



香港國際仲裁中心
Hong Kong International Arbitration Centre

hk Domain Name Dispute Resolution

ARBITRATION PANEL DECISION

Case ID : DN-0500015
Disputed Domain Name : www.lucky-number.com.hk
Case Administrator : Dennis CHOI
Submitted by : Raymond HO
Participating Panelist : Raymond HO
Date of Decision : 29 March 2005
Complainant : www.lucky-number.com
Respondent : Pretty Number Service Co.

I. THE PARTIES

1. The Complainant is www.lucky-number.com of Room A211, Ground Floor, Shop 1, Ho Chuck Centre, Kwai Yi Road, Kwai Chung, New Territories, Hong Kong. Roger Lau of the same address is the authorized representative of the Complainant.
2. The Respondent is Pretty Number Service Co. of Flat/Room 801, 655 Nathan Road, Mongkok, Kowloon, Hong Kong. Ricky Cheung of the same address is the authorized representative of the Respondent.

II. THE DOMAIN NAME AND REGISTRAR

The domain name at issue is “www.lucky-number.com.hk” and it was registered by the Respondent with Hong Kong Domain Name Registration Company Limited (“HKDNR”) on 7 September 2004.

III. PROCEDURAL HISTORY

1. A Complaint in respect of “www.lucky-number.com.hk”, was filed with the Hong Kong International Arbitration Centre (“HKIAC”) in the prescribed Form A on 28 January 2005.
2. On 28 January 2005, the Case Administrator at HKIAC acknowledged receipt of the Complaint and notified HKDNR of the filing of the Complaint.
3. On 28 January 2005, it was confirmed by the Case Administrator that the domain name “www.lucky-number.com.hk” is registered with HKDNR and

that Pretty Number Service Co. is the current registrant of that domain name in the HKDNR “WHOIS” database.

4. On 5 February 2005, a Notification of the Commencement of the Proceedings (“the Commencement Notification”) was transmitted to the Respondent (with a copy to the Complainant), giving the Respondent 20 calendar days from 5 February 2005 to submit a Response to the Complaint in accordance with the HKDNR Domain Name Dispute Resolution Policy (“the Policy”), the HKDNR Domain Name Resolution Policy Rules of Procedure (“the Rules”) and the HKIAC Supplementary Rules (“Supplementary Rules”). The Commencement Notification was transmitted to the Respondent by email to the e-mail address indicated in the Complaint and specified in HKDNR “WHOIS” database.
5. On 25 February 2005, having received no response from the Respondent, using the same contact details and method as was used for the Commencement Notification, the Case Administrator transmitted to the parties a notification of Respondent’s default.
6. No response or other communication has been received by HKIAC or the Case Administrator from the Respondent since the notification referred to in the above paragraph.
7. On 8 March 2005, based on the Complainant’s designation of a sole panelist, HKIAC invited the Panelist to serve as the sole panelist in this Case No.DN-0500015 and transmitted to the Panelist a Statement of Acceptance and Request for Declaration of Impartiality and Independence.
8. Following the Panelist’s submission of his Statement of Acceptance and Declaration of Impartiality and Independence on 8 March 2005, HKIAC transmitted to the parties by email a Notification of Confirmation of Appointment of the Panelist (with a copy to the Panelist by email).
9. The Panelist finds that the Panel was properly constituted and appointed in accordance with the Policy, the Rules and the Supplementary Rules.
10. On 14 March 2005, having reviewed the Form A and the supporting documents filed by the Complainant, the Panelist issued the Direction by the Panel No.1 (“Direction No.1”) by email, directing that
 - “(a) the Complainant DO file with the HKIAC within the next three (3) days, the following documents :
 - (i) the Business Registration Certificate and the registered particulars of the Complainant's company (if a sole proprietor or partnership) registered at the Business Registry of the Inland Revenue Department; and if the company is a limited company, the Certificate of Incorporation and the lists of directors and shareholders registered at the

Companies Registry in relation to the business in Hong Kong of the Complainant that owns www.lucky-number.com Together also with the relevant documentary proof that it started its business operation in Hong Kong since 1997; and

- (ii) registration documents in relation to the registration of the trade-mark of www.lucky-number.com.
- (b) A copy of all documents hereafter filed with HKIAC by the Complainant pursuant to paragraph 1 above be provided to the Respondent forthwith after receipt by HKIAC and the Respondent will be given three (3) days thereafter within which to respond in writing.”
11. On 14 March 2005, the Case Administrator notified the parties of Direction No.1 by email and requested the Complainant to respond and submit the supplemental documents by close of business on 17 March 2005, with a copy to the Respondent.
12. On 16 March 2005, the Complainant sent a email to the Case Administrator (with a copy to the Panelist) stating (inter alia) that :
- (a) “due to the business privacy concern”, if all documents forwarded to the Panel should be copied to Respondent, the Complainant would give up forwarding these documents to the Panel”; and
 - (b) the Complainant had not proceeded with the registration of www.lucky-number.com for the trade-mark because the Complainant was querying about “its cost-justification means”.
13. On 16 March 2005, the Panelist issued by email Direction by the Panel No.2 (“Direction No.2”) to the parties, directing that
- “(a) the Applicant's email of 16 March 2005 be transmitted immediately to the Respondent by the Case Administrator;
 - (b) all communications by either party to the Case Administrator must be in writing and a copy of such communication must be given to the other party of this case;
 - (c) all future communication, information and documents by either party to the Panel must be copied in its entirety to the other party of this Case; and
 - (d) Direction by the Panel No.1 dated 14 March 2005 must be complied by the Applicant and the Respondent be given the right to respond within the time stipulated in the Direction.”

14. On 16 March 2005, the Case Administrator issued by email to the parties Direction No.2 and requested them to act accordingly. The email to the Case Administrator by the Complainant on 16 March 2005 was forwarded to the Respondent.
15. On 17 March 2005, the Case Administrator received by email from the Complainant a copy of the certified copy of a Certificate of Incorporation of WWW.LUCKY-NUMBER.COM LIMITED (專業秣把有限公司) issued by the Registrar of Companies, Hong Kong on 8 February 2005 and a copy of the certified copy of a Business Registration Certificate of this Company for the period from 8 February 2005 to 7 February 2006 bearing with a stamped receipt of the fees and levy paid on 15 February 2005. Such copies were forwarded by email to the Respondent and the Panelist on the same date.
16. The Respondent has thereafter not responded to Direction No.1 and Direction No.2.

IV. FACTUAL BACKGROUND

1. The Complainant's business name is “專業秣把, www.lucky-number.com”. But no evidence in relation to the registration of this business or trade in Hong Kong as a firm or as a partnership has been submitted by the Complainant except the incorporation of “WWW.LUCKY-NUMBER.COM (專業秣把有限公司)” in Hong Kong in February 2005 after the filing of this Complaint.
2. The Complainant alleges that it started its business operation in 1997 and its web operation since March 2000.
3. Based on the “WHOIS” database of Network Solutions, the Complainant is the registrant of the domain name www.lucky-number.com from 6 March 2000 to 6 March 2007.
4. While the Complainant alleges that it owns the trade-mark of www.lucky-number.com, it admits that it has not sought or obtained registration of this mark with the Trademark Registry in Hong Kong or elsewhere.
5. The major business run by the Complainant on its website www.lucky-number.com covers the trading business of all kinds of telephone, mobile and personal communication numbers, and agency services.
6. The Complainant advertised its business in the Hong Kong local magazines and newspapers. Based on the supporting documents referred to in Form A filed by the Complainant,
 - (a) in September 1999, the Complainant advertised its business under the business name “專業秣把” (literally means “professional number”) but not www.lucky-number.com;

- (b) in 2003, in addition to advertising its business name “專業秣把”, the Complainant included in its advertisements for business the website address of www.lucky-number.com;
 - (c) in an interview by a local magazine of the Complainant in August 2001 (published in its current website), the Complainant referred its business by the name “專業秣把” in each of the six paragraphs of the interview published and only at the end of the interview the Complainant stated that it owned the website www.lucky-number.com; and
 - (d) in the current website “www.lucky-number.com” (bearing the words copyright @2004), the Complainant used the opening words “你的專業幸運號碼” in Chinese (literally means “your professional lucky number”) in English as title of the webpage.
7. The Respondent is running the same type of business as the Complainant and it trades under the company name of “Pretty Number Service Co.” and its website www.prettynumber.com.
 8. The Respondent has used the newly registered website “www.lucky-number.com.hk” to compete with the Complainant.
 9. The domain name of the Complainant’s website and that of the Respondent’s website are similar and so are their business operations.
 10. In one email in Chinese dated 16 January 2005 from a representative of the Respondent to the Complainant that was sent through a free lucky-number trading forum <http://www.i-tnet.com>, the Respondent claimed that it had registered the domain name www.lucky-number.com.hk and that it would use it for its business operation if the Complainant continued to compete with it on the forum. The Respondent suggested to the Complainant to make it an offer to buy back this domain name.
 11. From the information in the internet, the Respondent did run the same trading business of lucky numbers as the Complainant at the website www.lucky-number.com.hk in addition to the Respondent’s other website www.prettynumber.com.
 12. The Complainant alleges that the matters in the above paragraphs 10 and 11 are evidence of malicious intention on the part of the Respondent to register and use the domain name at issue.

V. PARTIES’ CONTENTIONS

1. The Complainant contends that the Respondent has registered the domain name www.lucky-number.com.hk which is identical or confusingly similar to a trade or service mark in Hong Kong in which the Complainant has

rights; that the Respondent has no rights or legitimate interests in respect to the domain name at issue; and that the Respondent has registered and is using the domain name in bad faith.

2. The Respondent has not submitted a response.

VI. DISCUSSION AND FINDINGS

1. Under Paragraph 15(a) of the Rules, “an Arbitration Panel shall decide a Complaint on the basis of the statements and documents submitted to it and in accordance with the Policy, the Rules, the Supplementary Rules and the law that the Arbitration Panel deems applicable.”. By the combined operation of Paragraphs 5(e) and 14(b) of the Rules, a Respondent’s failure to respond does not automatically subject it to an adverse decision akin to a default judgment; rather, the Panel in such cases must “decide the dispute based on the complaint,” and may only draw such inferences from the Respondent’s default “as it considers appropriate.”.
2. Pursuant to Paragraph 4(a) of the Policy, in order to prevail, a Complainant must prove **each** of the following elements :
 - (i) That the Respondent’s domain name is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights;
 - (ii) That the Respondent has no rights or legitimate interest in respect to the domain name; and
 - (iii) That the Respondent’s domain name has been registered and is being used in bad faith.
3. The threshold issue under Paragraph 4(a) is whether Complainant has protectable "rights" in the mark to which it contends Respondent’s domain name is identical or confusingly similar. In plain text, it is unarguable the domain name at issue is essentially identical to the Complainant’s mark in its registered website www.lucky-number.com. “Lucky-number” is a descriptive and generic phrase in common use. It is not clear what the Complainant meant by querying the costs justification to register this mark as a trade-mark. But, it is no surprise that the Complainant has no registered trade-mark rights on this mark, As such, there is no presumption of the exclusive right to use such a mark afforded by registration and the Complainant must prove that its mark has become distinctive by acquiring a secondary meaning through extensive use of the mark : *Office Cleaning Services Ltd. v. Westminster Window & General Cleaners Ltd. [1946] 63 RPC 39* and *Land Power International Holdings Ltd. & others v. Inter-Land Properties (H.K.) Ltd. [1995] HKLRD 750*.
4. It requires a demonstration that the mark, by means of sufficient marketing, sales, usage, and passage of time, has become identified in the public mind

with a particular source of the goods or services. In the case of Office Cleaning, the House of Lords found that even on proof of 12 years of use of the name “Office Cleaning”, the name had not overcome its descriptive connotations and acquired a secondary meaning.

5. Apart from the advertisements in local Hong Kong magazines and newspapers, the Complainant has presented no evidence of consumer surveys, focus group studies, or other information, showing that consumers have come to associate “lucky-number.com” with the Complainant.
6. In fact, the Complainant’s trade name “專業秣把” (literally means “professional number”) is at variance with the word “lucky-number”. As late as 2003, the Complainant still advertised its business as “專業秣把” rather than “lucky-number” save that www.lucky-number.com was shown in these advertisements as its website address. In the 2004 version of its webpage, it began to use “Lucky-number.com” as its trade name to the consuming public and its business description in Chinese was slightly changed to “專業幸運號碼” (literally means “professional lucky number”). The name of the newly incorporated company is 專業秣把有限公司 in Chinese and WWW.LUCKY-NUMBER.COM LIMITED in English. In the circumstances, the Complainant’s domain name is no more than a direct description of its service; and such a mark cannot be monopolized and is therefore not entitled to protection.
7. The Complainant’s burden to establish that it has acquire common law trade-mark rights by acquired distinctiveness is particularly high where the mark asserted comprises words in common usage, as it does in this case. The Panelist finds that the Complainant has failed to establish such rights, whether at the date when the domain name at issue was registered (7 September 2004) or currently. It is therefore unnecessary to consider Paragraph 4(a)(ii) and (iii) of the Policy.

VII DECISION

Complainant’s request that the domain name <www.lucky-number.com.hk> be transferred from Respondent to Complainant is denied; and the Complaint is dismissed.

Dated : 29 March 2005

RAYMOND HO
Panelist