

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

Complainant: Television Broadcasts Limited

Respondent: Samuel Chan

Case No. DHK-1500126

Contested Domain Name: <mytvb.hk>

Panel Member: The Honourable Neil Anthony Brown QC

1. The Parties and Contested Domain Name

The Complainant is Television Broadcasts Limited of Legal and Regulatory Department, 10/F., Main Building, TVB City 77 Chun Choi Street, Tsuenh Kwan O Industrial Estate, Kowloon, Hong Kong.

The Authorized Representative of the Complainant is Ms. Jane Ting, Senior Legal Counsel, Legal and Regulatory Department, 10/F., Main Building, TVB City 77 Chun Choi Street, Tsuenh Kwan O Industrial Estate, Kowloon, Hong Kong, Hong Kong.

The Respondent is Samuel Chan, whose address is GUANG ZHOU SHI HAI ZHU QU, China 510000 and whose email address is taotao@vip.qq.com. Respondent has not provided details of an authorized representative in this proceeding.

The domain name at issue is <mytvb.hk> and the Registrar of the domain name is Topnets Technology Co., Ltd Customer Service Centre, whose address is 2/F, Hualian Building, Shennan Middle Road Futian District, Shenzhen, China Technical Centre: 7/F, Bright Way Tower, 33 Mongkok Road, Kowloon, Hong Kong and whose email address is: domain@idcicp.com.

2. Procedural History

On November 26, 2015 the Complaint was filed with the Hong Kong International Arbitration Centre ("the Centre"). The Centre acknowledged receipt of the Complaint on November 26, 2015 and received the appropriate case filing fee which was acknowledged on December 1, 2015.

On November 26, 2015, the Centre transmitted by email to the Registrar, Topnets Technology Co., Ltd a request for registrar verification in connection with the registrant of the disputed domain name and on December 9, 2015 the Registrar replied, verifying that the registrant of the domain name is Respondent, that his address is GUANG ZHOU SHI HAI ZHU QU, China 510000 and that his email address is taootao@vip.qq.com. The Registrar also confirmed that the Domain Name Dispute Resolution Policy for .hk and .香港 domain names is applicable to the current dispute.

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 ("HKDNR") 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 effective from 1 March 2011.

On December 10, 2015 the Centre served on the Respondent by email to taootao@vip.qq.com , the Notification of Commencement of Proceedings and gave notice that the Respondent had 15 business days, on or before January 4, 2016, to submit a Response to the Complaint in accordance with the Policy, the Rules of Procedure and the HKIAC Supplemental Rules. The Complaint and its annexures were attached to the Notification.

No Response was received from the Respondent by the Centre by the due date.

On January 5, 2016, the Centre notified the Complainant by email, with copies to the Respondent, that the Centre had not received a Response from the Respondent within the required period of time and that the Centre would shortly appoint a Panelist for this matter.

On January 11, 2016, 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 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 Complainant is a Hong Kong company listed on the Hong Kong Stock Exchange engaged in the business of television broadcasting, video rental, programme production and related services. It is the largest producer of Chinese language programming in the world. Its Chinese programmes are internationally acclaimed and are dubbed into other languages and are distributed to more than 30 countries, accessible to over 300 million households. The Complainant is the owner of several trade and service marks for TVB and MyTV registered in Hong Kong and internationally that it uses in connection with its

business of disseminating television programmes and related activities. As a result of the extensive and international provision of the Complainant's services using its trademarks, the trademarks have become particularly well known and associated with the Complainant's services.

Respondent appears to be an individual who lives in China and whose address is GUANG ZHOU SHI HAI ZHU QU, China 510000. He registered the contested domain name on August 5, 2015 and used it without the permission of Complainant to set up an online social commentary website so that its users could view Complainant's television programmes on the internet.

PARTIES' CONTENTIONS

A. COMPLAINANT.

Complainant made the following contentions.

1. The contested domain name is confusingly similar to Complainant's trademark MyTV and TVB.

The domain name in dispute is <mytvb.hk>. By comparing the disputed domain name with Complainant's trademarks TVB and MyTV, it is apparent that the disputed domain name <mytvb.hk> is confusingly similar to trademark the TVB and MyTV trademarks.

One of the reasons why the disputed domain name is confusingly similar to the trademarks is that Complainant uses the trademarks as the sign and mark of its various satellite television channels such as TVBJ, a Chinese-language television channel that has distributed its product in Australia and Singapore since 2000 and TVBS-E, a Chinese language television channel distributes its product in the UK and Europe.

Complainant's trademarks have become well known rights due to the goodwill and reputation accumulated through extensive use, advertising and promotion of the mark.

Respondent registered the contested domain name on August 5, 2015 and has used it set up various archives and classify Complainant's programmes by different categories and broadcast years. Thus, its website was deliberately created by the Respondent to offer the public an unauthorized avenue of viewing Complainant's programmes.

It is obvious that Respondent is taking advantage of Complainant's goodwill and reputation in the marks to counterfeit Complainant's identity and mislead the public to believe that the website is associated with Complainant, which it is not.

The domain name in of course also confusingly similar to other marks in the Complainant's extensive family of TVB and MyTV marks.

Respondent's registration of the domain name is also fraudulent and could cause confusion to the public and mislead them to think that Complainant and/or its official websites, such as www.tvb.com are associated with the domain name in dispute or that Complainant has authorized Respondent to register and use the contested domain name, which it has not.

2. Respondent has no rights or legitimate interest in respect of the contested domain name.

Respondent is not in any way connected, associated or affiliated with Complainant and Complainant has not authorized, endorsed or otherwise permitted Respondent to register the domain name in dispute or use Complainant's trade mark or any variation thereof.

There is no evidence that the Respondent has been commonly referred to as the disputed domain name, and there is no reason why Respondent might reasonably be said to have any rights or legitimate interests in registering or using the disputed domain.

By copying and using Complainant's registered trademarks and offering to internet users the opportunity to view Complainant's programmes without authorization, Respondent has infringed the copyright, trademark and other intellectual property rights of Complainant. Respondent receives revenue or other benefits from advertisers' posting advertisements on the website and the Complainant contends that Respondent is thus not making any legitimate, non-commercial or fair use of the domain name in dispute.

3. Respondent has registered and used the contested domain name in bad faith.

The domain name in dispute was registered in 2015 while Complainant has been widely publicizing TVB as its name since 1967 and has commenced to use MyTV since 2008. Respondent uses the domain name in dispute for the website where it provides Complainant's programmes for its users' viewing. Respondent should be inferred to have intentionally chosen the contested domain name for its website with full knowledge of Complainant's business and trademark. It is therefore inconceivable that at the time of registering the disputed domain name Respondent was not aware of Complainant's business and its trade mark.

Complainant engages its programme content, licensing and distribution business. In particular, Complainant distributes its programme content via MyTV and GOTV service in Hong Kong. Besides, Complainant has licensed VOD rights of its programmes to (a) PCCW Limited in Hong Kong through TVB.COM; (b) www.astro.com.my in Malaysia via TVBI and also grants its VOD and on-line streaming rights of its programmes to TVBC for sub-licensing in PRC; and (c) TVBI via TVB Anywhere services. Respondent, by setting up the platform for its users' free sharing, distribution and viewing of Complainant's works online, is in fact using the contested domain name in dispute in direct competition with Complainant's business.

Respondent's use of the Website has seriously prejudiced Complainant's commercial interests. Respondent has distracted customers from Complainant, who, instead of buying video products, subscribing VOD services or visiting Complainant's authorized website, choose to visit Respondent in order to get Complainant's programme contents for free at the website. Respondent's use of the Website has therefore adversely affected Complainant's business and income.

It is obvious that Respondent is riding on the reputation of Complainant and uses the contested domain name deliberately to attract Internet users to Respondent's website for commercial benefits. By making use of Complainant's works, and by creating a likelihood of confusion with Complainant's trademarks, Respondent has misled the public to believe

that the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location are associated with Complainant, or with its authorization.

B. RESPONDENT.

Respondent did not submit a Response in this proceeding.

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.
- (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.

The Panel takes the view that this requirement does not apply in the present case, as the contested domain name was not registered in the ".idv.hk" category. The Panel will therefore not make any further observations on that requirement.

(i) Identical or Confusingly Similar

The first question that arises is whether 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 in Hong Kong on which it can rely with respect to the contested domain name.

The Complainant holds numerous trademark registrations, including registrations 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 19960823AA for TVB, registered in the name of the Complainant on June 8, 1992;
- (b) Registered trademark number 302139372 for MyTV, registered in the name of the Complainant on January 16, 2012; and
- (c) Numerous other registered trademarks for TVB and MyTV in the name of the Complainant established by evidence adduced by the Complainant and which the Panel accepts.

The Complainant's evidence of these trademark registrations establishes the Complainant's trademark rights to TVB and MyTV in Hong Kong.

Accordingly, the Complainant has proved that it has trademarks on which it may rely in this proceeding.

The second question that arises is whether the disputed domain name may be said to be identical or confusingly similar to the TVB and MyTV trademarks. The Panel finds that the <mytvb.hk> disputed domain name is confusingly similar to each of the two trademarks. It is confusingly similar to the TVB trademark because the domain name incorporates the whole of the trademark and the objective bystander would naturally assume that the domain name was meant to invoke the use by an internet user of Complainant's famous television and related services provided under the trademark and because the domain name also incorporates another of the Complainant's trademarks, MyTV, which is likewise famous for the dissemination of the Complainant's television and related services provided under that trademark. The <mytvb.hk> domain name is also confusingly similar to the MyTV trademark because it incorporates the whole of the trademark and the objective bystander would naturally assume that the domain name was meant to invoke the use by an internet user of Complainant's famous television and related services provided under the trademark and because the domain name also incorporates another of the Complainant's trademarks, TVB, which is likewise famous for the dissemination of the Complainant's television and related services provided under that trademark.

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

(ii) Rights and Legitimate Interests

It is now well established, as it is in the analogous Uniform Domain Name Dispute Resolution Policy ("theUDRP"), 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 detailed and strong 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 TVB and MyTV trademarks and to use them 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 set up an online social community website for internet users to view Complainant's television programmes, so that large volumes of Complainant's works are distributed on the website by Respondent without Complainant's authorization, causing the Complainant loss and damage;
- (c)The Respondent has registered the domain name and used it in the manner just described without the consent or approval of the Complainant;
- (d)The Respondent is not in any way connected, associated or affiliated with the Complainant;

(e) There is no evidence that the Respondent has been commonly referred to as the disputed domain;

(f) By copying and using the Complainant's registered trademarks and offering internet users the opportunity to view the Complainant's programmes without authorization, the Respondent has infringed the copyright, trademark and other intellectual property rights of the Complainant. The Respondent must be assumed to receive revenue or other benefits from advertisers posting advertisements on the website; and

(g) By using his domain name in the way described, the Respondent in effect is endeavouring to disseminate illegally and free of charge to the user, the same services that the Complainant is providing lawfully to its own customers, by means of which it earns its legitimate income. To do so by using the Complainant's trademarks cannot give rise to a right or legitimate interest in the domain name.

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 Respondent has not attempted by filing a Response as it was notified it had the right to do, or by any other means, to rebut the *prima facie* case against it.

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

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

(iii) 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 TVB and MyTV trademarks. Both of the Complainant's trademarks were registered before the Respondent registered the disputed domain name. Because of the detailed and extensive case presented on behalf of the Complainant, the trademarks can only be described as famous as that, on the evidence, is what they are. It is therefore inconceivable to imagine that the Respondent believed on reasonable grounds that he was entitled to take the famous TVB and MyTV trademarks, without permission and to use them for any purpose, to register a domain name and to use the domain name in effect to steal the Complainant's programmes and breach the Complainant's copyright, trademark and other intellectual property rights as he has done.

The case therefore comes within paragraph 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 wherever internet users had access to the Respondent's website, knowing that he was denying the Complainant the opportunity to receive income it was entitled to receive as part of its business.

The case also comes within paragraph 4 (b) (iv) of the Policy as one of the consequences of the registration and use of the domain name is the potential to create confusion as to whether the website at www.mytvb.hk is endorsed by or affiliated with the Complainant. Internet users must wonder whether the services offered at that infringing website are services being offered by the Complainant as they are in effect being offered under the Complainant's trademarks and are services for which Complainant is famous for providing.

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. In particular, by using his domain name in the way described, the Respondent in effect is endeavouring to disseminate illegally and free of charge to the user, the same services that the Complainant is providing lawfully to its own customers, by means of which it earns its legitimate income. To do so by using the Complainant's trademarks means that the domain name has been registered and used in bad faith.

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, <mytvb.hk>, be TRANSFERRED to the Complainant Television Broadcasts Limited.

The Honourable Neil Anthony Brown QC

Dated: January 19, 2016