



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

Complainant: Nike Innovate C.V. and Nike Hong Kong Limited

Respondent: UBN Limited

Case Number: DHK-1600129

Contested Domain Name: NIKE-STORE.COM.HK

Panel Member: Dr. Christopher To

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### **1. Parties and Contested Domain Name**

The Complainants are Nike Innovate C.V. of One Bowerman Drive, Beaverton, OR 97005, the United States of America and Nike Hong Kong Limited of 29/F., Exchange Tower, 33 Wang Chiu Road, Kowloon Bay, Hong Kong. They are collectively referred to this Complaint as “Complainant” or “NIKE”.

The Respondent is UBN Limited of BeijingShi, Hai Dian Qu FuXingLu 8 Hao, China 100008. (中華人民共和國, 北京市, 海淀区, 復興路 8 号, 邮编 100008)

The Contested Domain Name is <nike-store.com.hk> (“*Disputed Domain Name*”). The Registrar of the *Disputed Domain Name* is the Eranet International Limited, which is located at 6B XiHai Building, No. 221, Renmin E Road, Xiang Zhou District, Zhuhai, GD 519000, China.

(中華人民共和國, 广东省, 珠海市, 沧州区, 人民东路 221 号, 西海大厦 6B)

### **2. Procedural History**

On 16 January 2016, pursuant to Hong Kong Domain Name Registration Company Limited (“*HKDNR*”) Domain Name Dispute Resolution Policy (“*Policy*”), the *HKDNR* Domain Name Dispute Resolution Policy Rules of Procedure (“*Rules*”) and the Hong Kong International Arbitration Centre Supplemental Rules (“*Supplemental*”

**Rules**”), the Complainant submitted a compliant to the Hong Kong International Arbitration Centre (“**HKIAC**”). The Complainant elected to have the case in question be dealt with by a single member panel and that the language of proceedings shall be in the English language.

On 18 January 2016 (09:49), the **HKIAC** notified the Eranet International Limited (“**the Registrar**”) of the **Disputed Domain Name** proceedings by email. From this, the **HKIAC** requested the **Registrar** to provide the following information namely:

- “1. Whether the domain name is registered with your company;
2. Whether the Respondent “**UBN Limited**” is the Registrant or holder of the disputed domain name;
3. Whether the Domain Name Dispute Resolution Policy for .hk and .香港 domain names is applicable to the current dispute;
4. Whois information regarding the disputed domain name;
5. Please provide us the Status of the domain name;”

In the mean time, the **HKIAC** reminded the **Registrar** to take appropriate action towards the **Disputed Domain Name**, namely, <nike-store.com.hk> in accordance with the rules stipulated by the **Policy**, such as prohibiting the **Disputed Domain Name** from being transferred to a third party.

On 18 January 2016 (10:00), the **HKIAC** notified the Complainant that they received the Complaint concerning the **Disputed Domain Name**, namely, <nike-store.com.hk>. The **HKIAC** also stated that:

*“We have notified the concerned Registrar of your complaint. Upon receipt of the Registrar’s confirmation on the WHOIS information, we shall proceed to review your Complaint and let you know whether it is in administrative compliance with the Domain Name Dispute Resolution Policy (“DNDRP”). If it is in compliance, we shall forward your complaint to the Respondent and formally commence the proceedings in accordance with Paragraph 4(b) of the **Rules**. If it is*

*not in compliance and in accordance with Paragraph 4(b) of the **Rules**, you will be requested to rectify the deficiencies within 5 business days after our notification of such deficiencies.”*

On 18 January 2016 (10:56), the **Registrar** sent an email to the **HKIAC** notifying the **HKIAC** in the same sequence of questions previously asked by the **HKIAC** via email on 18 January 2016 (09:49):

- “1. *yes*
2. *yes . and 李祥 is owner*
3. *yes*
4. *Domain Name : NIKE-STORE.COM.HK*

*Domain Status: Active*

*Contract Version: Refer to registrar*

*Registrar Name: ERANET INTERNATIONAL LIMITED*

*Registrar Contact Information: Email:info@todaynic.com*

*Reseller:*

*Registrant Contact Information:*

*Company English Name (It should be the same as the registered/corporation name on your Business Register Certificate or relevant documents): UBN LIMITED*

*Company Chinese name: UBN LIMITED*

*Address: BEIJINGSHIHAIIDIANQUFUXINGLU8HAO 100008*

*Country: CN*

*Email: [jjxp@outlook.jp](mailto:jjxp@outlook.jp)*

*Domain Name Commencement Date: 28-10-2015*

*Expiry Date: 28-10-2016*

*Re-registration Status: Complete*

*Administrative Contact Information:*

*Given name: XIANG*

*Family name: LI*

*Company name: UBN LIMITED*

*Address: BEIJINGSHIHAIDIANQUFUXINGLU8HAO 100008*

*Country: CN*

*Phone: +86-1081234567*

*Fax: +86-1081234567*

*Email: [jjxp@outlook.jp](mailto:jjxp@outlook.jp)*

*Account Name: HK5037088T*

*Technical Contact Information:*

*Family name: LI*

*Company name: UBN LIMITED*

*Address: BEIJINGSHIHAIDIANQUFUXINGLU8HAO 100008*

*Country: CN*

*Phone: +86-1081234567*

*Fax: +86-1081234567*

*Email: [jjxp@outlook.jp](mailto:jjxp@outlook.jp)*

.....

5. *Domain Status: Active      should we disputed lock it ?”*

From this, the **Registrar** confirmed with the **HKIAC** that the Respondent is the registered holder of the **Disputed Domain Name**. As a result, the **HKDNR** Domain Name Dispute Resolution Policy is applicable to the **Disputed Domain Name**. The language of the Registration Agreement of the **Disputed Domain Name** is in the English language as provided by the **Registrar**.

On 20 January 2016, the **HKIAC** sent a Notification of Commencement of Proceedings (NCP) consisting of the Complaint, to the email address of the Respondent’s nominated registrant contact for the **Disputed Domain Name** (as recorded in the **Registrar** WHOIS database, and stated that:

*“The Dispute Resolution Policy is incorporated by reference into your Registration Agreement with **HKDNR**, in accordance with which you are required to submit to and participate in a mandatory final and binding arbitration proceedings in the event that a third party (Complainants) submits a Complaint concerning your domain name to a dispute resolution service provider, such as the **HKIAC**.”*

The NCP gave the Respondent fifteen (15) business days to file a Response (i.e. on or before 15 February 2016).

On 18 February 2016 (11:22), the **HKIAC** sent an email notifying the Complainant (with a copy to the Respondent) that the Respondent failed to submit a response concerning the *Disputed Domain Name* <nike-store.com.hk> (Case ID: DHK-1600129) within the required period of time (i.e. 15 February 2016), and will shortly appoint a Panelist for the matter on hand.

On 7 March 2016, the Panel comprising of *Mr. Christopher To* as a single Panelist was appointed by the **HKIAC**, and a hard copy pertaining to the case was delivered to the Panel on the same day.

In accordance with Rule 15(a) of the **HKDNR** Domain Name Dispute Resolution Policy Rules of Procedure, the Panel is of the view that it shall decide the Complaint on the basis of statements and documents submitted.

Also, according to Rule 15(d) of the **HKDNR** Domain Name Dispute Resolution Policy Rules of Procedure and Section 67 of the Hong Kong Arbitration Ordinance (Cap. 609) of the Laws of Hong Kong, this Panel shall issue a reasoned award.

### **3. Factual Background**

#### **For the Complainant**

Established in 1971, Complainant’s NIKE brand has grown from a small athletic footwear business with one retail store to a global provider of athletic footwear, apparel, electronic devices, digital applications and equipment. Operated in more than

160 countries around the globe, the Complainant's products and business are famous globally and NIKE is internationally recognized for its high-quality athletic products. The Complainant's revenues have exceeded \$20 billion USD each year for 2012, 2013 and 2014. The total sales of goods since the company's inception are in excess of \$300 billion USD under the NIKE Mark. In terms of employment, NIKE directly or indirectly employs nearly one million people through its supplier, shippers, retailers and other service providers, including more than 30,000 NIKE employees across six continents.

NIKE owns the exclusive rights to the NIKE trade mark and NIKE trade name (collectively referred to as "*NIKE Mark*") which has been used for over 40 years in its highly successful and widely known lines of sports shoes and sport apparel.

Nike Innovate C.V. and NIKE Hong Kong Limited are affiliated companies, and are wholly owned subsidiaries of NIKE, Inc. The famous NIKE trade mark in Hong Kong is owned by Nike Innovate C.V. As it has been shown by the Complainant, Nike Innovate C.V. owns rights to numerous Hong Kong trade mark registrations for the *NIKE Mark*. NIKE HONG KONG LIMITED, being the duly authorized licensee, conducts business in Hong Kong using the *NIKE Mark*.

Back to the first NIKE trade mark registration in 1978, various *NIKE Mark* have been registered in Hong Kong and used by NIKE for many years. It is much earlier than when the *Disputed Domain Name* was first registered with the *Registrar*. NIKE operates an extensive online website directed and dedicated to consumers in Hong Kong through "*nikestore.com.hk*".

In regards to advertising expenditures, it is in excess of \$2.5 billion USD each year for the years of 2012, 2013 and 2014 respectively. The total expenditure since inception are in excess of \$34 billion USD, and *NIKE Mark* has been extensively promoted by the Complainant through various high profile channels, including print advertisements in major publications, television, online and major sport events.

According to Interbrand's annual publication of the 100 "Best Global Brands" (See <http://interbrand.com/best-brands>), NIKE consistently ranks among the highest valued brands in the world. Likewise, NIKE consistently ranks among the top apparel brands in the world in Brandz's annual publication, "The 100 Most Powerful Brands." (See <http://www.brandz100.com>)

Within the context of online business, the Complainant is closely associated with its consumers in which consumers learn and purchase Complainant's products via the Internet. With the online business growing over 40% in the fiscal year of 2014, the Complainant has made significant investments in its technical infrastructure to cope with such online business.

On a worldwide basis, the Complainant owns hundreds of separate trade mark registrations in over 150 countries. The numerous trade mark registrations in Hong Kong include registration number 19790392 (various goods in International Class 25) registered on 31 March 1978, registration number 19790486 (various goods in International Class 18) registered on 7 April 1978, registration number 199402282 (various goods in International Class 25) registered on 7 January 1989, registration number 199805108AA (various goods in International Class 9, 14 and 28) registered on 16 August 1996, registration number 300205659 (various goods in International Class 35) registered on 28 April 2004, registration number 300545742 (various goods in International Class 3) registered on 12 October 2005, registration number 302719675 (various goods in International Class 9) registered on 28 August 2013, and registration number 303048462 (various goods in International Class 41) registered on 24 June 2014.

### Class 3

*Preparations for bleaching and other substances for washing; other substances for laundry use; preparations for cleaning, polishing, scouring, degreasing and abrading; soaps; perfumery, essential oils, cosmetics, hair and body lotions; dentifrices*

Class 9

*Eyewear, lenses, frames, nose pieces and cases for eyewear; sports helmets; binoculars; cameras, camera cases; chronographs; pedometers; odometers; speedometers; protective clothing; helmets; knee pads; elbow pads; compasses; diving suits; buoys; ear plugs for swimming; safety goggles; lifebelts, lifejackets; magnifying glasses; neon signs; all included in Class 9.*

Class 14

*Jewelry, badges, buckles, medallions, money clips, statues, tankards, tie clips, pins, and trophies made of precious metals or plated with precious metal; chronographs, clocks, watches and watch bands; all included in Class 14.*

Class 18

*Bags included in Class 18, and labels and tags made of leather of imitations of leather for bags included in Class 18.*

Class 25

*Articles of sports clothing, athletic clothing, athletic shoes, athletic shoes for sports, athletic shoes for training, and athletic uniforms.*

Class 28

*Sporting articles; ice skates, skates, braking devices and replacement brake pads adapted for use with skates, wheels being parts for skates; hockey gloves, helmets, wrist guards, knee pads; hockey sticks, hockey stick shafts, hockey stick blades; baseball bats, batting gloves, catchers' mitts for sporting purposes, fielding gloves, football gloves, golf gloves; snowboards, snowboard bindings and snowboarding gloves; footballs, basketballs, volleyballs, soccer balls, rugby balls, baseballs, golf balls, tennis balls; board games; toy stuffed animals; archery equipment; targets; whistles; all included in Class 28.*

Class 35

*The bringing together for the benefit of others, of a variety of goods enabling customers conveniently to view and purchase those goods in a department store, in wholesale outlets, or in a retail store featuring footwear, clothing, sports equipment, eyewear, timekeeping devices and/or accessories, or from a mail order catalogue featuring footwear, clothing, sports equipment, eyewear, timekeeping devices and/or accessories, or by means of telecommunications or from an Internet web site specialising in the marketing of footwear, clothing, sports equipment, eyewear, timekeeping devices and/or accessories.*

Class 41

*Entertainment services, namely, arranging, organizing and conducting an array of athletic and sports activities, events, competitions and tournaments; encouraging and developing sports talent by organizing and conducting athletic programs and activities; encouraging youth and amateur sports and physical education by organizing and conducting youth and amateur athletic and sports programs and activities; organizing, conducting and arranging participation in cultural and community programs; providing training in the fields of sports and fitness; provide information regarding sports, fitness training, and athletic skill development via an online website; provide information regarding sports, athletic skill development, and fitness training via computer application software; provide live workouts, fitness instructions and sessions via an online website and computer application software; provide pre-recorded athletic and fitness sessions via an online website and computer application software; provide athlete training, workouts, and physical fitness challenges via a personal digital device or smart phone; provide a fitness assessment and a personalized workout program based on that assessment; entertainment services, namely, contest and incentive award programs designed to reward program participants who exercise and engage in other health-promoting activities.*

The Complainant's representative is *David J. Steele, Esq.*, Tucker Ellis LLP of 515 South Flower Street, Forty-Second Floor Los Angeles, CA 90071-2223.

**For the Respondent**

The Respondent, UBN Limited, is a company located at BeijingShi, Hai Dian Qu FuXingLu 8 Hao, China 100008.

On 28 October 2015, the *Disputed Domain Name* <nike-store.com.hk> was registered by the Eranet International Limited. As noted by the Registrar's email of 18 January 2016, the holder of the *Disputed Domain Name* is UBN Limited.

On 18 February 2016 (11:22), the *HKIAC* sent an email to notify the Complainant (with a copy to the Respondent) that the Respondent had not responded to the *HKIAC* within the stipulated time frame (i.e. 15 February 2016). As such, the Respondent has not contested the allegations of the Complaint and is in default.

**4. Parties' Contentions**

**The Complainant**

The Complainant submits that it has, including its predecessors, continuously and exclusively used the *NIKE Mark* since 1971, and registered the *NIKE Mark* in Hong Kong in 1978, long before the Respondent unlawfully registered the subject domain name.

- (a) The Subject Domain Name is confusingly similar to the Complainant's *Nike Mark*

The Complainant contends that the subject domain name "*nike-store.com.hk*" is confusingly similar to the Complainant's *NIKE Mark*, and almost identical to the NIKE's own domain name "*nikestore.com.hk*" except with the insertion of a hyphen between the words "*NIKE*" and "*Store*". This amounts to making use of the subject domain name to impersonate NIKE and collect personal information from NIKE's

customers. By examining the Respondent's website that contains Hong Kong NIKE store locations and NIKE products information, the Complainant is of the view that the Respondent is clearly engaged in cybersquatting to misdirect consumers looking for NIKE's official Hong Kong retail website. The cases of *Chan Luu Inc. v. big trade*, FA 1464057 (Nat. Arb. Forum Nov. 8, 2012) and *U.S. News & World Report, Inc. v. Zhongqi*, FA 917070 (Nat. Arb. Forum Apr. 9, 2007) are quoted by the Complainant to support its assertions.

The Complainant also drew to the Panel's attention by quoting the case of *Awesome Kids LLC v. Selavy Comm.*, D2001-0210 (WIPO Apr. 16, 2001) to support the requirements of identical or confusingly similar domain name namely:

*“that the domain name misappropriate sufficient textual components from the mark such that an ordinary Internet user who is familiar with the goods or services distributed under the mark would upon seeing the domain name likely think that owing to the visual and/or phonetic similarity between the mark and the domain name that an affiliation exists between the site identified by that domain name and the owner or licensed users of the mark.”*

The Complainant states that the addition of generic top-level domain names such as “.com” or country code top-level domain name such as .hk or .com.hk to portions of the subject domain name is irrelevant in relation to the confusingly similar analysis. The Complainant submits the case of *Conair Corporation vs. Tom Lee CCTV Ltd.*, DHK-1400108, (Hong Kong Intl Arb. Cntr. Jul. 23, 2014) to support its viewpoint under this context.

- (b) The Respondent has no Rights or Legitimate Interest in the Subject Domain Name

### **Prima Facie evidence**

The Complainant asserts that once there is a *prima facie* case against the Respondent, the Respondent will bear the burden of proofing that it has rights or legitimate interests in the ***Disputed Domain Name***, as mentioned in *AOL LLC v. Gerbert*, FA 780200 (Nat. Arb. Forum Sep. 25, 2006). By referring to the cases of *G.D. Searle & Co. v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) and *Dunkin' Brands Group, Inc. et al. v. Giovanni Laporta*, FA 568547 (Nat. Arb. Forum Aug. 25, 2014), the establishment of a *prima facie* evidence is that the Respondent is neither known by the ***NIKE Mark*** nor authorized or licensed to use the marks, and no legal relationship exists between the Complainant and the Respondent.

### **Bona fide offering**

The Complainant advocates that the unlawful use of the ***Disputed Domain Name*** constitutes infringement of the Complainant's trade mark, far from being a *bona fide* offering. According to the case *Viacom Int'l, Inc. et al. v. TVdot.net, Inc.*, D2000-1253 (WIPO Jan. 16, 2001), "*the illegal use of another's trademark cannot be considered a bona fide use*". The case of *Elorg Co., LLC and The Tetris Co., LLC v. 0x90*, FA 114355 (Nat. Arb. Forum Aug. 6, 2002) also suggests that the use of a domain name to capitalize on the value of a trade mark does not give rise to legitimate rights or interests under the ***Policy***. The Complainant also quoted the case of *Dream Horse Classified v. Mosley*, FA 381256 (Nat. Arb. Forum Feb. 8, 2005) to allege that an "*attempt to pass itself off as complainant by implementing a color scheme*" identical to that of Complainant indicates lacks of rights and legitimate interests in the ***Disputed Domain Name***. In respect of the Respondent's phishing for Internet users' personal information, the Complainant cited the case *Blackstone TM L.L.C. v. Mita Ireland Ltd.*, FA 1314998 (Nat. Arb. Forum Apr 30, 2010) that phishing for personal information is not a *bona fide* offering of goods and services.

### **Commonly known subject domain name**

The Complainant advocated that the Respondent, being listed in the whois information as “*UBN LIMITED*”, is not commonly known by the subject domain name. The Complainant stated that it had not given the Respondent permission to use the *NIKE Mark*, reinforcing the fact that the Respondent is not commonly known by the *Disputed Domain Name* as advocated in the cases of *Solstice Marketing Corp. v. Marc Salkovitz d/b/a Image Media, LLC*, FA 040087 (Nat. Arb. Forum Aug. 31, 2007) and *American Girl, LLV v. George Rau*, FA 308206 (Nat. Arb. Forum Apr. 2, 2010).

### **Existence trademark**

According to a search of the Government of Hong Kong Intellectual Property Department, the Complainant submits that it cannot find any trade mark or service mark for Complainant’s *NIKE Mark* owned by the Respondent. In fact, the Respondent does not own any trade mark or service mark in Hong Kong, indicating that the Respondent is not associated with the subject domain name.

### **Fair use of the subject domain name**

Evidenced by the imitation of the NIKE retail website, the Complainant advocated that the Respondent is using the *Disputed Domain Name* for unlawful commercial use to “*misleadingly divert consumers*”, rendering the non-existence of the fair use of the *Disputed Domain Name*.

### **Individual Domain Name Categories**

The Complainant indicates that the *Disputed Domain Name* is not the individual name of the Respondent, or any name which the Respondent is commonly known by, thereby supporting the fact that the Respondent cannot rely on the individual name to claim rights or legitimate interest in relation to the subject domain name.

(c) Register the Subject Domain Name in bad faith

The Complainant drew to the panel's attention by quoting a number of cases to allege bad faith on the part of the Respondent including (1) *Bloomberg Finance L.P. v. Andreas Leerent*, FA 629058 (Nat. Arb. Forum Jul. 21, 2006) that the Respondent “created a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the respondent’s website, thereby taking advantage of the complainant’s mark.”; (2) *Dollar Financial Group, Inc. v. Bankshire Corp.*, FA 13686 (Nat. Arb. Forum Jul. 30, 2007) that the Respondent made use of the “domain name confusingly similar to complainant’s mark to redirect Internet users to respondent’s own commercial website offering goods and services”; (3) *Smiths Group plc v. Lee Snooks*, FA 372112 (Nat. Arb. Forum Mar. 18, 2011) that the Respondent made “use of the disputed domain name for false impersonation”; (4) *Johnson Financial Group, Inc. v. Janssen*, FA 214465 (Nat. Arb. Forum Jan. 19, 2004) that the Respondent attempted “to pass itself off as complainant” constituting bad faith.

The Complainant is of the view that there is no conceivable and legitimate use of the subject domain name by the Respondent and quoted the case of *Indymac Bank v. Ebeyer*, FA 175292 (Nat. Arb. Forum Sep. 19, 2003) to support its assertion. Another referenced case *Household International, Inc. v. Cyntom Enterprises*, FA 096784 (Nat. Arb. Forum Nov. 7, 2000) was quoted “inferring that respondent registered a well-known business name with hopes of attracting complainant’s customers”.

(d) Subject Domain Name registered by an individual person

Finally, the Complainant submits that the ***Disputed Domain Name*** was not registered by an individual person. As the Respondent is a company situated in China, the registration as an individual person does not apply to the present case on hand.

## **The Respondent**

On 28 October 2015, the *Disputed Domain Name* <nike-store.com.hk> was registered by the Eranet International Limited. As noted by the Registrar's email of 18 January 2016, the holder of the *Disputed Domain Name* is UBN Limited.

On 20 January 2016, the *HKIAC* sent an email to notify the Complainant (with a copy to the Respondent) that the Respondent had not responded to the *HKIAC* within the stipulated time frame (i.e. 15 February 2016). As such, the Respondent has not contested the allegations of the Complaint and is in default.

## **5. Findings**

### **A. Language of the Proceedings**

The Hong Kong Domain Name Registration Company Limited ("*HKDNR*"), Domain Name Dispute Resolution Policy ("*Policy*") and Rules of Procedure ("*Rules*") Paragraph 11(a) provides that:

*"Unless otherwise agreed by the Parties, the language of the arbitration proceeding shall be in English for English .hk domain name, and in Chinese for Chinese.hk or .香港 domain name, subject always to the authority of the Arbitration Panel to determine otherwise, having regard of all circumstances of the arbitration proceeding"*

In the present case, the parties had not agreed a particular language for these proceedings. As this is an "*English .hk domain name*", namely, <nike-store.com.hk>, then in accordance with Paragraph 11(a) of the *Rules*, the proceedings "*shall be in English*". In these circumstances, the Panel considers that it would be appropriate (and without prejudice to any of the parties) for the present proceedings to be conducted in English.

**B. Discussion and Findings**

Having considered all the documentary evidence before me, and the Respondent's non-participation in these proceedings after being afforded every opportunity to do so in accordance with Paragraph 5(e) of the **Rules**, the Panel is of the view that it should proceed to decide on the **Disputed Domain Name**, namely, <nike-store.com.hk> based upon the Complaint and evidence as adduced by the Complainant.

Paragraph 5(e) of the **Rules** stipulates that:

*“If a Respondent does not submit a timely Response, in the absence of exceptional circumstance as determined by the Provider at its sole discretion, the Arbitration Panel shall decide the dispute based upon the Complaint and evidence submitted therewith”.*

Having said so, Paragraph 4(a) of the **Policy**, which is applicable hereto, the Complainant has the burden of proving the following elements, namely:

*“(i) the 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) the Registrant has no rights or legitimate interests in respect of the Domain Name; and*

*(iii) the Registrant's Domain Name has been registered and is being used in bad faith, and*

*(iv) if the Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name.”*

**[as the Disputed Domain Name is not registered in the category of “individual” domain name, the Panel will not consider this factor within its decision]**

(1) **Identical/confusing similarity**

Paragraph 4(a)(i) of the *Policy* requires the Complainant to prove that the *Disputed Domain Name* is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

In the case of *Adidas-Salomon AG v. Chan Ma Lee* (HKDRP's Decision, Case ID: DHK-0400004) (December 14, 2004), the Panel found that:

*“The Complainant has provided substantial evidence of its right in the mark ‘Adidas’. I have been provided with evidence of the trademark registrations for Adidas held by the Complainant worldwide, some of which date back to the 1950’s. I have in particular been provided with documentary evidence of the Certificates of Registration in Hong Kong under the Trademarks Ordinance and that the marks have been registered for many years. I find that the domain name registered by the Respondent is identical to the registered trademark of the Complainant in which the Complainant has long established rights.”*

On this basis, the Panel is of the opinion that the reasoning of *Adidas-Salomon* case can apply to the present *Disputed Domain Name* because both Complainants have been for many years leading companies in the business of sports shoes and sport apparel, which many people around the world have come to be aware. NIKE, like Adidas, has invested huge amount of resources in promoting its products, and carries hundreds of separated trade mark registrations in over 150 countries around the world. In Hong Kong, NIKE has registered various trademarks in different classes since 1978, as evidenced by numerous registration documentation provided by the Complainant (see “*For the Complainant*” within the section of “*Factual Background*” of this decision). On the contrary, the Respondent does not have any registered trademarks except the registration of the *Disputed Domain Name* <nike-store.com.hk> on 28 October 2015 through the registrar “*Eranet International Limited*”. In fact, the *Disputed Domain Name* with an addition of a hyphen between

the words “*nike*” and “*store*” is similar to the domain name “nikestore.com.hk” owned by the Complainant.

Comparing the difference between the *Disputed Domain Name* <nike-store.com.hk> and <nikestore.com.hk> owned by the Complainant, the Panel is of the view that an ordinary Internet user who is familiar with the goods or services distributed under the *NIKE Mark* would likely perceive the *Disputed Domain Name* either as a domain owned by the Complainant or that there is some kind of commercial relationship associated with the Complainant. The Panel believes that the requirements stipulated in Paragraph 4(a)(i) of the *Policy*, fall within the confines of the case in question namely:

*“the Registrant’s Domain Name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights;”*

In the absence of a defence by the Respondent, the Panel cannot find any reasons why the *Disputed Domain Name* is not confusingly similar to the Complainant’s domain name <nikestore.com.hk> and it’s *NIKE Mark*.

As stated previously, the Respondent has not contested the allegations of the Complaint and is in default.

For all the foregoing reasons, this Panel concludes that the Complainant has discharged its burden of proof to establish the elements of identical and confusingly similar mark as stipulated in Paragraph 4(a)(i) of the *Policy*.

## **(2) Rights or Legitimate Interests of Respondent**

Paragraph 4(d) of the *Policy* sets out examples of circumstances where the Respondent may have rights or legitimate interests over the *Disputed Domain Name*:

***“How to Demonstrate the Registrant’s Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.***

*When the Registrant receives a Complaint as defined in Paragraph 3 of the Rules of Procedure, the Registrant should refer to Paragraph 5 of the Rules of Procedure in determining how the Registrant’s Response should be prepared.*

*Any of the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be proven based on its evaluation of all evidence presented to it, shall demonstrate the Registrant’s rights or legitimate interests to the Domain Name for purposes of Paragraph 4(a)(ii):*

*(i) before any notice to the Registrant of the dispute, the Registrant’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 in Hong Kong; or*

*(ii) the Registrant (as an individual, business, or other organisation) has been commonly known by the Domain Name, even if the Registrant has acquired no trade mark or service mark rights in Hong Kong; or*

*(iii) the Registrant has trademark or service mark rights that the mark is identical to the Domain Name the Registrant is holding; or*

*(iv) the Registrant is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue; or*

*(v) If the Domain Name is registered in one of the Individual Domain Name Categories, the Domain Name registered must be the Registrant’s own “individual name”, which can be either (1) the Registrant’s legal name, or (2) a name by which the Registrant is*

*commonly known and can include, for example, a pseudonym the Registrant uses if the Registrant is an author or a painter, or a stage name if the Registrant is a singer or actor, or the name of a fictional character if the Registrant has created or can otherwise show it has rights in such fictional character.”*

In the case of *Disney Enterprises, Inc v. Wei Zhu* (ADNDRC’s Decision, Case ID: HK-0800210) (Dated 11 December 2008) (“*Disney Enterprises Inc*”), the Respondent, Wei Zhu, registered the disputed domain names <迪士尼乐园.biz>, <迪斯尼乐园.biz>, <迪士尼樂園.biz> and <迪斯尼樂園.biz> whereas those Chinese words in these domain names, irrespective of whether they are of the Simplified Chinese or Traditional Chinese text, exactly means “*Disneyland*” in English, which is the trade name and trademark of the Complainant, Disney Enterprises, Inc. In relation to the rights or legitimate interests of the *Disneyland*’s disputed domain name, the Panel stated and concluded that:

*“(a) The Disputed Domain Names are the trade names and trademarks of the Complainant. The Respondent is not entitled to or otherwise authorized or licensed by the Complainant by whatsoever means to use the Trademark in any goods or services. The Respondent will not be able to demonstrate that his conduct satisfies any of the conditions in paragraph 4(c) of the Policy. Specifically, (i) the Respondent is not using and has not demonstrated an intent to use the Disputed Domain Names or names corresponding to the Disputed Domain Names in connection with a bona fide offering of goods or services in the course of trade; (ii) the Respondent, being an individual, is not and has not been doing business under any business name referable to or commonly known by the Disputed Domain Names; and (iii) the Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Names, without intent to misleadingly divert consumers or to tarnish the Complainant’s marks for commercial gain.*

*Therefore, the Respondent has no rights or legitimate interests in respect of the domain Names in dispute.”*

By applying the principle stipulated in Disneyland Enterprises Inc to the case on hand, one can assert that the Respondent is not entitled to or otherwise authorized or licensed by the Complainant by whatsoever means to use the trademark in any goods or services. The Respondent has not shown any evidence in regards to a bona fide offering of goods or services in the course of trade carrying the ***Disputed Domain Name***. In respect of a legitimate non-commercial or fair use of the ***Disputed Domain Name***, the Panel is of the view that no evidence can be found to support this aspect. In addition, the Respondent is not an individual and has not been doing business under any business name referring to or commonly known by the ***Disputed Domain Name***. The Panel has been made aware of the fact that the Respondent has not registered any trademark similar to the ***NIKE Mark*** either in part or in its entirety.

With regards to the burden of demonstrating rights or legitimate interest in the domain name, the Panel concurs with the Complainant’s cited cases in its Complaint, namely *AOL LLC v. Gerbert*, FA 780200 (Nat. Arb. Forum Sep. 25, 2006), *G.D. Searle & Co. v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002), and *Dunkin’ Brands Group, Inc. et al. v. Giovanni Laporta*, FA 568547 (Nat. Arb. Forum Aug. 25, 2014), whereby once *prima facie* evidence is established against the Respondent, the Respondent bears the burden of proofing that it has rights or legitimate interests in the ***Disputed Domain Name***. Similar reasoning can be found in the case of *Alibaba Group Holding Limited v hiyeah hu* (ADNDRC’s Decision, Case No: HK-1300550) (Dated 19 November 2013) in which the Panel stated that:

*“While the overall burden of proof rests with the complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore a complainant is required to make out an initial prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the*

*domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.”*

Despite the notification to the Respondent by the **HKIAC**, there is no response from the Respondent in relation to the **Disputed Domain Name**. The Panel has no alternative but to conclude that the Respondent has “no right” and/or “legitimate interest” in respect of the **Disputed Domain Name**.

**(3) Bad faith**

Paragraph 4(b) of the **Policy** sets out four (4) factors in which the Panel shall take into account in determining whether the Respondent has registered and used the **Disputed Domain Name** in bad faith. The prescribed four (4) factors are as follows:

*“Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:*

- (i) circumstances indicating that the Registrant has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the Complainant who is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant’s documented out-of-pocket costs directly related to the Domain Name; or*
- (ii) the Registrant has 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 Registrant has engaged in a pattern of such conduct; or*

- (ii) *the Registrant has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or*
  
- (iv) *by using the Domain Name, the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's web site 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 Registrant's web site or location or of a product or service on the Registrant's web site or location."*

In the case of *Pierre Cardin (皮尔·卡丹) v. Lai Gui Di* (ADNDRC's Decision, Case No: CN-1300681) (Dated 28 April 2013) ("*Pierre Cardin*"), the Panel stated that:

*"The Respondent tried to attract users to visit the website "pierrecardin-cn.com" in a deliberate manner out of commercial profits through registration and usage of such website and provision of goods or services on such website and link from such website to a on-line shop at Taobao.com to sell "皮尔卡丹 (Pierre Cardin)" clothing so as to cause confusion as to the source, sponsor, affiliates, supporters, etc., which severely damaged the business of the Complainant.*

*The main part, "pierrecardin", of the disputed domain name "pierrecardin-cn.com" registered by the Respondent is identical with the trademark "pierrecardin" owned by the Complainant. The word "cn" is short for China on the Internet. Therefore, "pierrecardin-cn.com" can be comprehended as "Pierre Cardin in China" to ordinary network users or customers.*

*As to the usage of the domain name “pierrecardin-cn.com”, the logo “P & Device”, highlighted at the upper left corner of the webpage, is duplicated from the trademark No. 211048 “P & Device”, a remarkable, well-known trademark of the Complainant; the spell of the words “Pierre cardin”, used below such logo, is identical with the trademark No. 137016 “Pierre Cardin” of the Complainant. As to the on-line shop at Taobao.com linked from the disputed domain name/website, the abovementioned logo “P & Device” and words of “pierre cardin” are also used on the homepage of that shop.*

*Furthermore, the Respondent links the disputed domain name to Taobao.com for distributing such goods as “Pierre Cardin down jackets”, men’s jeans, women’s jeans, men’s clothing, women’s clothing, etc. The logo “P & Device”, confusingly similar to the trademark No. 211048 “P & Device”, and the words of “pierre cardin”, confusingly similar to the trademark No. 137016 “Pierre Cardin”, are used on the upper left part of the exhibiting pictures of those goods offered for sale by the Respondent. It should be noted that the goods mentioned above are covered by the trademark of the Complainant, the act of the Respondent has not been authorized or licensed by the Complainant.*

*The evidence mentioned above shows that the Respondent tried to attract users to visit the website “pierrecardin-cn.com” in a deliberate manner out of huge commercial profits through registration and usage of such website and provision of goods or services on such website and link from such website to on-line at Taobao.com for selling goods without authorization or license from the Complainant so as to cause confusion as to the source, sponsor, affiliates, supporters, etc., which severely damaged the business of the Complainant. In accordance with the provisions regulated in UDRP 4(b)(iii) and (iv), such acts in bad faith shall be prohibited by the law.*

*Enjoying high reputation in China, trademarks and goods of the Complainant have become the counterfeit target by many infringers. Domain names identical with or similar to “pierrecardin” have emerged continuously. These acts cause serious damages to the legitimate rights and interests of the Complainant, violate the principle of honesty and credibility favored by the market-oriented economy, and also deceive the ordinary customer at the meantime, which causes severe damages to the legitimate rights and interests of the ordinary customers.”*

By applying the principle stipulated in *Pierre Cardin*, one can assert that the Respondent registered and used the ***Disputed Domain Name*** in bad faith. It is because the Respondent hosted a website in the name of the ***Disputed Domain Name*** with the purpose of attracting Internet users for commercial profits through the selling of goods or services on such a website for which “nike-store.com.hk” can be confused as NIKE store in Hong Kong to ordinary internet users or customers.

As the Complainant did not license its trademark or trade service or products to the Respondent, one can ascertain that the goods being offered for sale through the ***Disputed Domain name*** could be classified as counterfeit products, whereby one can imply from such that one is simply using the Complainant’s reputation in Hong Kong and globally to deceive ordinary customers into believing that the ***Disputed Domain Name*** is associated in some way or form with the Complainant’s business. This in essence violates the principle of honesty and credibility, causing severe damage to the legitimate rights and interests of ordinary customers (and for that matter the general public) and that of the Complainant.

The Panel is of the view that the Respondent has no good cause or justifiable reasons for using the ***Disputed Domain Name***. On this basis, the Panel concludes that the Respondent registered and used the contested domain name in bad faith.

## 6. Conclusions

The Complainant has proved its case. It has a registered Hong Kong trademark in the name of “**NIKE**” to which the contested domain name is confusingly similar.

The Respondent has shown no rights or legitimate interest in the *Disputed Domain Name*.

The Complainant has proved that the Respondent registered and used the *Disputed Domain Name* in bad faith.

For all the foregoing reasons and in accordance with Paragraph 4 of the *Policy*, the Panel concludes that the relief requested by the Complainant be granted and do hereby order the *Disputed Domain Name* <nike-store.com.hk> be transferred to the Complainant namely “NIKE Hong Kong Limited”.

Rendered in the Hong Kong Special Administrative Region of the People’s Republic of China

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*Dr. Christopher To*

Dated 28 March 2016