



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

ADMINISTRATIVE PANEL DECISION

Case No. DHK-0800039

Complainant: Chow Pui Sze

Respondent: Sublime Technology Limited

Disputed domain name: <szectattoo.com.hk>

Registrar: Hong Kong Domain Name Registration Company Limited

1. Procedural History

The Complainant of this case is Miss Chow Pui Sze, its address is at 1/F, 170 Wellington Street, Kau U Fong, Central, Hong Kong. The authorized representative of the Complainant in the proceedings is Mr. David Ma of Woo Kwan Lee & Lo, contact address is at 2801, Sun Hung Kai Centre, 30 Harbour Road, Wanchai, Hong Kong.

The Respondent is a company called Sublime Technology Limited, contact name is Mr. Tony Lentino, contact address is at Room 211, Wellbourne Commercial Centre, 8 Java Road, North Point, Hong Kong.

The disputed domain name is <szectattoo.com.hk>. The registrar of the disputed domain name is Hong Kong Domain Name Registration Company Limited.

A complaint made 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 in respect of the above domain name, was filed with HKIAC dated 18 December 2008 in the prescribed form, received by HKIAC on the same day.

The HKIAC notified the Registrar of the Disputed Domain Name of the proceedings by email on 18 December 2008.

The Complaint was served upon the Respondent by the HKIAC by email on 30 December 2008 to the address, domains@asiaregistry.com provided by the Respondent as his contact email, according to the Complainant's WHOIS search as well as the Registrar of the Disputed Domain Name.

This constitute valid service of these proceedings upon the Respondent.

No Response was filed with the HKIAC within the allotted time. The Panel, Dr. Timothy Sze, was appointed on 24 January 2009, with the papers being delivered to the Panelist on the same day. In accordance with the HKDNR, the Panelist shall render the decision by 16 February 2009. The Panelist notified the HKIAC for a revised date, 2 March 2009 for rendering the decision owing to the Panelist has to undergo an urgent surgery.

Pursuant to the Rules, the Panel determines English as the language of the proceedings.

2. Factual Background

For the Complainant

The Complainant in this case is Miss Chow Pui Sze, its address is at 1/F, 170 Wellington Street, Kau U Fong, Central, Hong Kong. The authorized representative of the Complainant in the proceedings is Mr. David Ma of Woo Kwan Lee & Lo, contact address is at 2801, Sun Hung Kai Centre, 30 Harbour Road, Wanchai, Hong Kong.

The Complainant has been operating a tattoo business as a sole proprietor, trading under the name of Sze. C Tattoo since around 2003. "Sze. C" is the short form of Sze Chow and is derived from the name of the Complainant, Chow Pui Sze. The Complainant has since the same time as the commencement of her business been using this trade name as her email addresses, being szectattoo@hotmail.com and szectattoo@yahoo.com.hk.

For the Respondent

The Respondent is a company called Sublime Technology Limited, contact name is Mr. Tony Lentino, contact address is at Room 211, Wellbourne Commercial Centre, 8 Java Road, North Point, Hong Kong, the current registrant of the disputed domain name <szectatto.com.hk> according to the Whois information.

3. Parties' Contentions

The Complainant

The dispute resolution in relation to domain <www.szectattoo.com>

In the process of filing a dispute against the domain <www.szectattoo.com>, The Complainant found out that the subject domain <www.szectattoo.com.hk> has been registered in January 2008 and is automatically redirected to the domain <www.szectattoo.com>.

The dispute in relation to the domain <www.szeptattoo.com> has been decided in favour of the Complainant on 4 December 2008.

The Complainant could not ascertain the relationship between Mr Evangelo Costadimas (“EC”, the respondent in the dispute in relation to <www.szeptattoo.com>) and the Respondent. The auto-redirection from <www.szeptattoo.com.hk> to <www.szeptattoo.com> suggests a connection. In any case, the domain <www.szeptattoo.com.hk> should be transferred to the Complainant, whether assessed in isolation or in conjunction with the dispute in relation to <www.szeptattoo.com>.

The confusion between <www.szeptattoo.com>, <www.szeptattoo.com.hk> and <www.szeptattoo.hk>

The Complainant actively marketed the domain <www.szeptattoo.com>:-

- on business cards,
- in emails,
- in advertisements, and
- in work samples for clients.

and upon the complication posted by EC and the domain <www.szeptattoo.com>, the Complainant actively marketed the new domain <www.szeptattoo.hk>:-

- in new business cards,
- in advertisements in the Hong Kong Magazine and hk.88db.com, and
- in personal emails to her clients.

The existence of both the domain <www.szeptattoo.com.hk> and <www.szeptattoo.hk> is certainly confusing, as existing and potential clients may confuse the suffix “.com.hk” and “.hk” easily.

The content of the domain

Since around May 2008, the Complainant found out that various contents has been put on the domain <www.szeptattoo.com> (which is the auto-redirected link from <www.szeptattoo.com.hk>), including links to other tattoo studios (no printout available as the Complainant was not contemplating the institution of the domain name dispute resolution procedures at that time) and different photos of the Complainant accompanied by suggestive wordings, updated from time to time. These contents cause confusion to the existing and potential customers of the Complainant and adversely affect the business of the Complainant. The Complainant is almost certain that EC has provided the content to the domain <www.szeptattoo.com>, as the same photo put on the domain was also found on the personal blog of EC.

The contents on the domain include the following:

- 1) there is a “disclaimer” on the front page stating that the content of the

domain is fictional and not intended to defame. Notwithstanding the disclaimer, visitors to the domain (because of the Domain Name being <www.szectattoo.com.hk>) may be misled into thinking that the Complainant provided such “fictional content” to the domain;

- 2) there is a “tattoo counter” which purportedly records the numbers of tattoos that the Complainant has given to clients during certain periods. Visitors to the domain will be misled into thinking that the content of the domain was provided by a tattoo artist, in particular (because of the Domain Name being <www.szectattoo.com.hk>) the Complainant;
- 3) an article “fly fly little wing” is posted on the domain which contains a pencil sketch and a photograph of a tattoo, both of which are original work created by the Complainant. The issue of copyright is not discussed as this is not the appropriate forum. The sketch and the photograph would mislead visitors to the domain into thinking that the content of the domain was provided by a tattoo artist, in particular (because of the Domain Name being <www.szectattoo.com.hk>) the Complainant;
- 4) there are links of “*click here to send me email*” and “*click here to contact me*” (previously “*comments*” and “*email*”) which redirect to the email address “szectattoo@gmail.com”. The Complainant is unrelated to and does not have access to this email address. The Complainant believes that the Respondent is in control of this email address. An acquaintance of the Complainant recently informed the Complainant that he has sent an email to this email address and received very rude responses;
- 5) the domain name itself being identical to the business name of the Complainant, and the foregoing analysis in (1) to (3) shows that the content of the domain was calculated to mislead visitors to the domain to think that the domain was operated by the Complainant. It is reasonable to estimate that many existing and potential clients have come across the domain, attempted to contact the Complainant, and were driven away by rude responses;
- 6) all of the above further supports that the Respondent is using the Domain Name to misleadingly divert consumers of, to tarnish the trade mark of, and to disrupt the business of the Complainant, with no rights or legitimate interests in the Domain Name and in bad faith.

Notwithstanding the decision made by the Asian Domain Name Dispute Resolution Centre (Hong Kong Office) in relation to <www.szectattoo.com>, the above contents are still available on both <www.szectattoo.com> and <www.szectattoo.com.hk> to date.

The Complaint

The Complainant now makes a complaint under Para 4(a) of the Policy as follows:-

(i) “The Domain Name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights”

As stated in Paragraph 7 above, the Complainant has been carrying on a trade with the trade name Sze. C Tattoo. The domain <www.szectattoo.com.hk> (“Domain Name”) is identical or similar to the service mark Sze. C Tattoo in Hong Kong in which the Complainant has carried business and accordingly has the rights to.

(ii) “The Respondent has no rights or legitimate interests in respect of the Domain Name”

The Complainant submits that Respondent has no rights or legitimate interests in the Domain Name.

The Complainant refers to Para 4(c) of the Policy and submits as follows:-

(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”*

The Respondent has never used or prepared to use the Domain Name or a name corresponding the Domain Name in connection with a bona fide offering of goods or services in Hong Kong.

(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”*

The Respondent has never been commonly known by the Domain Name.

(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 was not making any legitimate non-commercial or fair use of the Domain Name. Its act was calculated to misleadingly divert consumers or to tarnish the mark of the Complainant.

In any case, the Complainant only has to show any of (i) to (iii) above or establishes in general that the registrant has no rights to or legitimate interests in the Domain Name.

(iii) “The domain name has been registered and is being used in bad faith”

The Complainant submits that the Respondent has registered the Domain Name and has been acting in bad faith and using the Domain Name to cause damage to the Complainant and her business.

The Complainant refers to Para 4(b) of the Policy and submits that the Respondent:-

- (i) *“had registered or 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”*

The Respondent does not have the authority to hold the Domain Name. The Respondent has not offered to sell or rent the Domain Name to the Complainant. However, on the internet, a complaint in the District Court of Arizona named the Respondent as defendant for, amongst other things, cybersquatting of domain names <isagenix.com.hk> and <isagenix.hk>. It could not be ascertained whether the complaint was actually filed in the District Court of Arizona, but a search shows that the subject domain has been transferred to Isagenix Holdings (Asia Pacific) Limited.

- (ii) *“had 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”*

The Respondent has been using the Domain Name so that the Complainant is not able to reflect her trade mark in the Domain Name.

A further search also shows that the Respondent holds a total of 266 domains. The actual domain names are not available but it could be taken to imply that the Respondent conducts a cybersquatting practice and has engaged in “a pattern of such conduct”.

- (iii) *“you have registered the Domain Name primarily for the purpose of disrupting the business of a competitor”*

As could be seen from the evidence, the Respondent is using the Domain Name to disrupt the business of the Complainant, although the Complainant is not a competitor of the Respondent.

- (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”*

Although the Respondent derives no commercial gain from using the Domain Name, it is apparent that the Respondent is using the Domain Name to create a likelihood of confusion with the Complainant's mark, by linking the domain to other tattoo studios and also creating contents which do not manifestly relate to the services of the Complainant.

In any case, the Complainant only has to show any of (i) to (iv) above or establishes in general that the registrant has no rights to or legitimate interests in the Domain Name.

The Respondent

No Response was filed.

4. Findings

Discussion and Findings

According to Article 4(a) of the Policy which is applicable hereto, the Complainant has the burden of proving that:

- (i) the Disputed Domain is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interest;
- (ii) the Disputed Domain name holder has no right or legitimate interest in respect of the domain name or major part of the domain name; and
- (iii) the Disputed Domain name holder has registered or is being used the domain name in bad faith.

1. Identical/confusing similarity

The Panelist has examined all the evidence and documents submitted by the Complainant. The evidence submitted by the Complainant shows that the Complainant has been operating a tattoo business under the name of Sze. C Tattoo since around 2003. The consideration of the Panelist is whether the Complainant has sufficiently alleged the existence of common law trademark rights in her complaint. Although the registering of the business take place in September 2008, the Complainant has been continuously using the name of Sze. C Tattoo to promote her business dated back in 2003. The Disputed Domain is identical to the Complainant's name, but for the necessary addition of ".com.hk". The Panel adopts the arguments in *Croatia Airlines d.d. v. Modern Empire Internet Ltd.* (WIPO D2003-0455), and finds the Complainant has satisfied the first condition under Article 4(a)(i) of the Policy.

2. Rights or Legitimate Interests of Respondent

The Complainant has alleged that the Respondent has no right or legitimate interest in respect of the Disputed Domain. The evidence shows the Disputed Domain has been automatically redirected to <szectattoo.com>, another disputed domain name decided in favour of the same Complainant on 4 December, 2008 (ADNDRC DHK-0800214). Clearly the Complainant does have a legitimate interest in the name and mark "Sze. C Tattoo".

Accordingly, the Panel finds that the Complainant has satisfied the second condition under Article 4(a)(ii) of the Policy. The first condition is also satisfied as the complainant has civil rights or interests in the name "Sze. C Tattoo".

3. Bad faith

The Panel finds that the evidence is sufficiently established that the Respondent is aware of the existence of the Complainant and her trademark for the business, especially in the circumstances of his redirection of the Disputed Domain to <szectattoo.com>, at the time of registering the Disputed Domain. The action of registering the disputed domain name constituted bad faith. The registration of the disputed domain name has effectively prevented the Complainant from reflecting her trademark in a corresponding domain name.

In conclusion, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith. Accordingly, the Panel finds that the Complaint satisfies the condition provided under Article 4(a)(iii) of the Policy.

5. Decision

Based on the above analysis, the Panel decides that:

- (1) the Disputed Domain is identical to the Complainant's name and trade mark in which the Complainant has civil rights and interests;
- (2) the Respondent has no right or legitimate interest in respect of the Disputed Domain; and
- (3) the Respondent registered the domain name in bad faith.

Accordingly, pursuant to all three elements required under the HKDNR Policy, and at the Complainant's request, the Panel decides that the Disputed Domain <szectatto.com.hk> should be transferred to the Complainant.

Sole Panelist: Dr. Timothy Sze

Dated: 1 March, 2009