



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

Complainant: Swire Properties Limited

Respondent: WEB ADMIN

Case Number: DHK-1400107

Contested Domain Name: <pacificplaceshop.hk>

Panel Member: Paul STEPHENSON

1. Parties and Contested Domain Name

The Complainant is SWIRE PROPERTIES LIMITED of 33rd Floor, One Pacific Place, 88 Queensway, Hong Kong being a legal entity incorporated under the laws of Hong Kong SAR.

The Respondent is WEB ADMIN whose physical address for ordinary post is unknown.

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

2. Procedural History

The complaint was received by the Hong Kong International Arbitration Centre (“HKIAC”) on 22 April 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 29 April 2014. Shanghai Meicheng confirmed to HKIAC that the disputed domain name was registered in the name of the Respondent. The Respondent was given until 22 May 2014 to file a Response. The Respondent 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 22 May 2014 deadline for filing a Response to the Complaint, no Response had been received by HKIAC.

3. Factual Background

For the Complainant

The Complainant manages a shopping mall called “Pacific Place” and that name is claimed to have been in use since 1988. The Claimant provides a good deal of factual information about the shopping centre and asserts that such use is extensive both by reference to the number and variety of different stores it contains and to certain awards organised by the Hong Kong Economic Times.

The Complainant has several Hong Kong and PRC registered trade marks for which consist of, or contain, the words PACIFIC PLACE and other registrations in both Hong Kong and the PRC for a logo trade mark which stylises the letters PP. These registrations collectively cover a very wide range of goods and services which include, in particular, supermarket and department store retailing services. A series mark for PACIFIC PLACE in four different fonts registered under no. 1996B00109AA appears to be the most pertinent.

For the Respondent

The Respondent has made no submissions

4. Parties’ Contentions

The Complainant

The Complainant asserts that the only contact information of the Respondent provided on the HKIRC’s WHOIS database is the email address webadmin@swireproperties.com adding that the tail “@swireproperties” is almost identical to the domain name <swireproperties.com> which has been used and registered by the Complainant since 1996. Left uncontroverted, I must agree with the Complainant that “The provision of an invalid email address appears to be a calculated measure on the Respondent’s part to avoid liability by creating an impression that the Disputed Domain name is registered by

the Complainant". There being no connection between the Respondent and the Complainant, the use of so similar "tail ending" of an email address must be regarded as a deliberate kind of what is sometimes called "typosquatting" which in this case is not designed to attract custom, but is rather to seek to push any responsibilities incurred by the Respondent onto the Complainant.

The Respondent

The Respondent has filed no Response.

5. Findings

I take the view that this case turns on whether PACIFICPLACESHOP is so similar to the trade mark PACIFIC PLACE 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 "shop" is a generic term that affords no distinguishing feature to PACIFICPLACE.

According to Paragraph 4a 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 element of the disputed domain name that consists of the word SHOP serves no purpose in distinguishing the Respondent's name from

PACIFICPLACE. Whilst PACIFICPLACE and PACIFICPLACESHOP 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 PACIFICPLACE or with the consent of the registered owner.

(2). Rights or Legitimate Interests of Respondent

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 PACIFICPLACE I cannot see what justification there could be. The Complainant would seem to have a good arguable claim for trade mark infringement.

(3). Bad faith

In the circumstances I am satisfied that the domain name <pacificplaceshop.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 the Complainant is associated with the web site when no such association exists. (Indeed, one email from a customer or potential customer makes this erroneous connection). This is a misrepresentation which on the information available to me seems to be deliberate.

(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 domain name

Given the other findings contained in this decision, this is not a ground that I need to consider.

6. Conclusions

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 <pacificplaceshop.hk> should be transferred to the Complainant.

Decision

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

PAUL STEPHENSON

Sole Arbitrator

Dated 1st June 2014