



香港國際仲裁中心

Hong Kong International Arbitration Centre

.hk Domain Name Dispute Resolution

ARBITRATION PANEL DECISION

Complainant: Mattel, Inc.
Respondent: Kristopher-Kent Harris
Case Number: DHK-1000060
Contested Domain Name: <barbie.hk>_
Panel Member: Adam Samuel

1. Parties and Contested Domain Name

The Complainant is a manufacturer and marketer of toys including its BARBIE doll. The contested or disputed domain name is <barbie.hk>.

2. Procedural History

On 27th October 2010, lawyers for the Complainant filed the Complaint with the Hong Kong International Arbitration Centre (HKIAC). Receipt was acknowledged on 3rd November 2010. 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 4th November 2009. On the following day, the HKIAC served the Complaint on the Respondent indicating to it that it had 15 business days ending on 26th November in which to file a response. The Respondent responded to this e-mail on 26th November 2010 and appears to have tried to file a response on that day. He did file a response on 29th November 2010. On 1st December 2010, the HKIAC appointed Adam Samuel to serve as the Panellist in this case having received the appropriate declarations of independence.

As a preliminary matter, it should be noted that technically the Response is marginally out of time. The Complainant has raised no objection to it. The Panel has a discretion under paragraph 10(a) of the Rules of Procedure to conduct the proceedings in such manner as it considers appropriate. The Respondent appears to have tried to send his Response in to HKIAC on the last date for filing a response. The Complainant has suffered no prejudice or disadvantage from the late filing. So, for that reason, the Panel exercises its discretion to admit the Response.

3. Factual Background

The Complainant has owned a trademark registration in Hong Kong for BARBIE since 1964. The disputed domain name was registered on 31st May 2004.

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 BARBIE word mark held by the Complainant in Hong Kong. The Complainant's long history of use of the BARBIE trademark and its substantial fame in Hong Kong and worldwide further enhances the likelihood of confusion. The Complainant maintains the <Barbie.com>m <barbiegirl.com>, <barbiecollector.com.> and <barbiestyle.barbie.com> domain names. The BARBIE mark has acquired distinctiveness through its extensive use by the Complainant in commerce so that the mark is immediately recognizable to consumers as being associated with the Complainant and its business.

The disputed domain name resolves to a parking page containing links advertising products that compete directly with the Complainant's products. In deciding whether a trademark is identical or confusingly similar to a domain name, the domain extension <.hk> in this case should be disregarded.

The disputed domain name does not reflect the Respondent's name. The Respondent has no registered trade mark rights which reflect the disputed domain name. The Respondent has not used the BARBIE name other than in connection with the disputed domain name. The Complainant has not consented to or authorized the Respondent's use of its BARBIE trademark. The Complainant only recently became aware of the Respondent's use of the disputed domain name. So, it has not acquiesced in its trademark's use by the Respondent.

The contested domain name was registered over 40 years after the Complainant registered the BARBIE trademark. It is unlikely that the Respondent would be unaware of the Complainant and their rights in the BARBIE trademark when it registered the contested domain name. This all creates an irrefutable presumption that the Respondent registered the disputed domain name in order to sell it to the Complainant or a third party and obtain unjustified commercial gains or to set up a website which diverts internet traffic from the Complainant's websites and obtain unjustified commercial gain from featured links.

The Respondent, as an American individual, must have been aware of the Complainant's prior rights and interest in the disputed domain name by virtue of the Complainant's reputation in the BARBIE brand in the USA and internationally as at the date when the Respondent registered the disputed domain name. The Respondent

registered more than one domain name identical to the Complainant's marks indicating a pattern of domain name hi-jacking featuring the Complainant's marks. The Respondent has also registered a large number of domain names in Hong Kong containing famous brands which further indicates a pattern of cyber-squatting by the Respondent. In two other cases, involving famous brands, the HKIAC panel found that the Respondent had engaged in abusive domain name registration. The registration of the disputed domain names concerned occurred in the same five day period that the Respondent registered the disputed domain name in this case.

The Respondent

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

The Respondent would not have bought a domain name unless he had no legitimate interest in the name. BARBIE is a familiar way of presenting the common first name Barbra and Barbara and the surname Barbie.

The reference to the Respondent's nationality is discriminatory. Just being American does not mean that the Respondent should be aware of all the trademarks and products available in the USA.

The Complainant had one year six months to register their name as a domain name before it was made available to the public.

What the Complainant has alleged is not domain hijacking or domain theft which is the transfer of the registration of a domain name without the permission of the original registrant.

The Respondent has never contacted anyone about selling the domain name and did not register the disputed domain name to provide the owner of the trademark from reflecting the mark in a corresponding domain name. The Respondent did not register the disputed domain name primarily for the purpose of disrupting a competitor's business. That was not his intention. Nor did this occur. The Respondent did not intentionally attempt to attract for commercial gain, internet users to his website 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 website or location or of a product or service on your website or location.

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 Complainant registered the trademark BARBIE in Hong Kong on 19th June 1964 with a registration number 0938/1965. That registration is currently valid. The domain name reproduces the Complainant's trademark with only the necessary addition of the suffix ".hk". The Respondent argues that the Complainant's trademark is just a variation on two common first names and a surname. This may be correct. However, that is not the issue under the Policy. The question is whether the domain name is confusingly similar to the Complainant's trademark, not whether it is similar to other names. The Panel finds that the disputed domain name is clearly at the very least confusingly similar to the trademark BARBIE owned by the Complainant in Hong Kong.

(2). Rights or Legitimate Interests of Respondent

The Respondent is not called "BARBIE" 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 except as a parking site. 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.

The Respondent argues that he would not buy a domain name in which he had no legitimate interest. That is an assertion without any Policy, legal, evidential or logical foundation. For these reasons, on the basis of the available record, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

(3). Bad faith

The Complainant's trademark BARBIE was registered and 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.

The Respondent has denied all this but not provided any evidence or even an indication of why he registered the domain name. Without that, it is impossible to reach any other conclusion about his motives. The Respondent seems to be arguing that the Complainant should have registered the disputed domain name instead in 1993. However, the Policy does not require this. It insists instead that those registering domain names ensure that they comply with its provisions.

The Panel accepts the Respondent's argument about his nationality. It bases its decision instead on the widespread awareness worldwide of the Complainant's BARBIE trademark and associated product.

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

6. Conclusions

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

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

Dated 3 December 2010

A handwritten signature in black ink, appearing to read 'Adam Samuel'. The signature is written in a cursive, flowing style with a large initial 'A' and 'S'.

Adam Samuel