



## **.hk Domain Name Dispute Resolution** ARBITRATION PANEL DECISION

Complainant: Google Inc.  
Respondent: Kam Piu Shih  
Case Number: DHK-1300092  
Contested Domain Name: <gmail.hk>  
Panel Member: Dr. Clive Trotman

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### **1. Parties and Contested Domain Name**

The Complainant is Google Inc., incorporated in Delaware, United States of America.

The Respondent is Kam Piu Shih, whose address is unavailable

The Disputed Domain Name is <gmail.hk>, which was apparently registered by the Respondent on September 14, 2009 with Hong Kong Domain Name Registration Company Limited (HKDNR).

### **2. Procedural History**

The Complaint was filed at the Hong Kong International Arbitration Center (HKIAC) on January 23, 2013. On the same date the HKIAC requested the Registrar to verify particulars of the registration. On the same date the registrar replied confirming the name of the registrant to be Shih Kam Piu, a Hong Kong individual, of unknown address.

The HKIAC verified that the Complaint satisfied the formal requirements of the Hong Kong Internet Registration Corporation Limited (HKIRC) Domain Name Dispute Resolution Policy (the “Policy” or “DNDRP”), the DNDRP Rules of Procedure (the “Rules”), and the HKIAC Supplemental Rules (the “Supplemental Rules”).

On January 29, 2013, the HKIAC formally notified the Respondent of the details of the Complaint and gave notification that February 22, 2013 was the due date for the receipt of a Response. On February 26, 2013 the Parties were notified that no Response had been received.

On March 18, 2013, the Parties were notified that Dr. Clive Trotman had been appointed sole Panelist in this matter pursuant to the provisions of the Policy, the

Rules and the Supplemental Rules. The Panel determines that it has been properly appointed.

### **3. Factual Background**

#### For the Complainant

The Complainant, Google Inc., is a Delaware corporation well-known for the provision of Internet services including search facilities, advertisement placement and the electronic mail service Google Mail, known as GMAIL. Google Inc., holds trademarks for GMAIL including the following:

GMAIL, Hong Kong Trade Marks Registry (HKTMR), registration number 300398548, registered April 7, 2005, class 38;

GMAIL (design and word), United States Patent and Trademark Office (USPTO), registration number 4171862, registered July 10, 2012, class 38;

GMAIL, USPTO, registration number 3150462, registered October 3, 2006, class 38;

GMAIL, USPTO, registration number 3353237, registered December 11, 2007, class 38.

The Complainant also holds 16 domain names that incorporate the string “gmail”, for example, <gmail.com>.

#### For the Respondent

Nothing is known about the Respondent except for the information provided to the registrar for the purpose of registration of the Disputed Domain Name.

### **4. Parties' Contentions**

#### The Complainant

The Complainant contends that the Disputed Domain Name is identical to the registered Hong Kong trademark GMAIL.

The Complainant further contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has no connection or affiliation with the Complainant and has not been licensed to use the Complainant's trademark. The Respondent has not been authorised to register the Disputed Domain Name and has not acquired trademark or service mark rights in the Disputed Domain Name. The Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name.

The Complainant further contends that the Respondent's use of the Disputed Domain Name is in bad faith. It has never been used and the Respondent has not made honest disclosure of his address.

The Disputed Domain Name has been offered for sale on the website "www.sedo.com". The Complainant's Brand Marketing Manager, by Notarized Declaration, states that negotiations for possible purchase of the Disputed Domain Name were conducted through a third party negotiator. The Respondent sought HK\$150,000.

The Respondent is or has previously been listed as the registrant of the domain names <iphone.hk>, <motorola.hk> and <vertu.hk>, these containing the trademarks of well-known mobile telephone suppliers.

The Complainant says that the Respondent has intentionally attempted to attract, for commercial gain, Internet users (including the Complainant) to the Disputed Domain Name with intent to sell it and thereby to profit from the goodwill of the Complainant's GMAIL trademark.

The Complainant has cited previous domain name dispute decisions that it wishes the Panel to consider as possible precedent.

The Complainant requests the transfer to itself of the Disputed Domain Name.

#### The Respondent

The Respondent has not submitted any Response in this proceeding.

### **5. Findings**

According to Paragraph 4(a) 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; and
- (iv) 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.”

**(1). Identical/confusing similarity**

The Complainant has produced copies of documentation sufficient to satisfy the Panel that it has rights in the trademark GMAIL in Hong Kong.

The Disputed Domain Name is <gmail.hk>, of which the country code “.hk” may be disregarded in the determination of confusing similarity. What remains is “gmail”, which is identical to the Complainant’s trademark GMAIL. The Panel finds for the Complainant in the terms of Paragraph 4(a)(i) of the Policy.

**(2). Rights or Legitimate Interests of Respondent**

The Complainant must prove that the Respondent does not have rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has asserted that the Respondent does not have such rights or legitimate interests because the Complainant, as the holder of the registered trademark GMAIL, has not granted the Respondent any authority to use it.

The Respondent has the opportunity to refute the Complainant’s assertions and to demonstrate relevant rights or legitimate interests under the provisions of Paragraph 4(d) of the Policy, as follows:

“(i) before any notice to the Registrant of the dispute, the Registrant’s use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services in Hong Kong; or

(ii) the Registrant (as an individual, business, or other organisation) has been commonly known by the Domain Name, even if the Registrant has acquired no trade mark or service mark rights in Hong Kong; or

(iii) the Registrant has trademark or service mark rights that the mark is identical to the Domain Name the Registrant is holding; or

(iv) the Registrant is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue; or

(v) If the Domain Name is registered in one of the Individual Domain Name Categories, the Domain Name registered must be the Registrant’s own “individual name”, which can be either (1) the Registrant’s legal name, or (2) a name by which the Registrant is commonly known and can include, for example, a pseudonym the Registrant uses if the Registrant is an author or a painter, or a stage name if the Registrant is a singer or actor, or the name of a fictional character if the Registrant has created or can otherwise show it has rights in such fictional character.”

The Respondent has not submitted any claim to have rights or legitimate interests in the Disputed Domain Name. The Panel cannot find any reason to anticipate that the

Respondent may have used the Disputed Domain Name in legitimate business, may have been commonly known by that name, may have used it non-commercially or fairly, or may hold an identical trademark. The Panel finds for the Complainant in the terms of Paragraph 4(a)(ii) of the Policy.

**(3). Bad faith**

The Complainant must prove that the Respondent has registered and is using the Disputed Domain Name in bad faith. Paragraph 4(b) of the Policy sets out illustrative circumstances, without limitation, that shall be evidence of the registration and use of a Disputed Domain Name in bad faith:

“(i) circumstances indicating that the Registrant has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the Complainant who is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant’s documented out-of-pocket costs directly related to the Domain Name; or

(ii) the Registrant has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Name, provided that the Registrant has engaged in a pattern of such conduct; or

(iii) the Registrant has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’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 Registrant’s web site or location or of a product or service on the Registrant’s web site or location.”

The Complainant has produced evidence in the form of copies of a series of emails exchanged on its behalf with the Respondent. The evidence reveals that, commencing on October 2, 2012, certain offers and counter-offers for the Disputed Domain Name passed between the Complainant’s agent or representative and the Respondent. There was also some activity on the Complainant’s behalf through the domain name sales platform “www.sedo.com”. Negotiations ended on or about November 16, 2012, with the Respondent requiring a sale price of HK\$150,000.

The Respondent said in an email of November 15, 2012, that the Disputed Domain Name had special meaning to him and he was not intent on selling it. This claim was qualified, however, by the statement that he would sell it for a high price, and by its placement on “www.sedo.com”. The Respondent also made clear in an email of November 16, 2012 that he knew the ultimate intending buyer to be Google Inc. On the totality of the evidence, including the Respondent’s registration of the Domain Name comprising an internationally recognised trademark of which he could not

reasonably have been unaware, his stated willingness to sell the Disputed Domain Name for what he termed a high price, and his awareness that he was dealing ultimately with the holder of the trademark GMAIL, the Panel finds on the balance of probabilities that the Respondent's primary intention was to sell the Disputed Domain Name profitably to the Complainant. The Panel finds the Respondent's actions to constitute registration in bad faith and use in bad faith within the meaning of Paragraphs 4(b)(i) and 4(a)(iii) of the Policy.

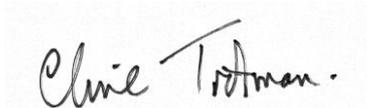
**(4). Individual Category of Domain Name**

The Disputed Domain Name is not registered under an Individual Category of Domain Name and therefore Paragraph 4(a)(iv) of the Policy is not applicable in this case.

**6. Conclusions**

In accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Disputed Domain Name <gmail.hk> is ordered to be transferred to the Complainant.

Dated April 3, 2013

A handwritten signature in black ink that reads "Clive Trotman." The signature is written in a cursive style and is positioned above a horizontal line.

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Dr. Clive Trotman