



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

Complainant: TWITTER, INC., and TWITTER HONG KONG LIMITED

Respondent: CHINESE PROFESSIONAL STANDARD CO.

Case Number: DHK-1400116

Contested Domain Name: <twitter.com.hk>

Panel Member: The Honourable Neil Anthony Brown QC

1. The Parties and Contested Domain Name

The Complainants are TWITTER, INC., of 1355 Market Street, Suite 900 San Francisco, California 94103, United States of America and TWITTER HONG KONG LIMITED of C/- Baker & McKenzie, 1401 Hutchison House, 10 Harcourt Road, Hong Kong.

The authorized representative of the Complainants is Wilkinson & Grist, 6 th Floor, Prince's Building, Chater Road, Hong Kong.

The Respondent is Chinese Professional Standard Co. of 4F, 646 Nathan Road, Mong Kong, Hong Kong.

The authorized representative of the Respondent is Jia Jian Su of 4F, 646 Nathan Road, Mong Kong, Hong Kong.

The domain name at issue is <twitter.com.hk>. The domain name is registered with Speedy Group Corp Limited the email address of which is enquiry@domain.net.hk.

2. Procedural History

On November 25, 2014 the Complaint was filed with the Hong Kong International Arbitration Centre ("the Centre"). The Centre acknowledged receipt of the Complaint on November 25, 2014 and received the appropriate case filing fee by bank transfer on November 27, 2014.

On November 25, 2014, the Centre transmitted by email to Speedy Group Corp. Limited a request for registrar verification in connection with the registrant of the disputed domain name and on November 27, 2014 it reiterated the request.

On November 27, 2014, the Hong Kong Internet Registration Corporation Limited, ("the HKIRCL") as a domain name registry, transmitted by email to the Centre that the domain

name holder of the disputed domain name is a business registered in Hong Kong named Chinese Professional Standard Co. and referring to the WHOIS at <https://www.hkirc.hk/whois/whoi.jsp> for contact information of the Administrative and Technical Contacts.

On December 1, 2014, the Centre informed the Complainants by email that the Complainant Twitter Inc., to whom transfer of the disputed domain name was sought in the Complaint, was described in a manner indicating that it was not a commercial entity registered in the Hong Kong Special Administrative Region, which was inconsistent with the requirements of Article 3.6 of the Domain Name Registration Policies, Procedures and Guidelines for .hk domain names. Accordingly the Centre invited the Complainant to revise and resubmit its Complaint on or before December 8, 2014.

On December 8, 2014 an amended Complaint with its annexures was filed with the Centre. The Centre acknowledged receipt of the amended Complaint and its annexures on December 8, 2014.

On December 8, 2014 the Complainant delivered a copy of the Amended Complaint and annexures to the Respondent by sending the same by email to hostlog@infinitytechnologies.com.hk, the email address of Chinese Professional Standard Co in the WHOIS of the Hong Kong Internet Registration Corporation Limited.

The Centre verified that the Complaint satisfied the formal requirements of the HKDNR Domain Name Dispute Resolution Policy adopted by the Hong Kong Domain Name Registration Company Limited on February 22, 2011 (the "Policy" or "HKDRP"), the HKDNR Domain Name Dispute Resolution Policy Rules of Procedure ("the Rules of Procedure"), approved by the HKDNR on February 22, 2011 and the HKIAC Supplemental Rules.

On December 9, 2014 the Centre served on the Respondent by email to arthurso@yahoo.com, hostlog@infinitytechnologies.com.hk and postmaster@twitter.com.hk, the Notification of Commencement of Proceedings and that it had 15 business days, on or before December 30, 2014, to submit a Response to the Complaint in accordance with the Dispute Resolution Policy, the Rules of Procedure and the HKIAC Supplemental Rules. The Amended Complaint and its annexures were attached to the Notification.

A Response was received from the Respondent by the Centre within the required period of time. The Response indicated that the Respondent was Chinese Professional Standard Co. and that its authorised representative was Jia Jian Su.

On December 29 2014, the Centre appointed The Honourable Neil Anthony Brown QC as Panelist in the administrative proceeding. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rule 7.

The Panel finds that the Centre has performed its obligations under Rule 2(a) of the Rules of Procedure" to employ reasonably available means calculated to achieve actual notice to Respondent". Accordingly, the Panel is able to issue its decision based on the documents

submitted and in accordance with the Dispute Resolution Policy, the Rules of Procedure and the HKIAC Supplemental Rules and any rules and principles of law that the Panel deems applicable.

3. Factual background

The Complainants are two companies in the Twitter associated Group of companies who own and operate the famous Twitter means of real time information networking and a wide variety of telecommunications and internet services. The First Complainant which is the parent company has used the name TWITTER as is trade and business name since 2006. Since then, some 300 billion tweets have been sent internationally via its services. The TWITTER mark has become famous throughout the world. Its Hong Kong subsidiary, Twitter Hong Kong Limited, was incorporated on October 17, 2014.

The Complainants hold two trademark registrations for TWITTER in Hong Kong, being registered with the Trade Marks Registry, Intellectual Property Department, The Government of the Hong Kong Special Administrative Region. They are:

- (a) Registered trademark number 300980299 for TWITTER, registered in the name of the First Complainant on October 25, 2007; and
- (b) Registered trademark number 302310524 for TWITTER, registered in the name of the First Complainant on July 11, 2012.

The Respondent is a business consulting firm. The disputed domain name was registered on February 6, 2009. At various times during the conduct of the proceeding the domain name has resolved to www.hongkongwebdesign.com.hk owned and operated by Infinity Technologies Limited and the user has been referred to the home page of Infinity Technologies Limited. The email address of the Respondent Chinese Professional Standard Co in the WHOIS of the Hong Kong Internet Registration Corporation Limited is hostlog@infinitytechnologies.com.hk.

4. Parties' contentions

A. COMPLAINANT.

Complainant made the following contentions.

1. The disputed domain name was registered by the Respondent on February 6, 2009.
2. The Complainant relies on two trademarks for TWITTER registered in Hong Kong.

Trade Mark No.	Trade Mark	Class No.	Owner's Name	Status
300980299	TWITTER	38, 41, 45	Twitter, Inc.	Registered
302310524	TWITTER	9, 35	Twitter, Inc.	Registered

3. TWITTER is the trade/ business name used and owned by the Complainant since Twitter, 2006.

4. Complainant owns and operates the Twitter real-time information network and a wide variety of telecommunication and internet services and has done so since 2006. The mark TWITTER is used in connection with the ever-expanding business of the Complainants, including telecommunication services including but not limited to text messaging, chat rooms, blogs and social media websites.

5. The TWITTER mark is famous worldwide, is an extremely well known trademark, and a famous mark around the world including in Hong Kong.

6. The disputed domain name is identical to the TWITTER trademark in Hong Kong in which the Complainants have rights.

7. The Respondent has no rights or legitimate interests in respect of the disputed domain name

8. When the disputed domain name was accessed on 24 October 2014, it was automatically diverted to a webpage under www.hongkongwebdesign.com.hk which is owned and operated by Infinity Technologies Limited. When the disputed domain name was accessed on 5 November 2014, the diversion was removed but the user was referred to the home page of Infinity Technologies Limited at <http://www.hongkongwebdesign.com.hk/index.html>.

9. The Respondent registered the disputed domain name in bad faith. The use of the domain name shows that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or any other website as diverted by the Respondent by creating a likelihood of confusion with the TWITTER mark of Twitter, Inc. as well as misleading Internet users into believing that the Respondent's website and/or the services offered therein (by the Respondent, Infinity Technologies Limited, or any other party) are provided or endorsed by Twitter, Inc. The actions that the Respondent has taken or

could potentially take may serve to injure the good will and reputation Twitter, Inc. has built over the years.

10. On 27 October 2014, the Complainants' authorized representative received an email reply from Arthur So arthur@infinitytechnologies.com.hk acknowledging the Complainants' authorized representative's contact (email) with an offer to sell the disputed domain name to the Respondent at USD80,000. This clearly shows that the Respondent has registered the disputed domain name primarily for the purpose of selling it for valuable consideration to the Complainants with knowledge that Twitter, Inc. is the proprietor of the TWITTER mark.

B.RESPONDENT.

Respondent made the following contentions.

1. The Respondent registered the disputed domain name several years before Twitter Hong Kong Limited was founded and before the Complainant was famous in Hong Kong.
2. Twitter is a common English word and used by others in their company names.
3. The Respondent was established as a business consulting company and the word "twitter" is related to the nature of its business.
4. Infinity Technologies is the appointed IT service provider of the Respondent.
5. The domain name is parked in transition and points to the service provider's website which is common industrial practice.
6. No implication can be drawn from the fact that the Respondent replied with an offer price, as the Respondent was merely politely communicating to the Complainant and the offer is not yet communicated to the Respondent.

5. Findings and Discussion of the Issues

The Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

There is an additional requirement if the registrant is an individual person, namely that the Registrant does not meet the registration requirements for that individual category of Domain Name.

A) Identical / Confusingly Similar

The first question that arises is whether the Complainants (hereafter referred to as “the Complainant”) has a trademark or service mark in Hong Kong on which it can rely. The Complainant has adduced evidence that the Panel accepts to the effect that the Complainant has trademark rights on which it can rely with respect to the disputed domain name.

The Complainant holds two trademark registrations for TWITTER in Hong Kong, being registered with the Trade Marks Registry, Intellectual Property Department, The Government of the Hong Kong Special Administrative Region. They are:

- (c) Registered trademark number 300980299 for TWITTER, registered in the name of the First Complainant on October 25, 2007; and
- (d) Registered trademark number 302310524 for TWITTER, registered in the name of the First Complainant on July 11, 2012.

The Complainant has adduced evidence of these trademark registrations which the Panel accepts and they establish the Complainant’s trademark rights to TWITTER in Hong Kong. The First Complainant has rights in the trademarks as they are registered in the name of the First Complainant. The Second Complainant has rights in the trademarks as it is the Hong Kong subsidiary of the First Complainant and is licensed by the First Complainant to use the trademarks in its business in Hong Kong.

Accordingly, the Complainant has proved that it has a trademark on which it may rely.

The second question that arises is whether the disputed domain name may be said to be identical or confusingly similar to the TWITTER trademark. The Panel finds that the disputed domain name is identical to the TWITTER trademark as, in making this comparison between the domain name and the trademark, the TLD suffix “.com.hk” is ignored and the objective internet user would observe that the domain name embodies the entire trademark with no amendments or additions.

The Complainant has therefore established the first of the three elements that it must establish.

B) Rights and Legitimate Interests

It is now well established, as it is in the analogous UDRP, that the Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a) (ii) of the Policy and then the onus of proof shifts to the Respondent to show it does have rights or legitimate interests. There are many UDRP and HKDRP decisions to that effect, one of the most notable of the former of which is *Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) where it was held that a complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a) (ii) of the UDRP before the onus of proof shifts to the respondent to show that it does have rights or legitimate interests in the domain name).

Having regard to the evidentiary case presented on behalf of the Complainant, the Panel finds that the Complainant has made out a *prima facie* case that arises from the following considerations:

(a) The Respondent has chosen to take the Complainant's very prominent TWITTER trademark and to use it in its domain name without any amendments or additions;

(b) the Respondent had no authority to register the domain name and to use it as it has done, namely to resolve to a website of a web design firm featuring the Complainant's TWITTER mark and to retain the domain name for its own purposes;

(c) the Respondent is not registered on the Hong Kong Companies Registry as a company, as a business registration, as being engaged in any activity that would produce a result from a Google search or as having any trademark interest in the data base of the Hong Kong Trade Marks Registry

(d) The Respondent has registered the domain name and used in the manner just described without the consent or approval of the Complainant.

These matters go to make out the *prima facie* case against the Respondent and it is then up to the Respondent to rebut that case. The Panel has examined carefully the grounds on which the Respondent maintains that it has a right or legitimate interest in the domain name and finds that the Respondent has not rebutted the *prima facie* case against it.

The Panel therefore finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent first maintains that the Respondent registered the domain name before Twitter became famous in Hong Kong. That is not so, as the evidence is that the Complainant started its business under the TWITTER name in 2006 and that it quickly rose to prominence after that. It is clear that it was well established and famous before the domain name was registered on February 6, 2009. In this regard the Panel notes that the Complainant's Registered trademark number 300980299 for TWITTER was registered in Hong Kong in the name of the First Complainant on October 25, 2007, prior to the registration of the disputed domain name on February 6, 2009.

To rebut the *prima facie* case, the Respondent must show that it has a right or legitimate interest in the domain name, either under one of the criteria specified or because of some other factor. It is nothing to the point in that regard that the Twitter subsidiary company in Hong Kong was incorporated some years later if the TWITTER mark and brand were known earlier. The fame of the Twitter brand and name have been such that the Panel has no difficulty in finding that it was well known in Hong Kong prior to February 6, 2009.

Secondly, the Respondent says that the word "twitter" is a common English word. The word of course, has had and still has in appropriate circumstances a specific meaning. But it has also acquired a meaning associated with the Complainant and as signifying its services and that meaning is far and away the most dominant and overwhelming meaning of the word today and since the Complainant gained prominence. In any event, the Complainant has trademarks for TWITTER, the domain name is identical to it and the Respondent must show why, despite this, it has a right to use the Complainant's trademark in this way or a legitimate interest in the domain name using that trademark. The reason advanced by the Respondent does not show a right or legitimate interest in the domain name.

Thirdly, the Respondent says it is a business consultant and that the word “twitter” is related to the nature of its business. The Respondent does not show how this is so and it is inherently unlikely that the word is significant for that purpose. But again, it does not matter if it is related in that manner or not. The fact alleged by the Respondent at best gives rise to a wish or convenience; it says nothing about a right to the domain name or an interest in it, when the Respondent has clearly taken the Complainant’s trademark and used it without authority.

The only other ground that the Respondent relies on, as the Panel understands its submission, is that it is “common industrial practice” to park a domain name. It is regrettable that it is now too common a practice to take a prominent trademark and use it in a domain name for a dubious purpose as has occurred in the present case. That, however, does not make it right or give the domain name holder any legitimate interest in the domain name. This ground as alleged does not give rise to either.

The obligations on a domain name holder to show a right or legitimate interest may be made clearer to the Respondent if the Panel were to state that several grounds for a right or legitimate interest are set out in the Policy. They are, in general terms, that the domain name is for a *bona fide* offer of goods or services, that the Respondent is commonly known by the domain name, has a trademark identical to the domain name or is making a legitimate non-commercial or fair use of the domain name or that the domain name is the Respondent’s individual name or pseudonym. But the Respondent has not adduced any evidence or submission as to why it should be brought within any of those categories.

Nor, in the light of the evidence of the fame of the Complainant’s mark, could the Respondent conceivably show that it has such a right or legitimate interest in the domain name on any other basis.

The Respondent has thus not rebutted the *prima facie* case against it.

Accordingly, the Complainant has made out the second of the three elements that it must establish.

C) Bad Faith

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith.

That case may be made out if there are facts coming within the provisions of paragraph 4(b) of the Policy. That paragraph sets out a series of circumstances that are to be taken as evidence of the registration and use of a domain name in bad faith, namely:

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

(ii) Respondent has registered the disputed domain name in order to prevent Complainant from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location."

However, those criteria are not exclusive and Complainants in these proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression and frequently do so.

Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons.

First, the Respondent registered the disputed domain name in bad faith because it must have known at all times that it had no right to register it because of the existence of the famous TWITTER trademark. The Panel notes again that one of the Complainant's trademarks for TWITTER was registered before the Respondent registered the disputed domain name. That trademark can only be described as famous as that is what it is; it is a household name associated with communications and has been so for many years, in many jurisdictions including Hong Kong. It is therefore inconceivable to imagine that the Respondent believed on reasonable grounds that he was entitled to take the TWITTER trademark without permission, use it to register a domain name and to use the domain name so that it resolved to www.hongkongwebdesign.com.hk owned and operated by Infinity Technologies Limited and to refer the user to the home page of Infinity Technologies Limited.

The facts also bring the case squarely within the provisions of paragraph 4(b) (i) of the Policy as they show the Respondent attempted to sell the domain name for a substantial sum of money. This enables the Panel to draw the inference that at the time the Respondent registered the domain name it intended to sell it to the Complainant "for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain name."

Clearly, the case also comes within paragraphs 4(b) (iii) of the Policy because the prime reason for the entire process engaged in by the Respondent must have been to disrupt the business of the Complainant and reducing the potential business of Twitter in Hong Kong.

One of the consequences of the registration and use of the domain name is also the potential to create confusion as to whether the website at www.hongkongwebdesign.com.hk is endorsed by or affiliated with the Complainant, bringing the case within paragraph (b) (iv) of the Policy.

Finally, having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name and using it in the manner described, the Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

6. Decision

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name, <twitter.com.hk> be TRANSFERRED to the Complainant Twitter Hong Kong Limited.

The Honourable Neil Anthony Brown QC

Dated: January 19, 2015