

IN THE MATTER OF

The Domain Name Dispute Resolution Policy, adopted by the Hong Kong Domain Name Internet Registration Corporation Limited ("HKIRC") on 22 February 2011 (the "Dispute Resolution Policy");

The HKIRC Domain Name Dispute Resolution Policy Rules of Procedure, approved by the HKIRC on 22 February 2011 (the "Rules of Procedure"); and

The HKIAC Supplemental Rules effective from 1 March 2011 (the "Supplemental Rules").

Complainant: Orange Brand Services Limited
Respondent: Wang Hui
Case Number: DHK-1200078
Disputed Domain Name: iorange.hk
Panel Member: Peter Bullock

1. Parties and Contested Domain Name

The Complainant is Orange Brand Services Limited, a company registered in England and Wales with its registered office at St James Court, Great Park Road, Almondsbury Park, Bradley Stoke, Bristol, England, BS32 4QJ. The Respondent is Wang Hui, an individual with an address at 16F, Building 2, Jincheng International Square, Jing San Road, Zhengzhou, Henan Province, China. The contested domain name is "iorange.hk" which was created on 30 May 2011.

2. Procedural History

A complaint in this matter was filed with the Hong Kong International Arbitration Centre (the "HKIAC") on 5 April 2012. On the same day, the HKIAC notified the registrar of the Disputed Domain Name of the proceeding by email and the registrar notified the HKIAC that the proper respondent to the dispute is the Respondent.

The HKIAC sent a notification of commencement of proceedings and the complaint along with its annexes to the Respondent by email on 11 April 2012. The Respondent filed a response with the HKIAC on 12 April 2012.

In the response, the Respondent elected to have the complaint to be decided by a Panel of Three Arbitrators. However, the Respondent clarified with the HKIAC that the Respondent decided to have a single member Arbitration Panel by email on 13 April 2012.

On 27 April 2012, the HKIAC informed the parties by email that the Panelist had been appointed.

3. Factual Background

3.1 For Complainant

The Complainant is part of the France Telecom-Orange group. The Complainant provides a wide variety of services and goods, including but not limited to goods such as handsets, SIM Cards and computer devices; and installation, maintenance and repair of electronic goods and systems, under the trademark "ORANGE".

The Complainant has registered a variety of trademarks comprising the marks "ORANGE" (the "Mark"), "Orange Device" (registered for the orange colour referred to as pantone 151 and in black and white), and the colour orange (specifically the shade of orange colour referred to as pantone

151) in various jurisdictions including Hong Kong and People's Republic of China where the Respondent is domiciled.

The Complainant also owns various domain names incorporating the word "Orange" as standalone or associated with other words such as "orangemail" and "orange3g".

3.2 *For Respondent*

The Respondent registered the Disputed Domain Name on 30 May 2011. The webpage connected to the Disputed Domain Name showed that the Respondent is trading under the name "iorange.hk" and using the "iorange" mark.

The Complainant sent a cease and desist letter to the Respondent by registered letter and email on 21 March 2012, but no communication had been received from the Respondent. After the Complaint has been filed with the HKIAC and sent to the Respondent, the Respondent offered to sell the Disputed Domain Name "at a reasonable price".

4. **Parties' Contentions**

4.1 *For Complainant*

The Complainant asserts the following:

- The Disputed Domain Name is confusingly similar to the Complainant's Mark.
- The Respondent has no rights or legitimate interests in the Disputed Domain Name on the grounds that (i) the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or make use of the Mark; (ii) the Respondent has never used or made preparations to use, the Disputed Domain Name or any name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services; (iii) the Respondent intends to mislead consumers into thinking that the Respondent has some kind of business relationship with the Complainant or it is the Complainant; (iv) 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; and (v) the Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name.
- The Respondent has registered and used the Disputed Domain Name in bad faith in order to (i) intentionally attempt to attract, for commercial gain, internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's name or Mark; and (ii) mislead the trade and public into believing that the Disputed Domain Name is connected with the Complainant and seek to pass on the Disputed Domain Name for an amount far in the excess of the Respondent's out-of-pocket expenses.

4.2 *For Respondent*

The Respondent's response did not respond to the statements and allegations contained in the complaint.

The Respondent asserts the following:

- The Respondent has been the owner of the Disputed Domain Name since 2011.
- The Respondent is willing to accept a reasonable price for the Disputed Domain Name.

5. Discussion and Findings

Paragraph 4(a) of the Dispute Resolution Policy provides that the Complainant must prove all of the following elements in order to succeed in this arbitration proceeding:

- (i) the Disputed Domain Name 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 Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

5.1 *Identical/ Confusingly Similar*

The Complainant contends that the Disputed Domain Name is confusingly similar to the Complainant's Mark. The Disputed Domain Name incorporates the Complainant's trademark "ORANGE" with an addition of a letter "i".

The Complainant submits that the addition of a letter "i" to the Disputed Domain Name is purely non-distinctive. It is a single letter with no inherent trademark characteristics and therefore only serves to emphasise the Mark "ORANGE".

The Panel agrees with the Complainant's submission. It is well established that when a mark is the distinctive part of the disputed domain name, the domain name is to be considered to be confusingly similar to the registered mark (*Farouk Systems, Inc. v QYM WIPO Case No. D2009-1572*).

Thus, the Panel finds that the Complainant has fulfilled 4(a)(i) of the Dispute Resolution Policy.

5.2 *Rights and Legitimate Interests*

Paragraph 4(d) of the Dispute Resolution Policy sets 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 Respondent's use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services in Hong Kong before any notice to the Respondent of the dispute; or
- The Respondent (as an individual, business or other organisation) has been commonly known by the Disputed Domain Name, even if no trade mark or service mark rights has been acquired in Hong Kong; or
- The Respondent has trademark or service mark rights that the mark is identical to the Disputed Domain Name the Respondent is holding; or
- The Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel notes that the onus is on the Complainant to demonstrate that the Respondent has no rights or legitimate interests. Once prima facie evidence has been adduced, the burden shifts to the Respondent to prove otherwise (*Six Continents Hotels, Inc v Patrick Ory, WIPO Case No. D2003-00098*).

The Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or make use of the Mark. 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 did not provide any defence or evidence to contradict the Complainant's claim, rather the Respondent offered to sell the Disputed Domain Name to the Complainant. Accordingly, the Panel finds that the Respondent has not used or made preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods or services and is not making a legitimate non-commercial or fair use of the Disputed Domain name.

The Complainant provides screenshots of the Disputed Domain Name and it appears that the Respondent is using the Disputed Domain Name in connection with the services and products similar and identical to the Complainant's business. The Respondent also uses a mark confusingly similar to the Complainant's Mark on the website. Thus, the Panel finds that the Respondent intends to mislead the consumers into thinking that the Respondent has some kind of business relationship with the Complainant or it is the Complainant (*The Dow Chemical Company v Hwang Yiyi, WIPO Case No. D2008-1276*).

The Complainant submits that it has used the Mark for more than 17 years. The screenshot of the Disputed Domain Name shows that the Respondent was formerly trading under the name of Taurus Electronic Company. The Panel also notes that the Disputed Domain Name has only been registered since May 2011. 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.

In the circumstances of this case, the Panel concludes that, on a balance of probabilities, the Complainant has discharged its burden to show that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

5.3 *Bad Faith*

For the purposes of Paragraph 4(b) of the Dispute Resolution Policy, if the following circumstances, in particular but without limitation, are found by the Panel to be present, this constitutes evidence of the registration and use of the Disputed Domain Name in bad faith:

- any circumstances indicating that the Disputed Domain Name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name registration to the Complainant who is the owner of the trademark or service mark, or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the Disputed Domain Name; or
- the Respondent registered the Disputed Domain Name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- the Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or
- by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

Bad faith cannot be presumed, but once the Complainant has presented some evidence to establish a prima facie case, the onus is shifted to the Respondent to either justify or explain his business conduct (*Six Continents Hotels, Inc v Patrick Ory, WIPO Case No. D2003-00098*).

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 Dispute Resolution Policy.

The Panel considers that the Complainant's Mark enjoys a worldwide reputation. The ORANGE brand was ranked 36th globally in the 2011 "BrandZ 100 Most Valuable Global Brands" survey conducted by Millward Brown. The Complainant has also sponsored or supported numerous high profile cultural, sporting and charitable activities under the ORANGE brand. Further, the Complainant's rights in the Mark predate the Respondent's registration of the Disputed Domain Name by over 16 years. 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.

Since the Respondent did not provide any explanation as to why the Respondent has adopted a domain name that is confusingly similar to the Mark to conduct similar or identical business to the Complainant's business, the Panel finds that the Respondent is using the Disputed Domain Name intentionally to unfairly attract business by creating a likelihood of confusion with the Complainant's Mark.

The Complainant has also tried to contact the Respondent by letter and emails before the commencement of this arbitration proceeding to inform the Respondent of the Complainant's rights to the Mark and the domains. However, the Respondent did not respond. Only after this arbitration proceeding has begun, the Respondent first responded by offering to sell the Disputed Domain Name by an email on 12 April 2012 and reiterated this in the response. Accordingly, the Panel finds that the Respondent is misleading the trade and public into believing that the Disputed Domain Name is connected with the Complainant and that the Respondent is seeking to pass on the Disputed Domain Name for an amount in excess of the Respondent's out-of-pocket expenses. Although the Respondent professes a desire to sell the Disputed Domain Name "at a reasonable price", he neither quoted the price he required nor stated that he would transfer for an amount equivalent to his out-of-pocket expenses.

In light of the above, the Panel finds that, on a balance of probabilities, the Respondent has registered and used the Disputed Domain Name in bad faith.

6. Decision

In light of all the foregoing findings and in accordance with paragraph 4(a) of the Disputed Resolution Policy, the Panel holds that the Disputed Domain Name "iorange.hk" is confusingly similar to the Complainant's registered trademark of "ORANGE"; the Respondent has no right or legitimate interest with regard to the Disputed Domain Name; and the Disputed Domain Name was registered and subsequently used in bad faith by the Respondent.

Finally, the Panel decides that the domain name "iorange.hk" be transferred to the Complainant.

Dated: 17th May 2012.

Hong Kong



Peter Bullock