

**HONG KONG INTERNATIONAL ARBITRATION CENTRE**

**.hk Domain Name Disputed Resolution**

**ARBITRATION PANEL DECISION**

**Case no. DHK-120080**

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Complainant	:	Standard Perpetual Precious Metals Limited
Respondent	:	Jiaren Wu
Domain Name	:	<standardperpetual.hk>
Panelist	:	Gabriela Kennedy

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**1. The Parties**

The Complainant is Standard Perpetual Precious Metals Limited of Hong Kong.

The Respondent is Jiaren Wu of China.

**2. The Domain Name and Registrar**

The disputed domain name <standardperpetual.hk> (the "Disputed Domain Name") is registered with Hong Kong Domain Name Registration Company Limited (the "Registrar").

**3. Procedural History**

The Complaint was filed with the Hong Kong International Arbitration Centre (the "Centre") on June 14, 2012. On June 15, 2012, the Centre transmitted by email to the Registrar, a request for registrar verification in connection with the Disputed Domain Name. On June 18, 2012, the Registrar transmitted by email to the Centre verification responses confirming that it is the Registrar of the Disputed Domain Name and that the Respondent is listed as the registrant of the Disputed Domain Name, and providing the contact details for the Respondent.

The Centre verified that the Complaint satisfied the formal requirements of the Domain Name Dispute Resolution Policy for .hk and .香港 domain names (the "Policy") and the Domain Name Dispute Resolution Policy for .hk and .香港 domain names Rules of Procedure (the "Rules").

In accordance paragraphs 2(a) and 4(a) of the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on June 22, 2012. In accordance with the Rules, paragraph 5(a), the due date for the Response was July 16, 2012. The Respondent did not submit a formal Response by July 16, 2012.

The Centre appointed Gabriela Kennedy as the sole panelist in this matter on July 20, 2012. The Panel finds that it was properly constituted. The Panel confirmed on July 19, 2012 of her appointment as the sole panelist in this matter.

It subsequently came to the Panel's attention that the "Standard Perpetual" trade mark registration on which the Complainant's complaint is based was owned by Standard Perpetual Finance Group Limited ("SPFG") and the Complainant did not provide evidence to show that it has rights in respect of such trade mark. In accordance with its powers under paragraph 10 of the Rules, the Panel issued a Panel Order on August 9, 2012, requesting the Complainant to provide further evidence of its rights in respect of the trade mark and its relationship with SPFG by August 16, 2012. The Panel provided until August 23, 2012 for the Respondent to submit a supplemental Response in respect of any additional evidence submitted by the Complainant.

On 16 August 2012, the Complainant forwarded to the Centre a license agreement, under which SPFG grants rights to the Complainant to make use of the "Standard Perpetual" trade mark, as well as a letter of declaration, stating that the Complainant and SPFG are subject to common management control.

The Respondent did not submit a supplemental Response to the Centre by August 23, 2012.

#### **4. Factual Background**

The trade mark on which the Complaint is based is "Standard Perpetual". The Complainant is a Hong Kong company, providing services in the areas of global asset management, investment in gold, and corporate investment strategies. The Complainant's related company, SPFG, owns a trade mark registration in Hong Kong for "Standard Perpetual" and has granted rights to the Complainant to use this trade mark.

The Respondent is Jiaren Wu of China. The Disputed Domain Name was registered on June 13, 2011. At the date of this Decision, the Disputed Domain Name resolved to an inactive website (the "Website"). According to the evidence adduced by the Complainant, the Disputed Domain Name used to resolve to a website which was almost identical in content and layout to the section of the Complainant's [www.standardperpetual.com](http://www.standardperpetual.com) website (the "Genuine Website") that advertises services relating to the investment in gold.

#### **5. Parties' Contentions**

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

The Complainant's contentions can be summarised as follows:

- (a) The Disputed Domain Name is confusingly similar to the Complainant's "Standard Perpetual" mark, in which the Complainant has rights:
  - (i) the layout of the Website (before its content was removed) and the Genuine Website were identical as the Respondent has copied the Genuine Website;
  - (ii) the logo displayed in the Website was exactly the same as the Complainant's registered trade mark;
  - (iii) the Complainant's is the only registered company in Hong Kong to legally engage in precious metals trading; and

- (iv) the Respondent is not related to the Complainant and he is intentionally imitating the Complainant by pretending to be a member of The Chinese Gold and Silvery Exchange Society ("CGSE").
- (b) The Respondent does not have rights or legitimate interests in the Disputed Domain Name:
- (i) the Disputed Domain Name is not used in connection with a *bona fide* offering of goods or services in that the Website claimed the Respondent to be a member of the CGSE while it is not. The Complainant is the only company with authorisation by CGSE to trade in precious metals in Hong Kong. Therefore, the Respondent did not provide the purported services in Hong Kong;
  - (ii) the Respondent has not been commonly known by the Disputed Domain Name or by the name of any entity related to the Complainant;
  - (iii) the Respondent does not own any trade mark registrations for or incorporating "Standard Perpetual"; and
  - (iv) the Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name but is rather using the same with an intent for commercial gain to mislead and divert Internet users.
- (c) The Disputed Domain Name has been registered and is being used in bad faith:
- (i) the Respondent claims the Website to be the official website for Standard Perpetual, which is not the case; and
  - (ii) the Respondent has intentionally attempted to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant, through its use of the Disputed Domain Name.

## **B. Respondent**

The Respondent did not submit a formal Response to the Complainant's contentions.

The fact that the Respondent has not submitted a Response does not automatically result in a decision in favour of the Complainant. However, the failure of the Respondent to file a Response may result in the Panel drawing certain inferences from the Complainant's evidence. The Panel may accept all reasonable and supported allegations and inferences following from the Complaint as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. D2009-1437 and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. D2000 0403).

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, to succeed in the complaint, the Complainant has the burden of proving all of the following:

- (a) the Respondent's Domain Name is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights;

- (b) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- (c) the Respondent's Domain Name has been registered and is being used in bad faith; and
- (d) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name.

#### **A. Identical or Confusingly Similar**

The Panel accepts that SPFG owns the Hong Kong trade mark registration for "Standard Perpetual" dating back to June 1, 2011. Previous panels have established that a complainant having the right to use a mark under license from the trade mark owner has rights in such trade mark in respect of paragraph 4(a)(i) of the Policy (see *American Civil Liberties Union of New Mexico v Vilma Morales/e: bOOm, S.A.*, WIPO Case No. D2004-0473 and *Telcel, C.A. v jerm and Jhonattan Ramirez*, WIPO Case No. D2002-0309). Accordingly, the Panel finds the Complainant has rights in respect of the "Standard Perpetual" trade mark, on the basis of the licence granted by SPFG to the Complainant to in respect of such trade mark.

The Disputed Domain Name incorporates the Complainant's "Standard Perpetual" mark in its entirety. It is a well-established rule that in making an enquiry as to whether a trade mark is identical or confusingly similar to a domain name, the domain extension, in this case <.hk> should be disregarded (see *Rohde & Schwarz GmbH & Co. KG v. Perthshire Marketing, Ltd*, WIPO Case No. D2006-0767).

Accordingly, the Panel finds that the Disputed Domain Name is identical or confusingly similar to the "Standard Perpetual" trade mark in which the Complainant has rights in satisfaction of paragraph 4(a)(i) of the Policy.

#### **B. Rights or Legitimate Interests**

The Panel accepts that the Complainant has not authorised the Respondent to use the "Standard Perpetual" trade mark. The Panel further accepts that the Respondent has not become commonly known by the Disputed Domain Name. Accordingly, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name and the Respondent has the burden of proving that he does possess such rights or legitimate interests. As no Response has been submitted by the Respondent, the Panel will assess the Respondent's rights in the Disputed Domain Name (or lack thereof) based on the Respondent's use of the Disputed Domain Name in accordance with inferences that can be reasonably drawn from the Complainant's evidence.

As the Respondent has not been authorised by the Complainant to use the "Standard Perpetual" trade mark, does not appear to have any trade mark rights in respect of the Disputed Domain Name and does not appear to have been commonly known by the Disputed Domain Name, the only way for the Respondent to acquire rights or legitimate rights in the Disputed Domain Name for the purposes of 4(a)(ii) of the Policy would be through use of the Disputed Domain Name in connection with a *bona fide* offering of goods or services, or legitimate non-commercial purposes.

While at the time of this Decision the Website is inactive, the Complainant provided the Panel with evidence that the Website used to contain content that was virtually identical to the Genuine Website. In fact, certain sections of the Genuine Website were reproduced in an identical fashion on the Website, including the front page which displays the same pictures, logo and company name (discussed in more detail in relation to bad faith below). Under such circumstances, the Panel finds that the Dispute Domain Name and the Website will almost certainly create confusion amongst Internet users as to the origin of the Website because it inevitably creates an impression that the Website is owned or authorised by the Complainant. Furthermore, the striking similarity between the two websites suggests that the Respondent must have known of the "Standard Perpetual" trade mark, and that the Disputed Domain Name (as well as the Website) was used in order to create an impression of association or affiliation with the Complainant, the "Standard Perpetual" mark that the Complainant is licenced to use and the goodwill attached to the mark. Using a domain name to intentionally trade on the fame or reputation of another constitutes unfair use, and cannot amount to a *bona fide* offering of goods or services, or a legitimate non-commercial or fair use of the Disputed Domain Name (see *Philip Morris Incorporated v. Alex Tsytkin*, WIPO Case No. D2002-0946; *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000 0847).

Also, given the fact that the Website is almost identical in content and layout to the Genuine Website, it is impossible to conceive that the Respondent was unaware of the Complainant, SPFG and their rights in the "Standard Perpetual" trade mark. As such, the Panel finds that the Respondent's use of the "Standard Perpetual" trade mark in its entirety renders no plausible explanation as to why the Respondent selected the trade mark other than to trade on the goodwill of such a mark (see *Financial, Inc. v Ray Chen*, WIPO Case No. D2001-1242 and *Cellular One Group v Paul Brien*, WIPO Case No. D2000-0028).

The Panel accordingly finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy in respect of the Disputed Domain Name.

### **C. Registered and Used in Bad Faith**

The fact that the Respondent has registered and used the Disputed Domain Name without having any rights or legitimate interests in it is of itself evidence of bad faith on the part of the Respondent.

As discussed above, the Website was previously almost identical to the Genuine Website, such that Internet users were unlikely to distinguish the difference between the two websites. Not only did the Website contain the same pictures, logo and company name as the Genuine Website, it was also extremely similar in look and feel, and contained the same contact details and description of services as the Genuine Website. With the exception of a few pages where the Website posted daily updates relating to the gold market, 48 of the 54 screenshots provided by the Complainant contained exactly the same content as that shown on the Genuine Website. Given the compelling evidence that the Website was nearly a mirror copy of the Genuine Website, the Panel finds that the Respondent must have been aware of the Complainant and the "Standard Perpetual" mark when registering the Disputed Domain Name, and therefore registered the domain name in bad faith (see *Computer Sciences Corporation CSC Deutschland Solutions GmbH v Olivier Terroux*, WIPO Case No. D2012-0677 and *Zappos.com, Inc v Zufu aka Huahaotrade*, WIPO Case No. D2008-1191).

The Complainant alleges that the Respondent has intentionally attempted to attract consumers for commercial gain by creating a likelihood of confusion with Standard Perpetual through the Disputed Domain Name. It is not precisely clear from the screen shots provided how the Respondent profited from the operation of the Website but the Panel considers that given the lengths that the Respondent has gone to in order to imitate the Genuine Website and the Complainant's business, it is difficult to conceive that this was done otherwise than for profit (whether by providing services to customers visiting the website on the mistaken belief that it is somehow associated with the Complainant, via advertising revenue or selling the Disputed Domain Name to the Complainant or a competitor for an amount exceeding its out of pocket costs associated with the Disputed Domain Name). The Panel concludes that more likely than not, the Respondent registered the Disputed Domain Name and set up the Website with the intention of capitalising on the goodwill of the "Standard Perpetual" mark by attempting to attract, for commercial gain, Internet users to the Website by creating a likelihood of confusion with the Complainant's mark as to the affiliation or endorsement of the Website, thereby increasing the traffic to the Website and profiting from the services being advertised. Such use of the Disputed Domain Name by the Respondent constitutes an improper use of the Disputed Domain Name and is therefore further evidence of bad faith registration and use of the Disputed Domain Name on the part of the Respondent (see *Ebay Inc. v Wangming*, WIPO Case No. D2006-1107; *Renalo Investments Limited v Dot Coms, Inc./Mr Fulviu Fodoreanu*, WIPO Case No. 2008-1791 and *Kabushiki Kaisha Toshiba dba Toshiba Corporation v WUFACAI*, WIPO Case No. D2006-0768, in which the panels held that the respondents, in using the disputed domain names to host websites which were copies of the complainant's genuine websites, had registered and used the disputed domain names in bad faith).

The Panel accordingly finds that the Complainant has satisfied paragraph 4(a)(iii) of the Policy in respect of the Disputed Domain Name.

**D. If the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of domain name**

As the Disputed Domain Name does not fall into the individual category of domain name, the Complainant is not required to satisfy paragraph 4(a)(iv) of the Policy.

**7. Decision**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name be transferred to the Complainant.

**Gabriela Kennedy**  
Sole Panelist  
Date: September 4, 2012