



HONG KONG INTERNATIONAL ARBITRATION CENTRE

香 港 國 際 仲 裁 中 心

**.hk Domain Name Dispute Resolution**

**ARBITRATION PANEL DECISION**

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<b>Case No.</b>	<b>:</b>	<b>DHK-0700012</b>
<b>Complainant</b>	<b>:</b>	<b>VeriSign, Inc.</b>
<b>Respondent</b>	<b>:</b>	<b>Kristopher-Kent Harris</b>

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## **1. THE PARTIES AND CONTESTED DOMAIN NAME**

The Complainant is VeriSign, Inc. of 487 Middlefield Road, Mountain View, CA 94043, United States of America. The authorised representative of the complainant in this matter is Mr. Patrick McGarry of McGarry & McGarry, LLC of 120 N. LaSalle, Suite 1100, Chicago, IL 60602, United States.

The Respondent is Kristopher-Kent Harris of PO Box 7461, Bellevue, WA 98008, United States.

The domain names at issue (the “Disputed Domain Name”) is <verisign.hk>, registered on 31 May 2004 by the Respondent.

## **2. PROCEDURAL HISTORY**

A complaint in respect of <verisign.hk> was filed with the Hong Kong International Arbitration Centre (“HKIAC”) in terms of the prescribed Form A on 3 March 2007 under the Hong Kong Domain Name Registration Company Limited (“HKDRN”) Domain Name Dispute Resolution Policy (“the HKDNRP”), the HKDRN Domain Name Dispute Resolution Policy Rules of Procedure (“the Rules”) and the HKIAC Supplemental Rules therefor (“the Supplemental Rules”).

On 19 March 2007, the HKIAC received payment for Domain Name Dispute Complaint fee in connection with the case.

On 4 April 2007, the Respondent was notified of the commencement of the proceeding, requesting a response to be submitted within 15 business days. On 8 April 2007, the Respondent wrote to HKIAC in relation to extending time for the filing of the response in rebuttal. On 26 April 2007, the Respondent submitted a response in terms of the prescribed Form B under the HKDNRP.

On 18 April 2007, the HKIAC wrote to the candidates for the sole panelist, asking for confirmation of availability, independence and impartiality in dealing with this matter. Upon such confirmation, Mr. Gary Soo was appointed as the Sole Panelist in this case on 28 April 2007 and the Panel was requested to render a decision on or before 18 May 2007.

### **3. FACTUAL BACKGROUND**

#### **For Complainant**

The Complainant is the registered owner of the “VeriSign” trademark. In relation to this mark, the Complainant is the owner of trademark registration nos. 2302350, 2559289, 2758215 and 2758214 in the United States; the Complainant is also the owner of the trademark registration nos. 200005811, 200016644 and 200106066 in Hong Kong.

The Complainant is a company offering a broad range of technology and communications products, including but not limited to digital identify certification products and services, secure e-commerce payment products and services, development and consulting services in the fields of security encryption and identification systems, as well as domain name registry products and services, telecommunications products and services, computer software and other internet-related products and services.

#### **For Respondent**

The Respondent registers the Disputed Domain Name on 31.05.2004. The website with the Disputed Domain Name is stated to be under construction with the words “*Verisigns' of Georgia Family Tree*” appeared thereon.

#### 4. PARTIES' CONTENTIONS

##### **For Complainant**

The Complainant notes that the Complainant has previously filed a complaint against the Respondent (i.e. Case No. DHK-0600011). The Complainant however is of the view that that previous complaint does not have a *res judicata* effect on the present proceeding because the Respondent has substantially changed the use of the <verisign.hk> domain name.

The Complainant remarks that, during the previous complaint proceeding, the Respondent's website is password protected and the Respondent stated that it is nothing more than a 'test site', but now the website is available to the general public containing the Complainant's "VeriSign" trademark, in large letters. The Complainant also states that it has since been discovered that the Respondent has registered at least ten additional domain names in violation of Hong Kong trademark rights, illustrating the Respondent's bad faith intentions, thereby providing credible and new materials which could not have been known until after the previous panelist decision.

In this regard, the Complainant provides, in the annexes, various documents in support and seeks to rely on the WIPO cases of *Tala Abu-Ghazaleh International, Talal Abu Ghazaleh & Co., Abu Gazaleh Intellectual Property and Aldar Audit Bureau v. Fadi Mahassel* (WIPO Case No. D2001-0907) and *AB Svenska Spel v. Andrey Zacharov* (WIPO Case No. D2003-0527). In these cases decided under the Uniform Domain

Name Dispute Resolution Policy (“the UDRP Policy”), it is stated: *“In determining the circumstances in which Refiled Complaints should be entertained under the Uniform Policy, a distinction should be drawn between (i) Refiled Complaints that concern the act which formed the basis of the original complaint, and (ii) Refiled Complaints concern the act which have occurred subsequent to the decision on the original complaint. For the first type, acceptance of Re-filed complaints should be exceptional. In relation to the second type...a different approach is warranted. With a Re-filled Complaint of this type, the concept of res judicata does not arise. Because the subsequent complaint concerns acts which have occurred after the original decision, it is not an action upon which adjudication has already taken place; the subsequent complaint is truly new under the Uniform Policy.”*

On the Complainant’s rights, the Complainant states that it is the owner of the registered trademark “VeriSign” and provides documents to show that the Complainant is the owner of trademark registration nos. 2302350, 2559289, 2758215 and 2758214 in the United States and that the Complainant is also the owner of the trademark registration nos. 200005811, 200016644 and 200106066 in Hong Kong.

The Complainant further asserts that the Respondent’s conduct in registering the Disputed Domain Name creates a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation or endorsement of the Respondent’s website since internet users may associate the Disputed Domain Name with the Complainant’s goods and services.

As regards the Respondent’s rights or legitimate interests in respect of the Disputed Domain Name, the Complainant asserts that the Respondent holds no trademark registration for the “VeriSign” name or mark since:-

- (a) the Respondent does no legitimate business under any name that incorporates the “VeriSign” name or mark;
- (b) the Respondent is not known by any legitimate name that incorporates the same;
- (c) the Respondent is not licensed in any way by the Complainant;
- (d) there is no known association in the mind of the public of the “VeriSign” name or mark other than the goods and services that associated with the Complainant’s trademark.

The Complainant also states that the Respondent’s use of the Disputed Domain Name to cyber-squat and to divert traffic to another site is not in connection with a bona fide offering of goods or services and, furthermore, the Respondent’s behaviour of registering numerous trademarks as domain names has illustrated a lack of good faith.

Also, the Complainant is of the view that the Respondent registers the Disputed Domain Name in bad faith for the reasons set out below.

- (a) The Respondent’s registration of the Disputed Domain Name is with the intention to sell it and there is a clear pattern of bad faith cyber-squatting behaviour on the part of the Respondent. These include those domain names of <aol.hk>, <starbucks.hk>, <victoriassecret.hk>, <clarins.hk>, <Revlon.hk>, <mattel.hk>, <colgate.hk>, <heinz.hk>, <gucci.hk> and <nautical.hk> that violate trademark rights in Hong Kong. All of these, except <gucci.hk>, are registered by the Respondent between 28 May 2004 to 4 June 2004. There is no plausible explanation of how the Respondent could have registered the Disputed Domain Name or any of these domain names in good

faith. This is, as held in the cases of *Six Continents Hotels, Inc. v. IQ Management Corporation* (WIPO Case No. D2004-0272) and *LIN Television Corporation v. Home in USA, Inc.* (WIPO Case No. D2000-0257), evidence of bad faith.

- (b) The Respondent originally employs the Disputed Domain Name to divert the internet traffic to the website of The Puget Sound Toyota Owners Club, a website designed by the Respondent. After receiving a cease and desist letter from the Complainant, the Respondent claims in an email response that it is only a 'test site' and that the site has been deleted from the internet. Other than using password to restrain access to the site, the Respondent fails to answer any further attempts at communication with the Complainant. Yet, in a communication in the chat room 'forum' of the Puget Sound Toyota Owner's Club, the Respondent says: "*I have no plans on ever shutting down this site, unless someone buys the domain name. But, I got a ton more names.*" This statement, as read by the Complainant, is a clear admission by the Respondent of his intention to cyber-squat the "VeriSign" trademark.
- (c) Since the previous complaint, the Respondent begins to display on the website of the Disputed Domain Name, the "VeriSign" mark in large letters. This is however not a plausible legitimate reason for the Respondent's registration of the Disputed Domain Name.

In this regard, the Complainant provides documents in support of the above, in the form of trademark registration records, WHOIS information, printouts of the website of the Disputed Domain Name on different dates and registration agreement.

In the circumstances, the Complainant asks for the transfer of the Disputed Domain Name to the Complainant.

## **For Respondent**

The Respondent is of the position that the Complainant does not have a legitimate claim to the Disputed Domain Name and that the Complainant's representative, has made an attempt of 'reverse domain name hijacking'.

The Respondent asserts that it was the duty of both the parties to present the evidence they have or can have at the time of the previous proceedings and failure to do so is not grounds for reopening the case of filing a second complaint, as the Complainant is doing here. Thus, the Respondent asserts that this second complaint should be dismissed on these grounds. On the point of bad faith, the Respondent points out that the burden is on the Complainant but no new proof (as compared with the previous complaint) has been offered in the present complaint and the Respondent states that the proof offered by the Complainant in this regard was manufactured by the Complainant.

The Respondent also states that:-

- (a) during the time from 26.01.2004 to 19.03.2004, HKDNR has offered to the Complainant exclusive rights to the word "verisign" as a .hk domain name via the 'soft launch period', wherein, as a Hong Kong trademark owner, the Complainant was eligible to apply for the registration of the Disputed Domain Name;
- (b) the Complainant opted not to exercise their exclusive option in this regard, leaving the Disputed Domain Name available during the next offering period,



more commonly known as a the ‘sunrise period’;

- (c) again, the Complainant opted not to apply for the registration of the Disputed Domain Name;
- (d) the Complainant was aware fully of these at the time as could be seen from the corresponding advice to others posted on the Complainant’s website in relation to the registration of such .hk domain names;
- (e) two years have passed since the Complainant first shown interest in gaining ownership of the Disputed Domain Name.

The Respondent stated that, during the 36 months since the registration of the Disputed Domain Name, he has not used the Disputed Domain Name other than for his own internal testing practices and website design functions. The Respondent also stated that the Complainant’s representative, Mr. McGarry has quite a habit of lying and for fabricating the truth. In particular, the Respondent said that:-

- (a) some 9 months prior to the previous complaint, Mr. McGarry has contacted the Respondent’s father by email, who is an author of novels, pretending to be a fan of his work and telling his father that his website was in need of revamping and inviting recommendation of web designer, and this begins his trail of lies and deceit;
- (b) Mr. McGarry’s account on what the Respondent said in a forum in relation to whether he intended to sell the Disputed Domain Name is not true but is indeed made up;
- (c) the documents in relation to the email communication relied on by the Complainant in support of the previous complaint and the present Complaint were mysteriously changed by adding text to them to establish bad faith and, in

any case, the content in such communications is not from the Respondent;

- (d) the Respondent did not respond to the Complainant because, when Mr. McGarry learned about the Respondent from his father, he sent to him a threatening email asking for the domain name but without providing proof of authorization from the Complainant.

The Respondent states that the mark in the Disputed Domain Name, i.e. “verisign”, and the “VeriSign” mark of the Complainant are different with the distinct capital letter “S”.

The Respondent also asserts that “Verisign” is a family name and disagrees that this combination of letters is exclusively the Complainant’s, giving an illustration of whether Mr. T.P. Verisign who resided at 100 Ryon Ave. Hinesville, GA might also argue that he has a claim to this combination of letters. Hence, in the Respondent’s view, the word “verisign” is no more unique than the word “ford” is to Ford Motor Company or the combination of letters of “711” is to the 7-11 convenience store company, claiming that the Respondent was entitled to the ownership of the <www.ford.hk> or <711.hk> domain names, unless using these in bad faith manner. Therefore, the Respondent says that the word “verisign” is a generic term.

In the present Complaint, described by the Respondent as a possible second round arbitration, the Respondent is of the view that owing a list of domain names does not sufficiently demonstrate bad faith and no circumstances of bad faith exist since there is no evidence or is only manufactured evidence that the Respondent:-

- (a) intended to divert consumers from the trademark owner’s site to the

Respondent's site either for commercial gain or to tarnish, dilute or disparage the trademark owner's mark by confusing consumers into believing that the registrant's site is sponsored by the trademark owner;

- (b) the Respondent offered the Disputed Domain Name for sale to the trademark owner, with the intent to profit from the sale, without intending to use the domain name for a bona fide purpose, or there is an indication of a pattern of such conduct;
- (c) the Respondent used false contact information when registering the Disputed Domain Name, or has a pattern of such conduct.

The Respondent also remarks that the mere acquiring of a domain name and not using the website under that domain name is not using the concerned mark for the domain name publicly and the use of the "VeriSign" mark in the present case is not for commercial use.

In the circumstances, the Respondent asserts reverse domain name hijacking on the part of the Complainant and that the Complaint shall be dismissed once again.

## **5. DISCUSSION AND FINDINGS**

Pursuant to paragraph 4(a) of the HKDNRP, the complainant has the burden of proving that:-

- (i) the respondent'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 respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent's domain name has been registered and is being used in bad faith.

### ***Whether Current Complaint Subject to Res Judicata***

As noted in the above, this is a 're-filed' complaint. The previous complaint was decided by another Arbitration Panel, the case no. of which being DHK-0600011. In the previous complaint. It was filed on 14 October 2006, involving the same parties (i.e. the Complainant and the Respondent herein) and the same domain name (i.e. <verisign.hk>) were concerned. That decision dismissing the complaint was made on 19 January 2007. The grounds for doing so are that the Complainant had failed to prove paragraph 4(a)(i) of the HKDNRP.

In the present Complaint, the Complainant seeks to rely on a number of decisions made under the UDRP to assert that, because the Respondent has substantially changed the use of the <verisign.hk> domain name, the previous complaint does not have *res judicata* effect on the current Complaint.

This is obviously an important preliminary issue in this case on whether the Complaint, being a 're-filed' complaint, can be entertained under the HKDNRP. At the time of this decision, this Panel is aware of no other case decided under the HKDNRP (rather than the UDRP) that discusses the position of such a 're-filed'

complaint.

Thus, this Panel have to proceed to consider this preliminary issue under the regime of the HKDNRP and observes the followings:-

- (1) The proceeding under the HKDNRP is (as per paragraph 4 of the HKDNRP) a mandatory arbitration proceeding and this is different from that under the UDRP, which is (as per paragraph 4 of the UDRP) an mandatory administrative proceeding.
- (2) The HKDNRP, unlike the UDRP and in particular paragraph 4(k) thereof, contains no express provisions for catering for a complainant or a respondent to submit the dispute in issue to a court of competent jurisdiction for independent resolution before such mandatory proceeding is commenced or after such proceeding is concluded.
- (3) As a matter of fact, the Rules contain an extra preamble that: “*Arbitration proceedings for the resolution of disputes under the Dispute Resolution Policy adopted by the HKDNR shall be governed by these Rules of Procedure, the Supplemental Rules of the Provider administering the proceedings, the Arbitration Ordinance (Chapter 341)*”.

In the circumstances, those decisions concerning cases under the UDRP are decided under a very different regime, as compared to the HKDNRP. As such, this Panel should not simply take on board the outcome in such decisions, though they may still be of persuasive values in this regard, but to approach this matter from first principles.

Under the paragraph 14 of the registration agreement, which deals with dispute

resolution, a respondent agrees to submit the dispute over the registered domain name for handling in accordance with the HKDNRP when its domain name registration is challenged by a third party and the decision made by an Arbitration Panel accordingly shall be final and binding on the respondent. In the complaint form, i.e. Form A, it is contained in paragraph 14 as part of the certificate from the complainant that “[t]he Complainant, by submitting the Complaint agrees to the settlement of the dispute, regarding the domain name which is the object of the Complaint by final and binding arbitration in Hong Kong in accordance with the HKDNR Domain Name Dispute Resolution Policy, HKDNR Domain Name Dispute Resolution Policy Rules of Procedure and the Hong Kong International Arbitration Centre Supplementary Rules.”

Thus, the final and binding nature of the decision by the Arbitration Panel is expressly provided for in the mandatory arbitration proceeding under the HKDNRP. This is also in accord with the purpose for the HKDNRP for speedy and efficient resolution of domain name disputes, as well as with back up from the Arbitration Ordinance (Cap.341).

As per paragraph 12(a) of the Rules, “[a]n Arbitration Panel shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Dispute Resolution Policy, the Rules of Procedure, the Provider’s Supplementary Rules and the law which the Arbitration Panel deems applicable.” For this, as put in the WIPO decision under the UDRP in *Creo Products Inc. v. Website In Development* (Case No. D2000-1490), there is of application the broad principle as likewise found in most other common law jurisdiction that, once a party has been given a defended hearing in a court and a decision rendered, then a case cannot be re-litigated unless either the decision is overturned on appeal, or limited grounds for rehearing or reconsideration by the

first-instance court have been established. Such limited grounds are usually specified in rules of court and can include, for example: serious misconduct on the part of a judge, juror, witness or lawyer; perjured evidence having been offered to the court; the discovery of credible and material evidence which could not have been reasonably foreseen or known at trial; and a breach of natural justice. Applying these principles to domain name disputes under the UDRP, a re-filed case may only be accepted in limited circumstances. These circumstances include that the complainant establishes in the complaint that relevant new actions have occurred since the original decision, or that a breach of natural justice or of due process has occurred, or that there was other serious misconduct by the panel or the parties in the original case (such as perjured evidence). A re-filed complaint will also be accepted if it includes newly presented evidence that was unavailable to the complainant during the original case.

As in the case of the UDRP, there is likewise no procedure in the HKDNRP, the Rules or the Supplemental Rules for either an appeal against a Panel's decision or for a reconsideration of a Panel's decision once it has been given on a compliant. On the other hand, there is not any procedure or express prohibition under the HKDNRP, the Rules or the Supplemental Rules that deals with the re-filing of a complaint between the same parties and in relation to the same domain name.

In this regard, this Panel considers that a distinction has to be made between those re-filed complaints that concern acts which formed the same basis of the previous complaint and those that concern acts which have occurred subsequent to the decision on the previous complaint. In relation to complaints in the latter category, this Panel is of the view that the concept of *res judicata* does not arise. There has been

a standing agreement to submit disputes to be settled by the mandatory arbitration proceeding under the HKDNRP, whenever any third party submits a complaint thereunder. As a result of the presence of acts that occurred after the previous decision, no adjudication has yet been made in relation to the new complaint and the new complaint is indeed a new set of action under the HKDNRP. In such circumstances, the panel should approach the merits of the complaint *de novo*, as required under the HKDNRP when a complaint is made out, and should not be restrained by the findings of fact or conclusions reached in the decision of the previous complaint. The logic for that seems quite obvious. Being a new action, the HKDNRP calls for determination of the complaint in the same manner as any new complaint under the HKDNRP. Of course, the question of whether sufficient grounds exist for entertaining a re-filed complaint, even within this category, must be determined on a case-by-case basis.

Adopting the above, this Panel believes that the burden, which is a high one, rests on the Complainant to establish that this Complaint should be entertained for determination under the HKDNRP and the justifications for that should be clearly identified in the Complaint.

Applying these principles to the present case, the acts, subsequent to the previous complaint and relied upon by the Complainant are essentially that:(i) during the previous complaint proceedings, the Respondent's website is password protected and the Respondent stated that it was nothing more than a 'test site'; but now the website is available to the general public containing the Complainant's "VeriSign" trademark, in large letters; (ii) the Complainant has since been discovered that the Respondent has registered at least ten additional domain names in violation of Hong Kong



trademark rights, illustrating the Respondent's bad faith intentions, thereby providing creditable and new materials. As regards acts as per (i), at the time of the previous complaint, it appeared that the Respondent had undertaken no activities in relation to making public the website of the Disputed Domain Name. Thus, the acts in making available to the general public such a website are not in substance the same as those acts on which the previous complaint was based. As such, these are acts subsequent to the previous complaint to justify the present Complaint to be entertained for determination under the HKDNRP. On the other hand, regarding acts as per (ii), these domain names now relied on were all registered before the date of filing the previous complaint. No explanation was tendered by the Complainant on why these evidence could not have been known until after the previous complaint. These evidence are, therefore, not sufficient justification for the present Complaint to be entertained for determination under the HKDNRP. Nonetheless, with those acts in (i), this Panel concludes that the present Complaint is one that should be entertained for determination under the HKDNRP.

The Panel observes that the gist of the Respondent's submission in this regard is that the Complainant should have presented all the evidence it have or can have at the time of the previous complaint and should not be allowed a chance to reopen the case by filing the present Complaint. What is however clear is that those acts as per (i) only exist subsequent to the previous complaint. Hence, in the light of the above, this Panel declines to adopt the Respondent's submission. Also, there is no challenge to the jurisdictions of the Panel in deciding this matter from the Respondent and the Respondent took part in the present proceeding filing a substantive Response.

This Panel also notes that the other category for those re-filed complaints that

concern acts which only formed the same basis of the previous complaint will be treated quite differently, bearing in mind that mandatory arbitration proceeding, rather than merely mandatory administrative proceeding, is stipulated under the HKDNRP. However, for the present case, as discussed in the above, there is no need to consider whether the Complaint does also fall into this category of re-filed complaints.

***Whether Identical or Confusingly Similar to a Trademark or Service Mark in Hong Kong in which the Complainant has Rights***

The Complainant provides documents of trademark registration to support its claim of rights over the mark “VeriSign”. These include trademark registration nos. 2302350, 2559289, 2758215 and 2758214 in the United States and trademark registration nos. 200005811, 200016644 and 200106066 in Hong Kong. In response, the Respondent pointed out that the Complainant did nothing to register during the ‘soft launch period’ nor the ‘sunrise period’. This Panel is of the view that these, by themselves, cannot affect the otherwise rights of the Complainant has over its “VeriSign” mark. Therefore, the Panel finds that the Complainant has succeeded in establishing the necessary trademark rights under paragraph 4(a)(i) of the HKDNRP.

Though the Respondent said that the word “Verisign” was a family name and gave examples for persons with such a family name in United States, no evidence to show that the word “Verisign” was a family name commonly encountered in Hong Kong was adduced. This Panel finds that the name or mark “verisign” is not in the daily use of the English language nor a generic term, at least in Hong Kong. The Panel also agrees that the part of the Disputed Domain Name “.hk” is the ccTLD for

Hong Kong and, as such, should be of descriptive nature. Thus, the distinctive part of the Disputed Domain Name is “verisign”. The only differences between this and the Complainant’s “VeriSign” mark are the capital “V” and the capital “S” letters. They are also identical phonetically. Hence, the Panel finds that the Disputed Domain Name or the distinctive part thereof is identical or confusingly similar to the name or the mark of “VeriSign”.

Therefore, the Panel finds that the Complainant has succeeded in discharging the burden on its part to establish this element under paragraph 4(a)(i) of the HKDNRP.

***Whether the Respondent has no Rights or Legitimate Interests in respect of the Domain Name***

The Complainant alleged that the Respondent had no rights or legitimate interest in respect of the Disputed Domain Name. The Respondent remarked that “[i]here is no question in my mind that VeriSign is a trademark of a company” but asserted that, being a family name, the Complainant did not have exclusive rights to use the name or mark of “VeriSign”.

Paragraph 4(c) of the HKDNRP provides that the Respondent may demonstrate its rights to and legitimate interests in the Disputed Domain Name by proving any one of the following circumstances:-

- (i) before any notice to the Respondent of the dispute, the Respondent’s use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide

- offering of goods or services in Hong Kong; or
- (ii) the Respondent (as an individual, business, or other organisation) have been commonly known by the Disputed Domain Name, even if the respondent has acquired no trade mark or service mark rights in Hong Kong; or
  - (iii) the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

From the name of the Respondent, the Panel notices that there is no direct link between it and the distinctive part of the Disputed Domain Name, that is to say “verisign”. No explanation was put forward by the Respondent on why he, not having a family name as “Verisign”, registered to Disputed Domain Name and put it to use by showing “Verisigns' of Georgia Family Tree” on the website. From the address, the Respondent did not seem to be in Georgia either.

To the various allegations of the Complainant regarding the Respondent having no right in the Disputed Domain Name, there is no rebutting evidence from the Respondent showing the contrary. The Panel also finds no evidence to support a finding of any of the circumstances in paragraph 4(c) of the HKDNRP as aforesaid. As a matter of fact, the Panel is of the view that the evidence relied on by the Complainant indicated quite the opposite.

Therefore, taking into consideration of the overall evidence, the Panel accepts that the Respondent has no right or legitimate interests in respect of the Disputed Domain Name, as required under paragraph 4(a)(ii) of the HKDNRP.

***Whether the Respondent's Domain Name has been Registered and is being Used in Bad Faith.***

Pursuant to paragraph 4(b) of the HKDNRP, for the purposes of Paragraph 4(a)(iii) of the HKDNRP, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a Disputed Domain Name in bad faith:

- (i) circumstances indicating that the Respondent has registered or acquired the Disputed 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 Respondent's documented out-of-pocket costs directly related to the Disputed Domain Name; or
- (ii) the Respondent has registered the Disputed Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Disputed Domain Name, provided that you have engaged in a pattern of such conduct; or
- (iii) the 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, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent'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 Respondent's web site or location or of a product or service on the Respondent's web site or location.

The test for bad faith here is conjunctive and there must be evidence that the Disputed Domain Name has been registered in bad faith and is being used in bad faith.

The Complainant contends that the Respondent's registration and use of the Disputed Domain Name is both with bad faith. To this, the Respondent disagreed.

From the parties' submissions, there are factual disputes between the Complainant and the Respondent as regards what has taken place or said in the various emails and other communications between the parties. Obviously, such factual disputes cannot be resolved merely on documents and, as such, this Panel is not able to take them into account in reaching a decision on this aspect, one way or the other. What is however clear from the evidence is that the Respondent has registered a number of domain names using various well-known trademarks. All these point to the engagement of the Respondent in a pattern of such conduct as per paragraph 4(b)(ii) of the HKDNRP. On the website of the Disputed Domain Name, it contains only one page and, apart from those words of "Verisigns' of Georgia Family Tree", the only other words thereon are two Chinese characters meaning "Under Construction" and the words "Coming Soon" in English. This was notwithstanding that the Disputed Domain Name has been registered since May 2005, some 2 years from the time of this Complaint. This Panel thus sees this as not much different from mere passive holding of the Disputed Domain Name during such a relatively long period of time. Also, there was no evidence before this Panel to show that there has been

preparation or plan of active use of the Disputed Domain Name by the Respondent.

More importantly, it was the Respondent's own remarks in the Response that "[t]here is no question in my mind that VeriSign is a trademark of a company". As a matter of fact, the Respondent, as per the Response, was in the business of website design, which belonged to the same Internet business sector as the Complainant was in.

On the above basis, this Panel finds that the Respondent was aware of the trademark "VeriSign" when registered the Disputed Domain Name and that the registration and use of it is with bad faith under paragraph 4(a)(iii) of the HKDNRP.

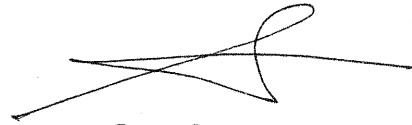
Therefore, taking into consideration of the overall evidence and the parties' submissions, the Panel finds that the Complainant has established that the Respondent has registered and is using the Disputed Domain Name in bad faith, as per paragraph 4(a)(iii) of the HKDNRP.

In the circumstances, the Respondent's claim of reverse domain name hijacking is rejected.

## **6. ARBITRATION DECISION**

In view of the findings as set out above, the Panel finds that the Complainant has succeeded in proving that all of the 3 elements of paragraph 4(a) of the HKDNRP are present. Therefore, this Complaint succeeds and this Panel accordingly directs

that the Disputed Domain Name registration shall be transferred to the Complainant.

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke extending to the right.

Gary Soo  
Arbitration Panelist

Date: 11 May 2007