



香港國際仲裁中心
Hong Kong International
Arbitration Centre

.hk Domain Name Dispute Resolution ARBITRATION PANEL DECISION

Complainant: **THE HONGKONG LAND COMPANY, LIMITED**
Respondent: **DIGUANGCHANG ZHI**
Case Number: **DHK-1400104**
Contested Domain Name: **landmarkshopping.hk**
Panel Member: **Paul Stephenson**

1. The Parties and Contested Domain Name

The Complainant is THE HONGKONG LAND COMPANY, LIMITED of 8/F., One Exchange Square, Central, Hong Kong being a legal entity incorporated under the laws of Hong Kong SAR.

The Respondent is DIGUANGCHANG ZHI whose physical address for ordinary post is unknown.

The domain name in dispute is <landmarkshopping.hk> registered by Respondent with Hong Kong Internet Registration Corporation through their subsidiary Hong Kong Domain Name Registration Company Limited.

3. Procedural History

The complaint was received by the Hong Kong International Arbitration Centre ("HKIAC") on 21 February 2014 and this was forwarded by HKIAC to Shanghai Meicheng Technology Information Development Co., Ltd ("Shanghai Meicheng")(the Registrar of the disputed domain name) on 24 February 2014. Shanghai Meicheng confirmed to HKIAC that the disputed domain name was registered in the name of the Respondent. The Respondent was eventually served with the Complaint on 5 March 2014 was informed that the Complaint would be examined according to the Hong Kong Domain Name Dispute Resolution Policy Rules of Procedure and the Supplemental Rules of the HKIAC. By the expiry of the deadline for filing a Response to the Complaint which date was fixed for 26 March 2014, no Response had been received by HKIAC.

4. Factual background

The Complaint describes itself as a subsidiary of Hongkong Land Holdings Limited, a company incorporated in Bermuda and a member of the Jardine Matheson Group. The

Complainant's group was asserted to have been founded in Hong Kong in 1889. The Complainant asserts that since 1980 it has used the word "LANDMARK" for the name of a shopping complex in Central, Hong Kong. The complex is said by the Complainant to contain about 208 stores and restaurants and operates websites accessible at www.landmark.hk & www.landmark.com.hk

The Claimant asserts that owing to "extensive use and reputation, the public will associate the "LANDMARK" Mark exclusively with the Complainant and the Complainant's group".

The Complainant has two Hong Kong registered trade marks for LANDMARK being nos. 200309470 & 300002771 for a very wide range of goods and services which include retailing and retail services.

The Respondent is an individual from who no Response has been received.

5. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

(i) The Claimant asserts that the Respondent is acting in bad faith in that the Respondent has taken the registered trade mark LANDMARK and in forming the disputed domain name has simply added the non-distinctive element "shopping". The Complainant asserts that this is a confusingly similar mark.

(ii) The Claimant asserts that there is passing off *vis-à-vis* the trade mark LANDMARK by choosing to "ride on the Complainant's reputation".

(iii) The Complainant asserts that by operating an on-line store by reference to the disputed domain name under the title "Hongkong LandMark Shopping; Cheap Discount Luxury designer wears", the Respondent is trying to mislead visitors into the false belief that there is an affiliation between the Respondent and the Complainant. To this end, the Complainant has provided emails apparently from members of the public who assert, in terms, that they are confused by the disputed domain name and the Respondent's website.

(iv) The Complainant asserts that the Respondent has been engaged in registering what are sometimes termed "abusive domain names" including www.lee-gardens.hk when the Respondent has no connection with or authorization from Lee Gardens in Causeway Bay.

B. The Respondent has made no submissions.

6. Findings

I take the view that this case turns on whether LANDMARKSHOPPING is so similar to the trade mark LANDMARK as to amount to their being a likelihood of confusion on the part of members of the public. There is evidence of actual confusion in that the Complainant has received emails from the public making enquiry as to

whether there is a connection between the Complainant and the Respondent. In any event, I consider that for retailing (and providing land and facilities for retailing), the word "shopping" is a generic term that affords no distinguishing feature to LANDMARK.

I do not need to consider in detail whether the Respondent's activities constitute Passing Off. In this regard, the Complainant has provided little evidence to support reputation and goodwill relying largely on assertion. I also do not need to consider in detail the Respondent's other activities alleged by the Complaint with regard to so-called "abusive domain name registrations". This area of law is well settled by the famous case of Marks and Spencer Plc and others v. One in a Million Ltd. [1998] F.S.R. 265. In that case, the Defendant registered several well known company names as domain names including <marksandspencer.com> <bt.org> <sainsbury.com> and others. In determining that there was liability for passing off, the courts in the UK took cognizance of the fact that the Defendants had a history of registering the domain names of other companies and, rather than use the domain names as part of a business, had tried to sell the domain names back to the true owners or threaten to sell the domain names to third parties. In view of that decision, I consider there is a burden placed on the Respondent to provide an explanation to justify his activity failing which it is proper to draw adverse inferences as to bad faith on the part of the Respondent.

The HKDNR DOMAIN NAME DISPUTE RESOLUTION POLICY provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name must be identical or confusingly similar to a trademark or service mark in Hong Kong in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The element of the disputed domain name that consists of the word SHOPPING serves no purpose in distinguishing the Respondent's name from LANDMARK. Whilst LANDMARK and LANDMARKSHOPPING are not identical, they are sufficiently similar as to be likely lead to deception and confusion when used by a party other than the registered owner of the trade mark LANDMARK or with the consent of that party.

B) Rights and Legitimate Interests

In this case, the Respondent has not provided any explanation as justify his use of the disputed domain name. In the light of the trade mark registrations for LANDMARK I cannot see what justification there could be. The Complainant would seem to have at least a good arguable claim for trade mark infringement.

C) Bad Faith

In the circumstances I am satisfied that the domain name <landmarkshopping.hk> in the registered ownership of the Respondent is a registration obtained in bad faith in that it is likely to lead to deception and confusion in the market place. Visitors to the website could be misled into believing that either the Complainant or one of the other group companies is associated with the web site when no such association exists. This is a misrepresentation. I also consider that the Complaint has made out a *prima facie* case of bad faith on the ground that the Respondent has previously registered an apparently (well) know name of another party and has not justified his action in so doing.

7. Arbitration Decision

The Respondent has not propounded any justification for using the disputed domain name and I am unable to conceive of any legitimate justification for such use.

I take the view that the domain name <landmarkshopping.hk> should be transferred to the Complainant.

Decision

My decision, therefore, is that the domain name <landmarkshopping.hk> now registered in the name of the Respondent SHALL BE TRANSFERRED TO THE COMPLAINANT.



PAUL STEPHENSON
Sole Arbitrator
Dated: 9th April 2014