chinese MICROSOFT Marks.

7.9 From the above, it is submitted that the Respondent’s Domain Name is identical to the trade and service marks in which Complainant has rights.

### ***Rights or Legitimate Interests of the Respondent***

The Respondent is listed as “WONG SAI CHUEN”. The website at the Respondent’s Domain Name “www.微軟.hk” is inoperative. The Respondent is not a licensee of the Complainant nor in any way associated with the Complainant. Further, the Complainant has never authorised the Respondent to register and use the domain name “微軟.hk” or any other domain name.

In addition, the registration dates of the Complainant’s Chinese MICROSOFT Marks are all between 26 June 1995 and 19 July 1999, all predating the Respondent’s registration of the domain name on 26 July 2007 by many years.

From the above, it is submitted that the Respondent has no rights or legitimate interests in respect of the domain name. See e.g. *Edmunds.com, Inc. v Triple E Holdings Limited*, WIPO Case No. D2006-1095. at § 6B (October 17, 2006).

Further, the Respondent's misappropriation of the Domain Name was no coincidence. Where a mark is an invented mark, as in the instant case, it is "not one traders would legitimately choose unless seeking to create an impression of an association" with the complainant. See *Telstra Corp. Ltd v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, at § 7.2 (February 18, 2000). See also *Outblaze Limited v. Wah Cheung Leatherware Company Limited*, HKIAC Case No. 0106-0001, at § 5B.

### ***Bad Faith***

The Complainant contents as follows:-

#### Domain Name Registered in Bad Faith

The Respondent's act in registering the Domain Name is, in itself, suggestive of bad faith as the Respondent appears to be resident in Hong Kong where the Complainant has an established business presence and an established goodwill for the Chinese MICROSOFT Marks as trade marks and trade names. The Respondent would thus have been aware of the established goodwill for the Chinese MICROSOFT Marks at the time when he registered the domain name.

In addition, the only contact details provided by the Respondent, an e-mail address, is not in operation. In addition, calls to the telephone directory listings on "WONG SAI CHUEN" were futile (see paragraph 7.4 above). It is submitted that these were deliberate steps taken by the Respondent to ensure that he cannot be reached.

The following passage from *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. D2000-00003 (Exhibit 11) is instructive:

"Has the Complainant proved that the domain name "has been registered in bad faith" by the Respondent? In light of the facts established in paragraphs 4.6 to 4.8, the Administrative Panel finds that the Respondent does not conduct any legitimate commercial or non-commercial business activity in Australia. In light of the facts established in paragraphs 4.6 to 4.8, the Administrative Panel further finds that the Respondent has taken deliberate steps to ensure that its true identity cannot be determined and communication with it cannot be made. Given the Complainant's various trademark registrations for, and its wide reputation in, the word <TELSTRA>, as evidenced by the facts established in paragraphs 4.2 to 4.5, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of this fact at the time of registration. These findings, together with the finding in paragraph 7.2 that the Respondent has no rights or interests in the domain name, lead the Administrative Panel to conclude that the domain name <telstra.org> has been registered by the Respondent in bad faith."

It is submitted that similarly in the present case, the Respondent has registered the domain name in bad faith.

A WHOIS search at the HKDNR website [www.hkdnr.hk](http://www.hkdnr.hk) based on the Respondent's name revealed that the Respondent owns several other domain names, including "GOOGLEE.HK" and "交易所.HK" [which is the commonly used Chinese term for "Stock Exchange"]. The registration of the domain name "GOOGLEE.HK" is a prototypical case of typo-squatting (also called URL hijacking) of the domain name "GOOGLE.HK". The website relating to "GOOGLE.HK", i.e. [www.google.hk](http://www.google.hk), is owned and operated by the Internet search engine corporation Google, Inc. Typo-squatting has been universally condemned in numerous WIPO UDRP decisions and administrative panels have no difficulty in finding bad faith on the part of the respondents in such cases. See e.g. *Edmunds.com, Inc. v Triple E Holdings Limited*, WIPO Case No. D2006-1095 at §6C, (October 17, 2006) (Exhibit 10). It is submitted that the domain name registrations under the Respondent's name in the present case (including "微軟.HK", "GOOGLEE.HK" and "交易所.HK") all point to the Respondent being a serial cyber- and typo-squatter, and is evidence of the Respondent's bad faith in registering the domain name "微軟.HK".

#### Domain Name is being Used in Bad Faith

The website at the Respondent's Domain Name is inoperative. The concept of a domain name "being used in bad faith" is not limited to positive action; inactions within the concept. See *Telstra Corporation Limited v Nuclear Marshmallows*, WIPO Case No. D2000-00003 at §7.9 (Exhibit 11). The Complainant referred to the following passage from Telstra:

"The Administrative Panel has considered whether, in the circumstances of this particular Complaint, the passive holding of the domain name by the Respondent amounts to the Respondent acting in bad faith. It concludes that it does. The particular circumstances of this case which led to this conclusion are:

- (i) the Complainant's trademark has a strong reputation and is widely known, as evidenced by its substantial use in Australia and other countries;
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name;
- (iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered name;
- (iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement; and
- (v) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law."

Telstra has been cited with approval in *Outblaze Limited v Wah Cheung Leatherware Company Limited*, at § 5C.

7.21 Similarly in the present case,

- (i) the Complainant's Chinese MICROSOFT trademarks have a strong reputation and is widely known, as evidenced by its substantial use in Hong Kong and other countries;
- (ii) it is very unlikely that the Respondent will be providing any evidence whatsoever of any actual or contemplated good faith use by him of the domain name;
- (iii) the Respondent has actively provided, and failed to correct, false contact details, in breach of clauses 3.6(e) and 8.2 the registration agreement; and

(iv) it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate.

The Complainant submitted that in the circumstances the domain name is being used in bad faith by the Respondent.

### The Respondent

The Respondent responded in paragraph 5 of the Response as follows:

1. The disputed domain name did not include any information related to the Complainant, and the Respondent had no intention to mislead internet users to believe that the content and the products or service referred to in connected website were provided by the Complainant.
2. What the Respondent had registered was .hk, a personal domain name and not .com.hk, which is for commercial domain names. The Respondent did not intend to interfere with the Complainants commercial activities.
3. The disputed domain name is for personal use and not for profit making commercial use.
4. That, according to his understanding, if the Complainant considered that they had rights over the disputed domain name, they should have registered it within the priority period of registration by trade mark holders. As the Complainant gave up the priority right to register as a trade mark holder, this caused the Respondent to believe that the disputed domain name would not infringe the trade mark of the Complainant.

Further, at paragraph 11 of the Response, the Complainant submitted in gist that the Respondent has not used the domain name after registration because presently the internet users are not enthusiastic in using Chinese domain names, this is so even for the commonly known .com. He thought that it would take 3 to 5 years before Chinese domain names would be popular and had therefore registered the Disputed Domain

Name for 5 years to await Chinese domain name becoming popular before developing it.

## **5. Findings**

According to Paragraph 4(a) 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 Panel finds that the Complainant has rights in the Chinese characters 微軟 in Hong Kong by virtue of the registration of trademark of “微軟” in 1995 in a range of goods and services as referred to above. The Panel also accepts that the Complainant has been using the Chinese marks since 1997 in Hong Kong and elsewhere, and has rights by virtue of usage as well.

The Panel accepts the contention that the top level domain extension should be discarded when comparing the disputed domain name with the Complainant's Chinese Marks. When so compared, they are clearly identical. In addition, the panel finds that the whole of the domain name is confusingly similar to the Complainant's Chinese Marks.

The Panel is satisfied that the requirements of Paragraph 4(a)(i) are met with.

**(2). Rights or Legitimate Interests of Respondent**

Paragraph 4(c) of the Policy requires the Complainant to prove that the Respondent has no right or legitimate interest in the disputed domain name. However, it is consensus view among Panelists that if the Complainant makes out a prima facie case that the Respondent has no rights or legitimate interests, and the 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. See *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties*, Case No. D2005-1085.

The Panel finds that the Respondent is not a licensee of the Complainant nor in any way associated with the Complainant. The Complainant has never authorised the Respondent to register and use the disputed domain name or any other domain name. The Complainant's Chinese Mark is a very famous mark and has been used in Hong Kong and elsewhere since 1997, which is well before the registration of the disputed domain name on 26 July 2007. The Panel is of the view that a prima facie case is established and it is for the Respondent to prove that he has rights or legitimate interests to the Disputed Domain Name, by proving the following circumstances set out in Para 4.c of the Policy, or otherwise:

- “(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 make any substantive response to establish any of the above circumstances or other circumstances. The Panel finds that the Complainant has

satisfied the requirement of Para 4(a)(ii) of the Policy that the Respondent did not have rights or legitimate interest in the Disputed Domain Name.

**(3). Bad faith**

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

“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 an Arbitration 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.”

The circumstances are however not exclusive as the circumstances are refers to “in particular without limitation”.

The Panel accepts the reasoning in the Telstra Corporation referred to above that “has been registered” and “being used in bad faith” under paragraph 4(a)(iii) of the Policy are different aspects of bad faith that has to be proved.

Having regard to the following circumstances, the Panel finds the registration of the disputed domain name has been in bad faith:

1. The Complainant’s Chinese mark is well known and extensively used well before the registration of the domain name;
2. The Respondent is fully aware of the Complainant’s Chinese mark at the time of registration of the disputed domain name.
3. The Respondent did not have any legitimate interest in the disputed domain name;
4. The Respondent has not been disclosing his address or other contact information saves and except the email address.

On the use in bad faith, the Panel also accepts the reasoning in Teltra Corporation that inaction (passive holding) could, in appropriate circumstances, apart from the circumstances set out in paragraph 4(b), amount to using domain name in bad faith. Having regard to facts set out in the preceding Paragraph hereof, and the following facts, the Panel finds that the Respondent is using the disputed domain name in bad faith:

1. The Respondent did not intend to use the domain name in the next few years;
2. taking into account all the circumstances in the case, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would no not be illegitimate, such as by being a passing off or an infringement of the Complainant’s right under the trademark law.

Regarding the Respondent’s response, it is suffice to say that nothing said by the Respondent detract the Panel from his findings.

Having regard to the above, the Panel is satisfied that the requirements under Paragraph 4(a)(iii) are met with.

## **6. Conclusions**

It is the finding of the Panel that all requirements of paragraph 4(a) are proved by the Complainant. In paragraph 8 of the Complaint, Complainant sought to have the domain name in question transferred to it. Having regard to circumstances of the case, the Panel believes that it is appropriate to transfer the domain name 微軟.HK / 微軟.HK to Complainant and so orders.

Dated 1/8/08

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(Anthony Wu)

In Hong Kong