

**HONG KONG INTERNATIONAL ARBITRATION CENTRE**  
**.hk Domain Name Dispute Resolution**  
**ARBITRATION PANEL DECISION**  
**Case no. DHK-1200077**

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Complainant : Schonbek Worldwide Lighting, Inc.

Respondent : Rich Point Hong Kong Development Limited

Case Number : DHK-1200077

Domain Name : <schonbek.hk>

Panelist : Christopher To

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**I. Procedural History**

The Complainant in this case is Schonbek Worldwide Lighting Inc., a company organized under the laws of United States of America, whose address is 61 Industrial Blvd., Plattsburgh, New York 12901-1908, United States of America. Its authorized representative in these proceedings is David P. Miranda of Heslin Rothenberg Farley & Mesiti P.C. of 5 Columbia Circle, Albany, New York 12203, United States of America.

The Respondent is Rich Point Hong Kong Development Limited, a company organized under the laws of Hong Kong, whose address is Room C, 19<sup>th</sup> Floor Winner Building, 867-885 Canton Road, Mongkok, Kowloon, Hong Kong.

The domain name in dispute is <schonbek.hk>. The Registrar of the disputed domain name is Hong Kong Domain Name Registration Company Limited, which is located in Hong Kong (the “Registrar”).

On 28 March 2012, pursuant to 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 Hong Kong International Arbitration Centre Supplemental Rules (“the

HKIAC Supplemental Rules”), the Complainant submitted a complaint in the English language to the Hong Kong International Arbitration Centre (the “HKIAC”), and elected that this case to be dealt with by a one-person panel.

On 2 April 2012, the HKIAC sent an email to the Registrar asking the Registrar whether it had received a copy of the complaint from the Complainant; whether the disputed domain name is registered with the HKDNR; whether the Respondent “Rich Point Hong Kong Development Limited” is the Registrant or holder of the disputed domain name; whois information regarding the disputed domain name; status of the disputed domain name and the language of the registration agreement.

On the same day, the Registrar replied stating that they had not received a copy of the complaint from the representative of the Complainant; the disputed domain name in question is under the management of the Registrar; the disputed domain name holder is Rich Point Hong Kong Development; supplied the billing contact information for the disputed domain name as well as the whois hyperlink; stated that the disputed domain name is active but could not be transferred and/or deleted during the dispute resolution process and stated that in accordance with Article 11 of the Rules, unless otherwise agreed by the Parties, the language of the arbitration proceedings shall be in English for English .hk domain name.

On 3 April 2012, the HKIAC sent to the Complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the HKIAC Supplementary Rules.

In accordance with the HKIAC Supplemental Rules Article 15 the Complainant on 3 April 2012, transferred the necessary payment to the HKIAC.

On the 11 April 2012, the Complainant forwarded the complaint to the Registrar and on 12 April 2012 the Registrar acknowledged having received such.

On 12 April 2012, the HKIAC notified the Respondent of the commencement of the action and requested the Respondent to submit a response to the complaint by 4 May 2012.

On 16 April 2012, the Respondent (“Andrew Chan”) responded to the HKIAC enclosing its response. On the same day the HKIAC notified the Complainant that the Respondent had submitted a response.

On 20 April 2012, the HKIAC informed the Complainant and the Respondent that Mr. Christopher To had been appointed by the HKIAC as the Panelist pursuant to the Policy, the Rules and the HKIAC Supplemental Rules and informed the parties that the case file will be transferred to the Panelist shortly. The HKIAC also stated that the Panelist shall render its decision on 11 May 2012. The Panel determines that the appointment was made in accordance with the HKIAC Supplemental Rules. On the 23 April 2012, the Panel received the file from the HKIAC.

On 25 April 2012, the Complainant wrote to the HKIAC requesting an opportunity to submit further statements to clarify potentially misleading characterizations that the Respondent has made in its response in particular, the Respondent is not currently and has not been an agent of the Complainant and the Complainant has never authorized or licensed to the Respondent to use its trademark or any of its proprietary products or materials.

On the 27 April 2012, the Respondent wrote to HKIAC clarifying the term “agent” and mentioned that it never stated it was authorized or appointed from manufacturers on its website.

On 30 April 2012, the HKIAC forwarded such a request for additional statements to the Panel for consideration. The Panel decided on the matter and HKIAC through an email of 2 May 2012 conveyed the following to the parties. *“The Complainant may file supplemental submission on or before 9 May 2012; the Respondent may file a reply to the Complainant’s supplemental submission on or before 16 May 2012 and the date for the Panel to render the decision is extended to 6 June 2012”*.

On 8 May 2012, the Complainant submitted its additional statement and the HKIAC requested the Respondent to file a response by 16 May 2012.

On 14 May 2012, the Respondent submitted its response to further statements made by the Complainant.

On 6 June 2012, the HKIAC informed the parties that the date for the Panel to render the decision is extended to 25 June 2012.

## II. Factual Background

### A. For the Complainant

The Complainant is the holder of numerous worldwide trademark registrations (including Hong Kong) [Complaint, Exhibit A] for the mark SCHONBEK, which marks have been in continuous use in Hong Kong since at least 2008. The Complainant is the world's leading manufacturer of premium crystal lighting. Since its founding over 140 years ago, Schonbek has specialized in the creation of custom chandeliers and has designed and created numerous masterpieces of highest heirloom quality using its state-of-the-art manufacturing facility.

Through advertising and the use of the SCHONBEK® mark in commerce, Schonbek has established its self as the superior designer and manufacturer of lighting masterpieces in the market place.

The Respondent registered the disputed domain name at issue on 30 January 2012 [Complaint, Exhibit C]. The Respondent registered the disputed domain name "schonbek.hk", which is identical to the Complainant's registered trademark, as well as to the Complainant's own domain name "schonbek.com" which the Complainant asserts that it has established an online presence for over fifteen (15) years through the use of its domain name "schonbek.com" (registered in 1996). [Complaint, Exhibit D]

The Complainant states that it is a well-established principle that if the disputed domain name wholly incorporated the Complainant's registered trademarks, it would be sufficient to establish the identity or confusing similarity and the Complainant quotes the case of *Paul frank Industries, Inc. v. Xianggangshengshitouzi Co., Ltd., HKIAC Case no. DHK-1100068 (May 25, 2011)* as a reference.

The Complainant asserts that the mere addition of the suffix ".hk" does not distinguish the disputed domain name from the Complainant's registered trademark and the Complainant quotes the case of *Wynn Resorts Holdings, LLC v. M3 International Exhibition & Design Limited, HKIAC Case No. DHK-0900045 (June 1, 2009)* for reference to supplement its reasoning.

The Complainant through its supplemental statement of 8 May 2012, confirmed that the Respondent is not, and has never been, an agent of Schonbek, and that the Respondent is not an authorized dealer of Schonbek's products in Hong Kong or

elsewhere. Any sale or offer for sale of Schonbek's products by the Respondent is unauthorized by Schonbek, and constitutes further evidence of confusion in the marketplace caused by the Respondent. The Complainant confirms that it has not sought or requested any advertising services from the Respondent in Hong Kong or elsewhere nor has it authorized or licensed to the Respondent to use the Complainant's trademarks or any of its proprietary products or materials including the use of such on its website.

The Complainant also states that the Respondent's offer to "negotiate" the sale of the disputed domain name to Schonbek is further evidence of the Respondent's bad faith.

The Complainant states that the Respondent does not have any rights or legitimate interest in the disputed domain name as the Respondent has no affiliation what so ever with the Complainant nor has it received any license or agreement to use the Complainant's trademarks as well as being authorized to trade in the Complainant's products in Hong Kong or elsewhere. Moreover the Complainant further asserts that the Respondent does not own trademark or service mark rights identical to the disputed domain name in Hong Kong and the Respondent is not commonly known by the disputed domain name.

The Respondent's website has the impression that it is somehow affiliated or associated and appears to be similar in appearance with the Complainant's own website thus creating confusion or attempting to mislead customers to believe that the Respondent and its website is somehow affiliated and /or authorized by the Complainant. [Complaint, Exhibit E and F respectively]

The Complainant asserts that the Respondent has not made a legitimate non-commercial fair use of the disputed domain name, instead it has created confusion and has routed customers seeking Complainant's products to that of the Respondent, which is a strong presumption of bad faith in attempting to attract, for commercial gain, customers by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation, endorsement of the website.

The Complainant is of the view that the registration and use of the disputed domain name "schonbek.hk", can thus only be seen as the Respondent's attempt to unfairly benefit from the extensive goodwill and outstanding reputation that the Complainant has developed in the industry by creating confusion with the Complainant's registered mark and website.

## **B. For the Respondent**

The Respondent in its response dated 16 April 2012 stated that its website did not state that it is the authorized distributor of SCHONBEK and Swarovski Architecture products, but instead the website stated that it is an information website for SCHONBEK and Swarovski Architecture products in the Hong Kong market and that Rich Point Hong Kong Development Limited is the agent that carries Schonbek items.

The Respondent states that schonbek.hk's role is to direct customers in Hong Kong to purchase Schonbek products thus providing advertising services for Schonbek in Hong Kong. It mentions that it has a Chinese translation on its webpage which schonbek.com does not have and its information within the website is real and is based on the website of schonbek.com.

It also states that Schonbek Worldwide Lighting had an opportunity to purchase the disputed .hk domain name but failed to do so thus giving others an opportunity to purchase the disputed domain name.

The Respondent through its supplemental statement of 15 May 2012, stated that it will remove all Schonbek related materials from its website. The mission of schonbek.hk was to direct customers conveniently with information on where to purchase authentic Schonbek products. The Respondent stated that it never registered the disputed domain name in order for the Claimant to purchase it back and on this basis it is not using the disputed domain name in bad faith.

The Respondent also stated that Schonbek owes the trademark and has the right to owe the disputed domain name nevertheless the Respondent had subscribed to the disputed domain name until January 30, 2013 and on this basis cannot transfer the disputed domain name until the subscription ends. During the period of registration the Respondent will ensure that the disputed domain name will not have Schonbek Worldwide Lighting Inc., materials or anything in that relationship on its website. The Respondent concluded by stating that regardless of the Panelist's decision, it will respect such a decision.

### **III. Parties' Contentions**

#### **A. The Complainant**

The Complainant asserts that the disputed domain name at issue is identical or confusingly similar to the Complainant's SCHONBEK marks, in that the disputed domain name at issue is comprised of the SCHONBEK mark with the addition of the ccTLD.hk and incorporates the SCHONBEK mark.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the Respondent's disputed domain name has been registered in bad faith and is being used in bad faith.

#### **B. The Respondent**

The Respondent's response did not respond to the statements and allegations contained in the complaint, nevertheless the Respondent asserts that the disputed domain name is an information website for SCHONBEK and Swarovski Architecture products in Hong Kong and it assists in directing customers to purchase Schonbek products.

The Respondent also asserts that it had never registered the disputed domain name in order for the Claimant to purchase it back and on this basis it is not using the disputed domain name in bad faith.

### **IV. Findings**

#### **A. The Languages of the Proceedings**

Paragraph 11(a) of the Rules provides:

*"Unless otherwise agreed by the Parties, the language of the arbitration proceedings shall be in English for English .hk domain name, and in Chinese for Chinese .hk domain name or .香港 domain name, subject always to the authority of the Arbitration Panel to determine otherwise, having regard to the circumstances of the arbitration proceeding."*

The registration agreement is in the English language [Complaint, Exhibit H] and given that the disputed domain name is an English .hk domain name as well as the correspondence in the case is in the English language. The Panel determines that the language of the arbitration proceedings shall be English.

### **B. The Burden of Proof**

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving:

1. That the domain name registered by the Respondent is identical or confusing similar to a trademark or service mark in which the Complainant has rights; and
2. That the Respondent has no rights or legitimate interests in respect of the domain name; and
3. That the domain name has been registered and is being used in bad faith; and
4. That the domain name is registered by an individual person who does not meet the registration requirements for that individual category of domain name.

## **V. Analysis**

### **A. Identical or Confusing Similarity**

The Complainant contends that the disputed domain name is confusing similar to the Complainant's trademark.

The Panel agrees with the Complainant submission and finds that the domain name <schonbek.hk> is identical to the Complainant's registered SCHONBEK mark.

### **B. Rights or legitimate Interests of the respondent**

Paragraph 4(d) of the Policy set out examples of what a Respondent may demonstrate to show that it has rights or legitimate interests in respect of the disputed domain name.

The Panel notes that the onus is on the Complainant to demonstrate that the Respondent has no rights or legitimate interests. Once prima evidence has been adduced by the Complainant, the burden shifts to the Respondent to prove otherwise.

The Complainant has never assigned, granted, licensed, sold, transferred or in any



way authorized the Respondent to register or make use of the Complainant trademark and this was confirmed by the Respondent. Therefore, the Panel finds that there is no commercial relationship between the Complainant and the Respondent which would entitle the Respondent to the mark. Consequently, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent asserts that the disputed domain name is an information website for SCHONBEK and Swarovski Architecture products in Hong Kong and it assists in directing customers to purchase Schonbek products. The Panel finds that the Respondent through the creation of an information website for Schonbek products intended to mislead consumers into thinking that the Respondent has some kind of business relationship with the Complainant or it is the Complainant.

The Complainant submits, that it has used the mark since May 2008 in Hong Kong. The Panel notes that the disputed domain name was registered on January 2012 by the Respondent "Rich Point Hong Kong Development Limited". The Panel therefore, concludes that the Respondent has never been commonly known by the disputed domain name and has never acquired any trademark or service mark rights in the disputed domain name.

The Complainant has in a credible way alleged that the Respondent has no rights or legitimate interests in respect of the disputed domain name at issue whereas the Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name at issue. This ineffectively entitles the Panel to infer that the Respondent has no rights or legitimate interests in respect of the disputed domain name at issue.

In the circumstances, the Panel concludes that, on a balance of probabilities, the Complainant has discharged its burden of proof to show that the Respondent has no rights or legitimate interests in the disputed domain name.

### **C. Bad Faith**

Bad faith cannot be presumed, but once the Complainant has presented some evidence to establish a prima facie case, the onus then shifts onto the Respondent to either justify or explain his business conduct.

The Panel finds that the Complainant has presented adequate evidence to demonstrate

the Respondent's bad faith in pursuant to paragraph 4(b) of the Policy.

The Panel consider that the Complainant's mark enjoys a worldwide reputation in so far as the Respondent was willing to use the disputed domain name as an information website for SCHONBEK and Swarovski Architecture products in Hong Kong so as to assists in directing customers to purchase Schonbek products. The panel also notes that the Complainant's rights in the mark predate the Respondent's registration of the disputed domain name. The Panel finds that, given the fact that the Complainant's marks are widely known, it is overwhelmingly likely that the Respondent, at the time of registration of the domain name and thereafter, was aware that it was infringing the Complainant's mark. Therefore the Panel concludes that the Respondent has registered the disputed domain name in bad faith.

#### **D. Domain Name registration by an individual person**

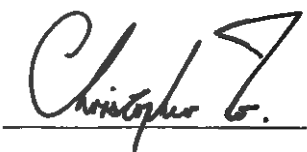
The disputed domain name is registered by Rich Point Hong Kong Development Limited and is not registered by an individual person, hence this requirement does not apply to the current case.

#### **VI. Decision**

For all of the foregoing reasons and in accordance with paragraph 4 (a) of the Policy, the Panel decides that the disputed domain name registered by the Respondent is identical to the mark in which the Complainant has rights, that the Respondent has no rights or legitimate interest in respect of the disputed domain name at issue and that the Respondent's domain name has been registered and is being used in bad faith. In pursuant to paragraph 3 of the Policy, the Panel requires that the registration of the domain name < schonbek.hk> be transferred to the Complainant.

Dated 25 June 2012

In the Hong Kong Special Administrative Region of the People's Republic of China.

A handwritten signature in black ink, appearing to read "Christopher To", is written over a horizontal line.

Christopher To