



香港國際仲裁中心

Hong Kong International Arbitration Centre

.hk Domain Name Dispute Resolution

ARBITRATION PANEL DECISION

1st Complainant: Pfizer Inc.

2nd Complainant: Pfizer Products Inc.

3rd Complainant: Pfizer Corporation Hong Kong Limited

Respondent: Relax 2 Planning (H.K.) Limited

Case Number: DHK-0900051

Contested Domain Name: <pfizer.hk>

Panel Member: Adam Samuel

1. Parties and Contested Domain Name

The 1st Complainant is the parent company of the 2nd and 3rd Complainants. It is a well-known pharmaceutical company. The 2nd Complainant owns trademark registrations for various PFIZER trademarks in Hong Kong. The 3rd Complainant is the regional arm of the 1st Complainant and the registered owner of the domain name <pfizer.com.hk>.

The contested or disputed domain name is <pfizer.hk>.

2. Procedural History

On 9th October 2009, lawyers for the Complainants filed the Complaint with the Hong Kong International Arbitration Centre (HKIAC). Receipt was acknowledged on 12th October. On the same day, the HKIAC asked the Hong Kong Internet Registration Corporation Limited to confirm that the Respondent was the Registrant of the contested domain name and for other factual information. Confirmation was received from Hong Kong Internet Registration Corporation Limited on 13th October 2009. On the same date, the HKIAC served the Complaint on the Respondent indicating to it that it had 15 business days ending on 4th November in which to file a response. No response has been received to date. On 10th November, the HKIAC appointed Adam Samuel to serve as the Panellist in this case having received the appropriate declarations of independence.

3. Factual Background

For the Complainant

The 1st Complainant has been using the PFIZER name since 1849. It operates in more than 150 countries, discovering developing, manufacturing and marketing prescription medicines for humans and animals and other consumer products.

The 2nd Complainant owns Hong Kong trademark registrations for the name PFIZER AND DESIGN, dating back to 1974 and a March 2006 mark for PFIZER.

The 1st Complainant set up the 3rd Complainant in 1956 in Hong Kong to market the 1st Complainant's products in the Asia Pacific region.

For the Respondent

The contested domain name was registered on 27 February 2006.

4. Parties' Contentions

The Complainant

These are the Complainant's contentions with which the Panel does not necessarily agree in their entirety.

The contested domain name is identical or confusingly similar to the trademark or service mark to which the Complainants have rights. Apart from the suffix ".hk", it is identical to the PFIZER word mark and the distinctive portion of the PFIZER trademarks held by the 2nd Complainant in Hong Kong. The Complainant's long history of use of the PFIZER TRADEMARK and its substantial fame in Hong Kong and worldwide further enhances the likelihood of confusion.

The contested domain name was registered over 150 years after the 1st Complainant started to use the PFIZER trademark. It is unlikely that the Respondent would be unaware of the Complainants and their rights in the PFIZER trademark when it registered the contested domain name. Attempting to take advantage of the Complainants' reputation and goodwill does not constitute a legitimate non-commercial or fair use of the domain name. The Respondent's current and former names do not refer to the word PFIZER. There is no evidence to suggest that the Respondent, as a business, has been or is otherwise commonly known by the contested domain name. The Respondent has not acquired any relevant trademark or service rights in Hong Kong. The Respondent is not affiliated with the Complainants. They have never licensed or permitted the Respondent to use its PFIZER trademark or register any domain name containing the PFIZER trademark. There is no evidence showing the Respondent's use of or demonstrable preparations to use the dispute domain name or a name correspondent to it in connection with a bona fide offering of

goods or services in Hong Kong. The dispute domain name is only used in connection with domain name parking services offered by the Registrar.

The fact that the contested domain name is so similar to the Complainants' famous PFIZER mark and that it is only used in connection with domain name parking services creates a presumption that the Respondent holds the expectation that Internet users will be drawn to its parking page. The Respondent's only interest in the dispute domain name is to use it to generate "click-through" revenue which does not constitute a right or legitimate interest in the contested domain name.

The registration of a domain name that is similar to the Complainants' marks is itself evidence of bad faith registration. The Respondent has engaged in a pattern of registering domain names in order to prevent the rightful owners from reflecting their marks in a corresponding domain name. The Respondent has never intended to use the domain name. The Respondent has also failed to provide complete contact details for its registration.

The Respondent

The Respondent did not reply to the Complaint.

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 2nd Complainant registered the trademark PFIZER in Hong Kong on 14 December 1976 with a registration number 19761722. That registration is currently valid. The 1st Complainant has applied for a trademark registration for the same name in Hong Kong recently. It is difficult to see how the 3rd Complainant is relevant to this case since the relief sought is transfer of the domain name from the Respondent to the 1st not the 3rd Complainant.

The domain name reproduces the 2nd Complainant's trademark with only the necessary addition of the suffix ".hk". It is clearly at the very least confusingly similar to the trademark PFIZER owned by the 2nd Complainant in Hong Kong.

The fact that this Complaint has been filed as a single Complaint by three companies in the same corporate group makes it apparent that the 2nd Complainant has permitted the 1st and presumably the 3rd Complainant to use the trademark that it owns in Hong Kong. Such a licence under established caselaw based on the identically worded Uniform Domain Name Dispute Resolution Policy (UDRP) constitutes sufficient entitlement to base a claim to have rights in a relevant trademark. See *Telcel, C.A. v. Jerm and Jhonattan Ramírez* WIPO [D2002-0309](#), *Grupo Televisa, S.A., Televisa, S.A. de C.V., Estrategia Televisa, S.A. de C.V., Videoserpel, Ltd. v. Party Night Inc., a/k/a Peter Carrington* WIPO [D2003-0796](#), *Spherion Corporation v. Peter Carrington, d/b/a Party Night Inc.* WIPO [D2003-1027](#).

If one was looking at this matter afresh, one might take the alternative view. Nevertheless, by the time that the Policy was adopted the UDRP majority position was well known. If those responsible for the Policy had wished Panellists to take the minority position, one would have expected the Policy to contain an express provision on the subject or to have been amended subsequently in this area. One must, therefore, assume that the correct interpretation of “a trade mark or service mark in Hong Kong in which the Complainant has rights” covers those marks to which the Complainant only has a license to use.

It follows from this that all three Complainants have rights in Hong Kong in the trade or service mark PFIZER.

The 1st Complainant is almost certainly entitled to Common Law rights in the name PFIZER in Hong Kong in the light of its extensive marketing over many years of its products under that name. However, in the light of the conclusions set out above, it is unnecessary to decide the point.

(2). Rights or Legitimate Interests of Respondent

The Respondent is not called “Pfizer” or anything similar and does not appear to trade under that or any related name. The website to which the disputed domain name resolves appears never to have been active. There is no evidence that the Complainant has authorized the Respondent to use its trademark. The Respondent has never asserted any rights or legitimate interests in that name or replied to the Complaint on the subject. For these reasons, on the basis of the available record, notably the absence of a Response, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

(3). Bad faith

The name, “Pfizer”, has no independent significance or meaning except as the 2nd Complainant’s trademark and the 1st Complainant’s trading name. The 2nd Complainant’s trademark was registered and the 1st Complainant’s trading name was widely known and used in Hong Kong many years before the domain name was

registered.

The only explanation of what has happened is that the Respondent's motive in registering and using the sites seems to be, as the Complaint says, simply to disrupt the Complainant's relationship with its customers or potential customers, attempt to attract Internet users for potential gain or persuade the Complainant to buy the domain name from it for an amount in excess of the Respondent's out-of-pocket expenses. These all constitute evidence of registration and use in bad faith: paragraph 4(b) of the Policy.

For these reasons, the Panel concludes that the Respondent registered and used the contested domain name in bad faith.

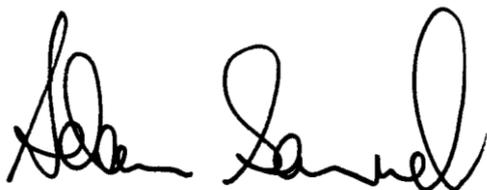
6. Conclusions

The 2nd Complainant has proved its case. It has a registered Hong Kong trademark in a name PFIZER to which the contested domain name is confusingly similar. The Respondent has shown no rights or legitimate interest in the name. The Complainants have proved that the Respondent registered and has used the domain name in bad faith.

However, the Complaint requests transfer of the domain name to the 1st Complainant. This is slightly unsatisfactory in requiring the Panel to make a decision on the scope of 1st Complainant's rights in the trademark concerned in Hong Kong. Nevertheless, the 1st Complainant has proved the existence of those rights. In the light of the Panel's findings on the other two elements of the Policy, the 1st Complainant is entitled to the remedy sought, namely the transfer of the contested domain name to itself.

For all the above reasons, in accordance with paragraph 4 of the Policy, the Panel orders that the domain name <pfizer.hk> be transferred to the 1st Complainant.

Dated 13 November 2009

A handwritten signature in black ink, appearing to read 'Adam Samuel', written in a cursive style.

Adam Samuel