



香港國際仲裁中心

Hong Kong International Arbitration Centre

Hong Kong International Arbitration Center

Administrative Panel Decision

Case No. DHK-0900042

Complainant : AXA SA

Respondent : RELAX 2 PLANNING (HK) LIMITED

Domain Name : www.axa.hk

Registrar : Hong Kong Domain Name Registration Company Ltd.

1、 Procedural History

On 3 February 2009, the Complainant submitted a Complaint in the English language to the Hong Kong International Arbitration Center (HKIAC) and elected this case to be dealt with by a one-person panel, in accordance with the Hong Kong Domain Name Registration Company Limited (HKDNR) Domain Name Dispute Resolution Policy (the Policy), the HKDNR Domain Name Dispute Resolution Policy Rules of Procedure (the Rules) and the HKIAC Supplemental Rules (the HKIAC Supplemental Rules). On 6 February 2009, the HKIAC confirmed the receipt of the Complaint.

On 6 February 2009, the HKIAC notified the Registrar of the Disputed Domain of the proceedings by email. On the same date, the Registrar acknowledged this notification by email confirming its registration of the Disputed Domain and including its WHOIS information.

The Complaint was served upon the Respondent by the HKIAC by email on 6 February 2009. In accordance with the Rules, the Respondent shall submit a Response within fifteen business days. The Respondent submitted a Response on 7 March 2009. The Complainant submitted a Comment to the Response on 9 March 2009. The HKIAC confirmed receipt of the above two documents on 10 March 2009.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the HKIAC notified the parties on 12 March 2009 that the Panel in this case had been selected, with Dr ZHAO Yun acting as the sole panelist. The Panel should render the Decision within on or before 26 March 2009.

The language of the proceeding is English, as being the language of the Domain Name Registration Agreement, pursuant to Paragraph 11(a) of the Rules, and also in consideration of the fact that there is no express agreement to the contrary by the Parties.

2、 Factual Background

For the Complainant

The Complainant in this case is AXA SA, a corporation registered in France. The registration address is 25 avenue Matignon, 75008 PARIS, FRANCE.

For the Respondent

The respondent, RELAX 2 PLANNING (HK) LIMITED, is the current registrant of the disputed domain name <axa.hk> according to the Whois information.

3、 Parties' Contentions

Complainant

The Complainant is the holding company of the AXA Group, whose main business is in the field of insurances and financial services. The group is widely known under the trade name AXA. The AXA Group has numerous subsidiaries in many countries around the world and the Complainant enjoys nowadays a worldwide reputation. In Hong Kong, the Complainant is one of the top general insurers with over 170 years of experience in Asia, and AXA's annual turnover of 2007 amounted to HK\$ 723 million. The AXA Group is also famous for its numerous activities in services like finance, real estate, telecommunications or insurance proposed both to individuals and to business companies. The Complainant is the owners of the trademark AXA in Hong Kong and in Asia-Pacific. The trademark, registered all over the world and containing the word AXA, are prior to the registration of the disputed domain name on 20 February 2006, and are widely used by the Complainant and its licensees notably in connection with classes 35, 36 and 38 of the international classification, i.e. insurance services, financial services and telecommunications services. The Complainant and its subsidiaries or licensees are also, among others, the owner of many domain names using AXA, which are all prior to the registration of the disputed domain name.

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The disputed domain name wholly incorporates the Complainant's distinctive trademark AXA, which has no particular meaning and is therefore highly distinctive, and as such creates sufficient similarity to be confusingly similar according to the Policy. In this respect, numerous panel decisions hold that confusing similarity is established when a domain name wholly incorporates a Complainant's trademark in its entirety. In addition, it must be underlined that the likelihood of confusion is also ascertained because of the notoriety of the Complainant and its trademark.

2. The Respondent has no rights or legitimate interests in respect of the domain name

Obviously, the Respondent does not have any legitimate interest in respect of the domain name. Firstly, it is crystal clear that the registrant does not have any legitimate

interest in using the disputed domain name since the name “RELAX 2 PLANNING (HK) LIMITED” has not any resemblance with the word AXA. According to the Respondent’s name history, its prior company name was “AMAS FINANCIAL PLANNING LIMITED”, which does not review any relationship with the word “AXA” directly or indirectly in any form. The Respondent has consequently neither prior right nor legitimate interest to justify the use of the already well-known and worldwide trademark AXA. Secondly, the Complainant has never licensed or otherwise permitted the Respondent to use its trademark or to register any domain name containing the above mentioned trademark. Therefore, there is no relationship whatsoever between the Complainant and the Respondent. The Respondent has clearly adopted the Complainant’s trademark and domain name for its own use and incorporated them into his domain name without the Complainant’s authorization. Under these circumstances, the absence of any permission by the Complainant’s trademarks proves that the Respondent has no right or legitimate interest in respect of the disputed domain name.

3. The domain name was registered and is being used in bad faith

The domain name has been registered in bad faith. The domain name has been registered for the purpose of attracting Internet users to the Respondent’s web site, by reproducing the AXA trademark and creating a likelihood of confusion between the AXA’s trademark and domain name. It is obvious that the Respondent has registered the domain name being aware of the Complainant’s rights. Indeed, it must be reminded that AXA Group is the owner of AXA trademark which is worldwide well-known and numerous domain names using the term AXA. The Respondent’s knowledge is also proved by the fact that he is acting in the same field of AXA Group, i.e. financial services. Under these circumstances, it is inconceivable that the Respondent registered the domain name unaware of the Complainant’s rights.

The domain name is being used in bad faith. By trying to visit the Respondent’s website, it clearly appears that the disputed domain name does not resolve to an active website or other “on-line” presence. Firstly, the Panel can note that the website corresponding to the domain name at issue consists of a page which only contains advertising messages from the Registrar, the Hong Kong Internet Registration Corporation Ltd (HKIRC) and its subsidiary the Hong Kong Domain Name Registration Company Ltd (HKDNRC), without any information in relation to the Respondent’s activity. Moreover, all the links of this page lead to the Registrar’s website. Taking into account that the Respondent registered the domain name on 20 February 2006, so for almost 3 years, this clearly means that the Respondent has neither intended nor had the intention to use the domain name. Consequently, the Respondent has broken the obligation of the Policy. Therefore, it is obvious that the domain name is being used in bad faith by the Respondent, who only tries to prevent the Complainant from reflecting his trademark in a corresponding domain name. Secondly, it is obvious that this case is a “passive holding” case, and it is well established now that inactivity and passive holding may be construed as positive action in bad faith if relevant circumstances are present. In this case, the Complainant has an established business presence and distinguished profile known under the trademark AXA, both in Hong Kong and outside Hong Kong. The existence of an inactive website registered on 20 February 2006, so for almost 3 years, wholly incorporating the Complainant’s trademark in its entirety, will certainly lead Internet

users to believe that the Complainant does not own a website, or he is not technically able to maintain an active website. Considering the above mentioned circumstances, it is obvious that the domain name is being used in bad faith by the Respondent, who only tries to disrupt the business of the Complainant by attempting to his reputation.

The Complainant requests the Panel to transfer the disputed domain name from the Respondent to the Complainant.

Respondent

No written materials have been submitted by the Respondent. Eight Annexures were submitted. The Annexures shows the introduction to the AXA Planning Ltd. And its cooperation with the Respondent, Business Registration Certificate of the Respondent (Registered in 2009), Business Registration Certificate of the AXA Planning Ltd. (registered in 2008), the Magazine on World Cuisine (With the AXA Planning Ltd. Being the HK & Macau Advertising Agent), Agent information of the AXA Planning Ltd., the name card of the Business Director of the Respondent (being insurance agent).

4、 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.”

Paragraph 4 (a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- 1) [The Respondent’s] Domain Name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights; and
- 2) [The Respondent] has no rights or legitimate interests in respect of the Domain Name; and
- 3) [The Respondent’s] domain name has been registered and is being used in bad faith.

Paragraph 4 (b) of the Policy provides the following evidence of registration and use 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.

Identical/Confusingly Similar

The evidence submitted by the Complainant shows that the Complainant owns the trademark AXA, which has been registered in Hong Kong as early as of 1993. The Complainant also owns the trademark rights of AXA in many other countries. The registration date of the trademark in Hong Kong is more than ten years earlier than the date of the registration of the disputed Domain Name. The Panel has no problem in finding that the Complainant enjoys the indisputable prior rights and interests in the trademark AXA in Hong Kong and other relevant jurisdictions.

The disputed Domain Name is “axa.hk”. The panel finds that the main part of the Domain Name “axa” is identical to the registered trademark (AXA), given that the “.hk” suffix is to be ignored. The Panel therefore holds that the Complaint fulfills the condition provided in Paragraph 4 (a)(i) of the Policy.

Rights or Legitimate Interests of the Respondent

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed Domain Name. The Complainant’s assertion is sufficient to establish a *prima facie* case under the Policy, thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

The Respondent fails to put forward any evidence to show any positive interests that it relies on. No evidence shows that the Respondent has acquired any trademark rights or other proprietary interests relevant to support its claim to the disputed Domain Name. The registration of a certain domain name does not of itself confer upon the registrant rights or legitimate interests in the domain name or in the subject matter of the domain name.

One Annexure shows that the Respondent is in cooperation with the AXA Planning Ltd., a company registered in Hong Kong in 2008. But no evidence has been submitted showing that the Respondent has been authorized by the AXA Planning Ltd. to use the trade name “AXA” for whatever purpose. The Respondent does not appear to be using, or preparing to use the disputed domain name in connection with a *bona fide* offering of goods or services, nor does the Respondent make a legitimate non-commercial or fair use of the domain name. Rather the Respondent is using the disputed domain name to confuse Internet users as to the source, sponsorship or affiliation of the website. Furthermore, no evidence shows that the Respondent has been commonly known by the disputed domain name.

The Panel therefore finds that the Complaint fulfills the condition provided in

Paragraph 4(a)(ii) of the Policy.

Bad Faith

Evidence sufficiently shows that the Complainant is a leading company in the field of insurance and financial services. The Complainant has been consistently using the trademark AXA for over a century. The trademark AXA has achieved a strong reputation through use and advertisement. As such, the public has come to recognize and associate the Complainant's trademark AXA as originating from the Complainant and no other. Furthermore, "AXA" is not a common English word. No reasonable justification could be offered for the Respondent to register the disputed domain name using "AXA" as the main part.

The evidence submitted by the Respondent shows that the business director of the Respondent is an insurance agent, exactly in the same field of the Complainant. This entitles the Panel to the conclusion that the Respondent is aware of the existence of the Complainant and its trademark AXA. The action of registering the disputed Domain Name *per se* has constituted bad faith. This action also has the effect of preventing the Complainant from reflecting its trademark in a domain name corresponding to its activities in Hong Kong.

Since its registration in 2006, the disputed domain name has not been put to active use. The evidence shows that the domain name is linked to the website of the Registrar, the Hong Kong Internet Registration Corporation Ltd. As well accepted, inactivity and passive holding of a domain name may be construed as positive action in bad faith if relevant circumstances are present. Considering the high reputation enjoyed by the Complainant and its trademark, the incorporation of the Complainant's famous trademark in its entirety in the disputed domain name, and the resolution of the domain name to the Registrar for almost 3 years, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith.

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

5、 Decision

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the <axa.hk> domain name should be TRANSFERRED from the Respondent to the Complainant.

ZHAO Yun
Sole Panelist

DATED: 13 March 2009