



.hk Domain Name Dispute Resolution ARBITRATION PANEL DECISION

Complainants: Newegg Trading Limited

Newegg Inc.

Respondent: GUCCN (HONG KONG) GROUP STOCK CO., LIMITED

Case Number: DHK-1300097

Disputed Domain Name: newegg.com.hk

Panel Member: Peter Bullock (Sole Panelist)

1. Parties and Disputed Domain Name

The first complainant is Newegg Trading Limited (the "**Complainant-1**") with registered address at Rm 917 Nan Fung Centre, 264-298 Castle Peak Road, Tsuen Wan, New Territories, Hong Kong.

The second complainant is Newegg Inc. (the "**Complainant-2**", and together with the Complainant-1, the "**Complainants**") with registered address at 16839 E.Gale Avenue, City of Industry, CA 91745, United States of America.

The respondent is GUCCN (HONG KONG) GROUP STOCK CO., LIMITED (the "**Respondent**") with registered address at Rm 1005, 10/F, Ho King Commercial Centre, 2-16 Fa Yuen Street, Mong Kok, Kowloon, Hong Kong.

The disputed domain name is "newegg.com.hk" (the "**Disputed Domain Name**") which was registered in Hong Kong with the Hong Kong Domain Name Registration Company Limited (the "**HKDNR**") on 16 March 2013, a registrar accredited by the Hong Kong Internet Registration Corporation Limited (the "**HKIRC**").

2. Procedural History

The current case originated from another similar case (case number: DHK-1300096), in which 上海新蛋电子商务有限公司 (translation: Shanghai Newegg E-commerce Company Limited) (the "**Original Complainant**") filed a complaint in this matter with the Hong Kong International Arbitration Centre (the "**HKIAC**") on 21 June 2013 (the "**Original Complaint**") pursuant to the HKDNR Domain Name Dispute

Resolution Policy (the "**Policy**"), the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure (the "**Rules**") and the HKIAC Supplemental Rules. The HKIAC notified the HKIRC of the proceedings by email on 25 June 2013. On the same day, the HKIRC notified the HKIAC that the Respondent is the holder of the Disputed Domain Name. On 11 July 2013, the HKIAC notified the Original Complainant by e-mail that the Original Complaint was terminated for failure to pay the case filing fee within the prescribed time limit.

The Original Complainant re-filed the complaint in this matter with the HKIAC on 11 July 2013 (the "**Complaint**") pursuant to the Policy and the Rules. On the same day, the HKIAC notified the HKIRC by e-mail that the case number of the Original Complaint has been changed to the current case (case number: DHK-1300097).

On 16 July 2013, the HKIAC requested the Original Complainant by e-mail to submit the Complaint in English. On 17 July 2013, the Original Complainant resubmitted the Complaint in English. On 18 July 2013, the HKIAC notified the Original Complainant by e-mail that there were certain deficiencies in the Complaint and requested the Original Complainant to revise and resubmit the Complaint. On 24 July 2013, the Complainants filed the amended Complaint (the "**Amended Complaint**") to the HKIAC and sent the same to the Respondent and the HKDNR on the same day.

The HKIAC sent notification of commencement of proceedings, the Amended Complaint and its annexes to the Respondent by email on 24 July 2013. Process has been duly served and no response was submitted by the Respondent on or before the prescribed deadline of 14 August 2013. The HKIAC informed the Respondent of the same by email on 15 August 2013.

On 27 August 2013 the HKIAC informed the parties by email that a sole panelist, Peter Bullock, was appointed to the Panel.

3. Factual Background

For the Complainants

The Complainant-1, a Hong Kong company, is part of the Newegg Group (as defined below).

The Complainant-2, a US company, and together with its affiliates and subsidiaries (the "**Newegg Group**") are the operators of www.newegg.com, an e-commerce website of which the domain name is owned by the Complainant-2.

Newegg Group have filed for, by way of various companies, trade marks of "newegg" and "新蛋" (translation: newegg) in different countries. The Complainant-2 is one such company which is the owner of the trade mark "newegg" (trade mark number:

301860318) in Hong Kong (the "**Trade Mark**") and registered the same on 16 March 2011.

For the Respondent

The Respondent registered the Disputed Domain Name on 16 March 2013 and the website of the Disputed Domain Name is currently inactive. Other than the Respondent's name, address and e-mail, no further information about the Respondent is available.

4. Parties' Contentions

The Complainants

The Complainants assert the following:

- The Disputed Domain Name is identical or confusingly similar to the Trade Mark.
- The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name on the grounds that (i) the Respondent has no connection or affiliation with the Complainants, and (ii) the Complainants have not authorised the Respondent to use the Trade Mark.
- The Respondent has registered the Disputed Domain Name in bad faith due to the Respondent's purpose in selling, renting, or otherwise transferring the Disputed Domain Name registration to the Complainant-2 who is the owner of the Trade Mark, for valuable consideration in excess of the Registrant's documents out-of-pocket costs directly related to the Disputed Domain Name.

The Respondent

The Respondent did not file a response within the stipulated time.

5. Findings

According to paragraph 4(a) of the Policy which is applicable hereto, the Complainant has the burden of proving that:

- (i) the Disputed Domain Name 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 Name; and
- (iii) the Disputed Domain Name 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 Disputed Domain Name.

(1). Identical/confusing similarity

The Complainants have produced evidence that the Complainant-2 is the owner of the Trade Mark since 16 March 2011. The Panel accepts the evidence and finds that the Complainant-2 has rights in the Trade Mark in Hong Kong.

The Panel also finds that the distinctive and dominant element of the Disputed Domain Name is identical to the Trade Mark. The fact that the Trade Mark is used in the Disputed Domain Name in its entirety would likely mislead the public to associate the Disputed Domain Name with the Complainants.

In relation to the use of ".com.hk" in the Disputed Domain Name, it is now well established that the generic top-level domain may be disregarded when evaluating whether a domain name is identical or confusingly similar (*Den Braven Sealants B.V. v. Bross Holding AD* WIPO Case No. D2012-2163).

Thus the Panel is satisfied that the requirement of paragraph 4(a)(i) of the Policy is met.

(2). Rights or Legitimate Interests of Respondent

According to paragraph 4(d) of the Policy, the Respondent may establish rights to or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- the Respondent'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

- the Respondent has been commonly known by the domain name the Respondent is holding; or
- the Respondent has trademark or service mark rights over the mark that 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It is well established that while the Complainants bear the burden of proof in showing the Respondent lacks the rights or legitimate interests in the Disputed Domain Name, such burden of proof shifts to the Respondent once the Complainants have made a *prima facie* case. (*Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455)

The website of the Disputed Domain Name is inactive. The Panel finds that the Respondent's failure to make active use of the Disputed Domain Name is not a *bona fide* offering of goods or services (*Electro-Motive Diesel, Inc. v. Focus Sevice, Inc* WIPO Case No. D2012-1848).

The Complainants assert that the Respondent (i) has no connection or affiliation with the Complainants, and (ii) the Complainants have not authorised the Respondent to use the Trade Mark. Meanwhile there is no evidence to suggest the Respondent has any rights to the Trade Mark in any way.

Having been presented with a *prima facie* case by the Complainant and in the absence of a reply from the Respondent, there is a lack of evidence before the Panel to suggest that the Respondent has established rights or legitimate interests based on any of the grounds mentioned in paragraph 4(d) of the Policy.

In conclusion, the Panel is satisfied that the condition under paragraph 4(a)(ii) is met.

(3). Bad faith

For the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy sets out four non-exhaustive circumstances which shall be evidence of registration and use of a domain name in bad faith. These are as follows:

- circumstances indicating that the Respondent 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 Respondent's documented out-of-pocket costs directly related to the Domain Name; or

- the Respondent has registered the domain name in order to prevent the Complainants 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 Domain Name primarily for the purpose of disrupting the business of a competitor; or
- by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, internet users to the Respondent'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 Respondent's web site or location or of a product or service on the Respondent's web site or location.

There is no evidence to support the Complainants assertion under paragraph 4(b)(i) of the Policy. On the other hand, there is no positive action being undertaken by the Respondent in relation to any of the above listed circumstances. Furthermore, the inactivity of the website of the Disputed Domain Name shows that the Respondent has been holding the Disputed Domain Name passively.

The panel in *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-003) acknowledged that bad faith may not necessarily be a positive action; inactivity by the Respondent can also be construed as bad faith. In the circumstances of the present case where (i) the Respondent failed to reply to the Amended Complaint, (ii) the website of the Disputed Domain Name is inactive and (iii) the Respondent is holding the Disputed Domain Name passively, these elements amount to using the Disputed Domain Name in bad faith.

Furthermore, the Trade Mark is distinctively identifying the Complainants and the Newegg Group so that the choice of the Disputed Domain Name cannot be reasonably explained otherwise than as a reference to the Trade Mark of the Complainant-2. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trade mark of another (*Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230).

Therefore the Panel concludes that the Respondent has registered and used the Disputed Domain Name in bad faith, satisfying paragraph 4(a)(iii) of the Policy.

(4). If the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Disputed Domain Name

The Disputed Domain Name is registered by a body corporate, therefore paragraph 4(a)(iv) of the Policy is not applicable.

6. Conclusions

In light of the foregoing paragraphs, the elements of paragraph 4(a) of the Policy are present in this case.

Domain name is generally transferred back to the complainant upon a successful complaint who is also the holder of the rights to the trade mark. In the present case, this should have been the Complainant-2.

However, since the Complainant-2 is not a Hong Kong company, it cannot be the owner of the Disputed Domain Name pursuant to the applicable regulations (Article 3.6 of the Disputed Domain Name Registration Policies, Procedures and Guidelines). For this purpose, the Amended Complaint requested that the Disputed Domain Name be transferred to the Complainant-1.

The Panel relies on the same reasoning in *Golla Oy v. Yica International Group Co., Limited* (Case No. DHK-1200075), in which the panel transferred the domain name to a Hong Kong agent nominated by the complainant where it has been established that (i) the complainant has met all substantive requirements under the Policy and the Rules in order to claim ownership of the domain name, and (ii) it is inequitable to cancel the domain name as it would lead to a situation in which the complainant would face the risk of another abusive registration from a third party.

Therefore, the Panel accepts the Complainants' request and orders that the Disputed Domain Name be transferred to the Complainant-1.

Dated 9th September 2013



Peter Bullock