



Hong Kong International Arbitration Centre

香港國際仲裁中心

.hk Domain Name Dispute Resolution

ARBITRATION PANEL DECISION

Case No.	DN-0200005
Complainant:	Management Reports International (H.K.) Limited
Respondent:	Reckon Hong Kong Limited

1. THE PARTIES AND CONTESTED DOMAIN NAME

The Complainant is **Management Reports International (H.K.) Limited** of 26th Floor, Wing On Centre, 111 Connaught Road, Central, Hong Kong.

The Respondent is **Reckon Hong Kong Limited** (formerly, Intuit Hong Kong Ltd.) of Unit D, 13th Floor, Guangdong Tours Centre, 18 Perrington St., Causeway Bay, Hong Kong.

The domain name at issue is "**intuit.com.hk**", registered by the Respondent with the Hong Kong Domain Name Registration Co. Ltd. or HKDNR (previously administered as HKNIC) of 306A, HKITC, 72 Tat Chee Avenue, Kowloon Tong, Hong Kong.

2. PROCEDURAL HISTORY

A Complaint in respect of "**intuit.com.hk**", was filed with the Hong Kong International Arbitration Centre ("HKIAC") in terms of the prescribed Form A on 5th December 2002.

The undersigned arbitrator was contacted by the HKIAC on 24th December 2002 and confirmed his acceptance of the case and declaration of impartiality and independence to the HKIAC on 29th December 2002. The Form A Complaint and supporting documents were sent to the Panelist on 31st December 2002.

The parties were given 7 days to object to Mr. Francis's appointment. No adverse comment having been received from the parties, Mr. Francis's appointment was confirmed on 2nd January 2003.

Following a review of the Complaint, the Panelist requested further clarification of certain issues and invited the Complainant to provide further evidence to support its claim. The Panelist received such evidence on 20th February 2003.

3. FACTUAL BACKGROUND

For Claimant

The Complainant states that it is a company registered in Hong Kong and is a

wholly owned subsidiary of Intuit Inc. ("Intuit"), a corporation organized and existing under the laws of the State of California, USA. The Complainant asserts that Intuit is the worldwide owner of the trademark INTUIT in connection with financial, accounting and tax related goods and services, including online services.

In relation to the INTUIT trade mark, the Complainant has submitted a copy of a Trade Mark Registration Certificate to show that Intuit registered the trade mark INTUIT in Class 36 in Hong Kong with effect from 21st January 1997. The services of interest taken from trade mark registration certificate no. 12013 of 1999 are in respect of "electronic banking and payment administration services relating to bills, provisions of information relating to finance, monetary transaction, insurance and investment; all included in Class 36". There are also two published Hong Kong trade mark applications for the trademark INTUIT in Classes 9 and 38 (filed in 1996 and 1997) and a pending Hong Kong application in Class 42 (filed in 1997).

The Complainant has provided the following historical background, together with supporting documentation (where appropriate).

Intuit has licensed to the Complainant the right to use the INTUIT mark for the purposes of registering and maintaining it as a domain name in Hong Kong. The Respondent was a former distributor of Intuit in Hong Kong. However, at no time did Intuit, either formally or informally, give the Respondent the right to register the INTUIT mark as a domain name in Hong Kong.

The Complainant has submitted documents to demonstrate that the Respondent has now been liquidated and that this process was completed on 10th October 2002.

Prior to the liquidation, the Complainant attempted to obtain a transfer of the domain name through the mechanism provided by HKDNR. The Complainant has submitted a copy of a letter dated 5th April 2002 from Reckon Pacrim Pty Limited ("Reckon Pacrim"), a company which wholly owned the Respondent and which asserted that it was a beneficial owner of the intuit.com.hk domain name prior to the Respondent's liquidation. Reckon Pacrim stated in the letter that it consented to and raised no objection to the transfer of the domain name to Intuit on condition that Intuit bore the costs of such transfer. However, it appears that the transfer was not completed at this time.

Subsequently, the liquidator of the Respondent was not in a position to authorize the transfer of the domain name in issue given that the request to transfer the domain name was made by the Complainant on 19th October 2002, after the liquidation had been completed. Accordingly, the Complainant's attempts to transfer the domain name were unsuccessful.

The Complainant has also submitted a letter dated 17th December 2002 from Reckon Limited ("Reckon") (formerly, Reckon Software Pty. Ltd.), the technical contact of the domain name, in which Reckon stated that it consented to and raised no objection to the transfer of the domain name, intuit.com.hk, to the Complainant.

For Respondent

The Respondent has been wound-up. Accordingly, the Respondent has not filed any

documents by way of background.

4. PARTIES' CONTENTIONS

The Complainant

The Complainant contends that the registration of the domain name should be transferred to it. The Complainant has filed evidence to support its Complaint.

The Respondent

The Respondent has been wound-up. Accordingly, the Respondent has not filed any response to the Complaint nor any evidence in support thereof.

5. DISCUSSION AND FINDINGS

General

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving that:-

- a. 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
- b. the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- c. the Respondent's Domain Name has been registered and is being used in bad faith.

Identical / Confusing Similarity

The Complainant has provided evidence to substantiate that it is the licensee of rights in the trade mark "INTUIT" in Hong Kong, both in terms of registered rights (and applications therefor) and unregistered rights (through Intuit and the Complainant carrying on business under and by reference to the trade mark in Hong Kong). The domain name in issue, namely intuit.com.hk, is identical to the trade mark "INTUIT" in which the Complainant has rights. As such, the Panel finds that the domain name in issue registered by the Respondent is identical or confusingly similar to trade marks in Hong Kong in which the Complainant has rights.

Right or Legitimate Interests of the Respondent

The Complainant asserts that Intuit granted only a limited licence to the Respondent to use its trade marks. Furthermore, the Complainant has filed evidence to the effect that the Respondent was not permitted by Intuit to apply for or use any domain name incorporating its trade marks. The Respondent has not provided any evidence of any circumstances giving rise to a right to or legitimate interest in respect of the domain name in issue. In fact, given that the Respondent has been wound up and its liquidation has been completed, there appears to be currently no beneficial owner of the Respondent's registration of the domain name in issue. The Panel therefore

concludes that the Respondent has no rights or legitimate interests in the domain name in issue.

Bad Faith

The test for bad faith is conjunctive and there must be evidence not only that the domain name has been registered in bad faith, but also that it is being used in bad faith. The Complainant has provided prima facie evidence of bad faith on the part of the Respondent in registering the domain name. The Respondent was the Hong Kong distributor of Intuit and registered the domain name without obtaining Intuit's permission.

In terms of use of the domain name, the Respondent has already been wound up, it no longer conducts any business activity and it cannot now use the domain name.

It was established in "Telstra Corporation Limited v. Nuclear Marshmallows" [WIPO Case No. D2000-0003] (and applied in "Outblaze Limited -v- Wah Cheung Leatherware Company Limited" [HKIAC Case No. 0106-0001]) that inactivity and passive holding of a domain name may be construed as positive action in bad faith if relevant circumstances are present. In the instant case, the following circumstances are present:

- d. there has been a lack of use of the Respondent's website as a result of the Respondent's liquidation;
- e. the permanence of the domain name registration and the existence of an inaccessible website may lead internet users to believe that the Complainant does not own the intuit.com.hk pages or that it is not technically able to maintain an active website (see "Group Financiero Inbursa, S.A. de C.V. -v- Alejandro Delgado-Ayala" [WIPO Case No. D2001-0172]); and
- f. the Respondent has provided no evidence of any actual or contemplated good faith use by it of the domain name (Telstra, above).

The circumstances listed above are relevant and lead the Panel to infer and to find, in the absence of any evidence from the Respondent to the contrary, that the domain name in issue was registered and is being used in bad faith.

6. ARBITRATION DECISION

The Panel requires that the domain name, intuit.com.hk, be transferred from the Respondent to the Complainant.

Nigel Francis
Arbitrator Panelist

Dated: March 7, 2003