

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

Complainant: The Hongkong Land Company, Limited
Respondent: Li He Ping
Case Number: DHK-1400115
Contested Domain Name: <landmarkshop.hk>
Panel Member: Jacques de Werra

1. Parties and Contested Domain Name

The Complainant is The Hongkong Land Company, Limited, Hong Kong (“the Complainant”).

The Respondent is Li He Ping, Shen Zen, China (“the Respondent”).

The domain name at issue is <landmarkshop.hk> (“the Disputed Domain Name”) and was registered by Respondent with Chengdu West Dimension Digital Technology Co., Chengdu, China (“the Registrar”).

2. Procedural History

The Complaint was filed with the Hong Kong International Arbitration Center (“HKIAC”) on November 21, 2014. On the same day, the HKIAC transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name and the Registrar transmitted by email to the HKIAC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The HKIAC verified that the Complaint satisfied the formal requirements of the HKDNR Domain Name Dispute Resolution Policy (the “Policy”), the HKDNR Domain Name Dispute Resolution Policy Rules of Procedure (the “Rules”), and the HKIAC Supplemental Rules (the “Supplemental Rules”).

The HKIAC formally notified the Respondent of the Complaint, and the proceedings commenced on November 28, 2014. Pursuant to art. 5 of the Rules, the due date for Response was December 19, 2014. No Response was filed with the HKIAC.

The HKIAC appointed Jacques de Werra as the sole panelist in this matter on December 30, 2014.

The Panel determines that its appointment was made in accordance with para. 6 of the Rules and Articles 8 and 9 of the Supplemental Rules.

3. Factual Background

For the Complainant

The Complainant is a subsidiary of Hongkong Land Holdings Limited which operates a group of companies founded in 1889 which is one of Asia's leading property investment, management and development businesses. The Complainant's group has used for many years the word "LANDMARK" as the name of the business and shopping complex that it developed in Central, Hong Kong, which is one of the best known luxury shopping complexes in Hong Kong.

The Complainant is the owner of various trademarks containing the word "LANDMARK", No 200309470, No 300002771, No 300207404, No 301551177 and 301982917 which have been registered in Hong Kong for various goods and services in classes 3, 14, 16, 18, 19 25, 30, 35, 36, 37, 39, 41, 42, 43, 44 as from 1999 (hereafter the "Trademark").

The Complainant is also the owner of the domain names <landmark.hk> and <landmark.com.hk> which have been registered by Complainant since 2004 and 1997 respectively.

For the Respondent

The Disputed Domain Name was registered by the Respondent on July 27, 2014. It is used as an online store to sell allegedly luxury brand fashion products (whereby the webpages indicate "Fashion Luxury women's Designer from Landmark"). An earlier version of the website associated with the Disputed Domain Name displayed the logo of the Complainant. The Respondent used the email address mail.hk.landmark@gmail.com for customer enquiries on the website associated with the Disputed Domain Name which is an email which closely resembles the Trademark.

4. Parties' Contentions

The Complainant

The Complainant's contentions may be summarized as follows:

- i. The prominent and distinctive part of the Disputed Domain Name reflects the Trademark and is thus identical or confusingly similar to

the Trademark also because the term “shop” is generic and relates to the Complainant’s business activities so that it increases the likelihood of confusion;

- ii. The Respondent has no right or legitimate interest in the Disputed Domain Name because it is not authorized or licensed to use the Trademark, because it is not commonly known by the Disputed Domain Name and because the Disputed Domain Name directs to a website which is clearly used to pass off on the Complainant’s business;
- iii. The Respondent registered and uses the Disputed Domain Name in bad faith because the Respondent was aware of the Trademark when registering the Disputed Domain Name and because it did so with an intention to cause confusion to the public that the Disputed Domain Name is related to or is authorized by the Complainant, for illicit commercial gain which disrupts Complainant’s business by creating confusion.

The Respondent

The Respondent did not file any response in the proceedings.

5. Findings

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 Panel is satisfied that the Complainant has rights to the Trademark in Hong Kong and that the Trademark distinctively identifies the Complainant's luxury shopping activities.

A comparison between the Disputed Domain Name and the Trademark shows that the Disputed Domain Name integrates the Complainant's Trademark to which it adds the word "shop" which is generic and which also refers to the Complainant's business activities so that this addition increases the risk of confusion.

As a result, based on the rights of the Complainant in the Trademark and on the confusing similarity between the Trademark and the Disputed Domain Name, the Panel finds that the conditions of paragraph 4(a)(i) of the Policy are met.

(2). Rights or Legitimate Interests of Respondent

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

- (i) before any notice to it of the dispute, 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; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial 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.

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, previous panels have consistently ruled that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the domain name, once the Complainant has made a *prima facie* showing. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

In the Panel's opinion, the Complainant has made a *prima facie* case against the Respondent. The Respondent indeed registered the Disputed Domain Name which is confusing similar to the Trademark owned by the Complainant and uses it for a business purpose which passes off on the Complainant's business activities and for which it appears that Respondent took measures in order to imitate Complainant's business activities (as particularly resulting from the use of the email address mail.hk.landmark@gmail.com for customer enquiries on the website associated with

the Disputed Domain Name which is an email which closely imitates the Trademark and therefore creates a risk of confusion).

The Complainant has also alleged (without being contradicted) that the Respondent has no right in the Disputed Domain Name, that it is not authorized or licensed to use the Trademark by the Complainant and that the Respondent has not been commonly known by the Disputed Domain Name.

The Panel thus accepts the Complainant's *prima facie* showing and it was consequently up to the Respondent to come forward with evidence of a right to or legitimate interests in the Disputed Domain Name, which has not been done given Respondent's absence of participation in these proceedings.

Accordingly, the Panel finds that the Respondent has no right or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(a)(ii) of the Policy.

(3). Bad faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) circumstances indicating that the respondent 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 respondent has engaged in a pattern of such conduct;
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its website 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 website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. 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 trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

In this case, the Panel holds that the Respondent registered the Disputed Domain Name in bad faith because the Trademark is distinctively identifying the Complainant so that the choice of the Disputed Domain Name cannot be reasonably explained otherwise than as a reference to the Trademark and to the business activities of the Complainant in Hong Kong. This is also supported by the facts of the case which evidence that the Respondent intentionally targeted the Complainant and the Trademark for promoting its own online business activities.

The Panel has further formed the view that the Respondent's intention in registering and using the Disputed Domain Name was to divert Internet users looking for Complainant's business activities to a website other than the Complainant's in order to take advantage of the reputation that the Complainant has built up in the Trademark.

For these reasons, the Panel considers that the Complainant has established that the Disputed Domain Name was registered and is being used in bad faith by the Respondent pursuant to 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 domain name*

The Disputed Domain Name is not registered under an Individual Category of Domain Name so that Paragraph 4(a)(iv) of the Policy does not apply.

6. Conclusions

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 <landmarkshop.hk> be transferred to the Complainant.

Jacques de Werra

Dated January 20, 2015