



香港國際仲裁中心

Hong Kong International Arbitration Centre

.hk Domain Name Dispute Resolution
ARBITRATION PANEL DECISION

Complainant: Multiple Listing Service Limited
Respondent: Million Source Limited
Case Number: DHK-1000058
Contested Domain Name: mls.com.hk
Panel Member: Matthew Laight

1. Parties and the Contested Domain Name

The Complainant is Multiple Listing Services Limited of Room 1504, 15/F Tung Chiu Commercial Centre, 193 Lockhart Road, Hong Kong. The Respondent is Million Source Limited of 7/F Yau Lee Centre, 45 Hoi Yuen Road, Kwun Tong, Kowloon. The contested domain name is "*mls.com.hk*" ("**Disputed Domain**").

2. Procedural History

On 7 July 2010, the Complainant filed a Complaint in this matter with the Hong Kong International Arbitration Centre ("**HKIAC**"). On 2 August 2010, the HKIAC confirmed receipt of the Complaint and payment of the required administrative filing fee.

On 4 August 2010, the HKIAC notified the Registrar of the Disputed Domain ("**Registrar**") of the proceedings by email. On the same day, the Registrar confirmed with the HKIAC that, amongst other things, the Respondent is the registered holder of the Disputed Domain, and that due to technical limitations, the Registrar's system was unable to detect the language of the registration agreement for the Disputed Domain at the time of registration.

On 9 August 2010, the HKIAC sent a Notification of Commencement of Proceedings ("**Notification**"), together with the Complaint, to the email addresses of the Respondent's nominated registrant contact, administrative contact and technical contact for the Disputed Domain (as recorded in the Hong Kong Domain Name Registration Company Limited's WHOIS database). The Notification gave the Respondent 15 business days to file a Response (i.e. by 30 August 2010).

The Respondent filed a Response with the HKIAC on 26 August 2010, a copy of which was forwarded to the Complainant by the HKIAC on 27 August 2010.

The Panel, comprising of Matthew Laight as a single panelist, was appointed on 2 September 2010. The papers were delivered to the Panel by email on the same day.

3. Factual Background

For the Complainant

The Complainant is a private company incorporated in Hong Kong. The Complainant has adopted several different names since its date of incorporation. Most recently, by way of a special resolution dated 3 July 2006, the Complainant changed its name to Multiple Listing Service Limited from its previous name of PropertyIT.com Limited. There is no evidence indicating that the Complainant had used, or traded under, the name of Multiple Listing Service Limited (or a related abbreviated name, such as "MLS") prior to 3 July 2006.

The Complainant is the owner of Hong Kong trade mark registration number 300780282 ("**Trade Mark**") with a registration date of 15 December 2006. The Trade Mark relates to a mark made up of the letters "MLS" in italics, with the space within each character containing coloured imagery representing what seems to be fireworks and a comet tail. The Trade Mark includes a statement that "*the applicant claims the colours purple, red, yellow, green and blue as elements of the trade mark*". The Trade Mark is currently registered in respect of the following goods and services in class 42:

"Computer programming; design of data processing apparatus, computer programs; computer advisory services relating to data subscription; computer software design; maintenance and updating of computing software; all included in Class 42."

The Complainant submits that it has been doing business under its Trade Mark since 2007.

For the Respondent

The Respondent is a private company incorporated in Hong Kong. The Respondent has always adopted the English name of Million Source Limited. There is no evidence indicating that the Respondent had used, or traded under, a different name since its incorporation.

The Respondent registered the Disputed Domain on 19 December 2003 on the basis that the Disputed Domain contained the letters "MLS", which correspond to key syllables in its name (i.e. **Mi**Llion **S**ource Limited). The Respondent submits that it has been using the Disputed

Domain since 2003 for both external and internal email communications in connection with its business.

The Respondent's evidence on its use of the Disputed Domain consists of:

- i) various emails (dated from November 2004 to August 2010) relating to the Respondent's commercial activities with third parties, which were sent from and received by various email addresses set up under the Disputed Domain;
- ii) various emails and commercial documents (dated from March 2007 to August 2010) relating to the Respondent's commercial activities with third parties, which were sent from, received by or refer to, email addresses set up under the Disputed Domain; and
- iii) various job advertisements placed by the Respondent (dated from August 2004 to May 2010), which refer to a recruitment contact email address set up under the Disputed Domain.

The commercial documents under category (ii) of the Respondent's evidence all include a letter head portion that includes the Respondent's registered business address in Hong Kong as well as an email address set up under the Dispute Domain.

The Respondent submits that although it does not have a trade mark application or registration in relation to "MLS", it nonetheless has conducted a significant amount of business (around HK\$22 million per year) through its current use of the Disputed Domain.

4. Parties' Contentions

A. Complainant

The Complainant submits that the Disputed Domain is identical with its Trade Mark, in that the Disputed Domain contains the letters "MLS" which correspond to the first three initials of the Complainant's name (i.e. Multiple Listing Service Limited).

The Complainant submits that the Respondent has never used the Disputed Domain since registration, and that this shows the Respondent: (i) has no genuine intention to use the Disputed Domain, and (ii) should not have any rights to the Disputed Domain.

The Complainant further submits that, given it has been doing business under its Trade Mark since 2007, the Respondent's use of the domain name will give rise to confusion with the Complainant's business and services. The Complainant submits that the Respondent's use

of the Disputed Domain will likely mislead and confuse customers into believing that: (i) the Disputed Domain is the Complainant's domain name, or that (ii) the Complainant's Trade Mark identifies or endorses the Respondent's business or products.

On this basis, the Complainant submits that the Respondent's use of the Disputed Domain is in bad faith, and requests the Disputed Domain to be cancelled, or alternatively, transferred to the Complainant.

B. Respondent

The Respondent submits that it has used the Disputed Domain in connection with its business for over 7 years, and has conducted a significant amount of business through its current use of the Disputed Domain. In view of its long history of use, the Respondent submits that the Complainant should not be allowed to use the Disputed Domain to avoid inevitable confusion by the Respondent's existing customers and contacts, which will have a significant adverse impact on the Respondent's business.

On this basis, the Respondent submits that the Complaint is unfounded, and requests the Complaint to be cancelled.

5. Findings

A. The Language of the Proceedings

The HKDNR Domain Name Dispute Resolution Policy ("**Policy**") Rules of Procedure ("**Rules**"), Paragraph 11(a) provides that:

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

In the present case, the Registrar indicated that its system was unable to detect the language of the registration agreement for the Disputed Domain at the time of registration. However, the Registrar is resident in Hong Kong, which has English as one of its official languages. Both the Complaint and Response were drafted and filed in English, and furthermore, all correspondence between the HKIAC, Complainant and Respondent were carried out in English without any issue. The Panel therefore considers that the parties are conversant in English. In these circumstances, the Panel considers that it would be appropriate (and without prejudice to any of the parties) for the present proceedings to be conducted in English.

B. Discussion and Findings

The Policy provides, at Paragraph 4(a), that the Complainant must prove that each of the following three elements is present in order for the Complaint to prevail:

- i) the Disputed Domain is identical or confusingly similar to a trademark 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

Paragraph 4(a)(i) of the Policy requires the Complainant to prove that the Disputed Domain is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights.

The Disputed Domain includes the letters "MLS". In contrast, the Complainant's Trade Mark relates to a stylized and coloured graphical representation of the letters "MLS". Although the graphical representation of "MLS" in the Trade Mark is not identical with the plain use of "MLS" in the Disputed Domain, the "MLS" portion represents the most distinctive and memorable part of both the Disputed Domain and Trade Mark. Accordingly, the Panel considers that the Disputed Domain and Trade Mark are not identical, but are confusingly similar, with each other.

(2) Rights or Legitimate Interests of Respondent

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the Disputed Domain.

For the purposes of Paragraph 4(a)(ii), Paragraph 4(c) of the Policy sets out three specific circumstances (set out below) which can help the Respondent demonstrate it has a right or a legitimate interest in the Disputed Domain. Paragraph 4(c) of the Policy provides that if the Panel considers it proven that, based on its evaluation of all evidence presented to it, the Respondent satisfies any of the following circumstances, the Respondent will have shown that it has a right or legitimate interest in the Disputed Domain:

- i) before the Respondent has any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the Disputed Domain or a name corresponding to the Disputed Domain is in connection with a bone fide offering of goods or services in Hong Kong; or
- ii) the Respondent (as an individual, business, or other organisation) has been commonly known by the Domain Name, even if the Respondent has acquired no trade mark or service mark rights in Hong Kong; or
- iii) the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain, without intent for commercial gain to misleadingly divert consumers or tarnish the trade mark or service mark at issue.

In summary, the Panel finds that the Respondent has satisfied all of the circumstances (i) to (iii) as set out under Paragraph 4(c) of the Policy. The Panel's reasons are provided below.

The evidence presented to the Panel indicates that the Respondent first began using the Disputed Domain in August 2004 by placing various recruitment advertisements with a recruitment contact email address set up under the Disputed Domain. From November 2004 onwards, the Respondent had set up several email addresses set up under the Disputed Domain, and began using these email address in connection with what seems to be genuine offerings of goods and services to actual or potential customers. The Respondent's evidence includes commercial documents which include a letter head portion stating the Respondent's registered business address in Hong Kong, as well as an email address set up under the Disputed Domain. These commercial documents indicate that the Respondent's business operations were being conducted from its registered office in Hong Kong. The Respondent began using the Disputed Domain before it had any notice of the present dispute on 9 August 2010. On this basis, the Panel finds that the Respondent had satisfied circumstance (i) under Paragraph 4(c) of the Policy.

Although the Respondent does not have any trade mark applications or registrations relating to "MLS" (including Hong Kong), the Respondent's extensive use of email addresses set up under the Disputed Domain since August 2004 (e.g. in recruitment advertisements, commercial email communications, and on its company letterhead) suggest that the Respondent is likely to be commonly known by, or have a affiliation with, the Disputed Domain. On this basis, the Panel finds that the Respondent has satisfied circumstance (ii) under Paragraph 4(c) of the Policy.

None of the evidence provided to the Panel indicates that the Respondent's use of the Disputed Domain had been conducted with the intent of making a commercial gain by

misleading consumers, or by tarnishing the Complainant's Trade Mark registration. The Panel is satisfied that the Respondent's use is fair use of the Disputed Domain. On this basis, the Panel finds that the Respondent has satisfied circumstance (iii) under Paragraph 4(c) of the Policy.

(3) *Bad faith*

Paragraph 4(a)(iii) of the Policy requires the Complainant to prove that the Disputed Domain is registered and is being used (by the Respondent) in bad faith.

For the purposes of Paragraph 4(a)(iii), Paragraph 4(b) of the Policy sets out four non-exclusive criteria which, if satisfied, shall be evidence that the Respondent's registration and use of the Disputed Domain is in bad faith:

- i) the Respondent has registered or acquired the Disputed Domain primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain to the Complainant who is the owner of the trade mark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the Disputed Domain; or
- ii) the Respondent has registered the Disputed Domain in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, providing that the Respondent has engaged in a pattern of such conduct; or
- iii) the Respondent has registered the Disputed Domain primarily for the purpose of disrupting the business of a competitor; or
- iv) by using the Disputed Domain, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's 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 the Respondent's web site or location or of a product or service on the Respondent's web site or location.

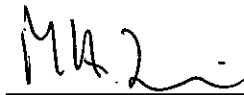
The evidence provided to Panel indicates that the Respondent began using the Disputed Domain for legitimate business purposes from August 2004, which was well before the Complainant had adopted its current name of Multiple Listing Service Limited on 3 July 2006, and well before the Complainant began doing business under its Trade Mark from 2007.

On this basis, the Panel finds that none of the evidence indicates or suggest that the Respondent had used the Disputed Domain for the purpose or intention of engaging in the types of conduct as set out in Paragraph 4(b) of the Policy.

6. Decision

For the foregoing reasons, the Panel concludes that the Complainant has not sufficiently proved all of the three elements set out in Paragraph 4(a) of the Policy. The Complaint is therefore denied.

Dated 28 September 2010
Hong Kong



Matthew Laight