



香港國際仲裁中心

Hong Kong International Arbitration Centre

.hk Domain Name Dispute Resolution

ARBITRATION PANEL DECISION

Case No.	:	DHK-0700023
Complainant	:	Produits Berger
Respondent	:	Zhuhai Talent Edu-Tech Co. Ltd.

1. THE PARTIES AND CONTESTED DOMAIN NAME

The Complainant is incorporated in France as a joint-stock limited company and its address is at 67 Avenue Victor Hugo, 75116 Paris, France. The authorised representative of the Complainant in this matter is Wenping & Co. at 17/F, Tung Wai Comm. Bldg., 111 Gloucester Road, Hong Kong.

The Respondent is Zhuhai Talent Edu-Tech Co. Ltd., with address at 1-6B, No. 19, Street Longxing, Jida Zhuhai 519015, China.

The domain names at issue (the “Disputed Domain Name”) is <lampeberger.hk>, registered on 13 May 2006 by the Respondent. The administrative contact of the Disputed Domain Name is “Hao Dongning”.

2. PROCEDURAL HISTORY

The complaint in respect of <lampeberger.hk> was filed with the Hong Kong International Arbitration Centre (“HKIAC”) in terms of the prescribed Form A on 5 September 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 6 September 2007, the HKIAC received confirmation on the registration details of the Disputed Domain Name and the Respondent was notified of the commencement of the proceeding, requesting a response to be submitted within the stipulated time, i.e. 15 business days therefrom.

On 29 September 2007, the HKIAC informed the parties by email that a response to the complaint has not been submitted by the Respondent within the required period of time and that the Panel would be appointed to proceed with this matter shortly.

Thereafter, 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 29 January 2008 and the Panel was requested to render a decision on or before 22 February 2008.

3. FACTUAL BACKGROUND

For Complainant

The Complainant is the registered holders of the “LAMPE BERGER” trademarks in Hong Kong, the registration numbers of which being 200105852AA, 200108763AA & 300464742.

For Respondent

The Respondent registers the Disputed Domain Name on 13 May 2006.

4. PARTIES' CONTENTIONS

For Complainant

On the Complainant's rights, the Complainant points out that they are the holders of the registered trademarks of “LAMPE BERGER” and produces printed records from the website of the Trade Marks Registry of the Hong Kong Intellectual Property Department to show that the Complainant is the owner of trademark registration in Hong Kong, nos. 200105852AA, 200108763AA & 300464742. The dates of registration are since 15 June 1999.

The Complainant says that the “.hk” part of should be disregarded as per the decision of *Croatia Airlines d.d. v. Modern Internet Empire Ltd.* (WIPO Case No. D2003-0455).

As regards the Respondent’s rights or legitimate interests in respect of the Disputed Domain Name, the Complainant asserts that the Respondent does not have any right or legitimate interests in this regard since:-

- (a) There is no active website under the Disputed Domain Name;
- (b) The registration by the Respondent appears to have been intended to exploit the Complainant’s “LAMPE BERGER” trademark and/or business name, rather than using it in a bona fide offering of goods and/or services and/or a legitimate non-commercial use without intent for commercial gain; and
- (c) The Respondent has not asserted any purported legitimate interest dispute previous correspondence being sent to the Respondent via a cease and desist letter on 31 July 2006.

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 Complainant has not licensed or otherwise permitted the Respondent to register the domain name incorporating the trademark “LAMPE BERGER” and there is no affiliation between the parties. The Respondent is not an authorized agent or licensee of the Complainant’s products and/or services in any way.
- (b) The effect of the Respondent’s registration of the Disputed Domain Name has been preventing the Complainant from using its business name and/or

trademark rights, to be reflected in a corresponding domain name in Hong Kong.

- (c) The Respondent is currently running a passive/non-active website, and thus such inactivity constitutes bad faith, on the basis of *Telstra Corporation Ltd. v. Nuclear Marchmallows* (WIPO Case No. D2000-0003). The Respondent further did not respond to any communication regarding the Complainant's allegations.
- (d) The Respondent would not have registered the Disputed Domain Name had the Respondent conducted a proper trademark search before registering it.
- (e) The Complainant has used "LAMPE BERGER" in many countries worldwide including but not limited to all major cities in Europe and Asia in connection with room deodorants and disinfectants for more than one century. Owing to the renowned reputation arising from long and extensive use of "LAMPE BERGER" by the Complainant, the Respondent should have deliberately selected and registered the Disputed Domain Name without justification.

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

For Respondent

The Respondent has not submitted any Response.

5. DISCUSSION AND FINDINGS

Elements under HKDNRP

Pursuant to paragraph 4(a) of the HKDNRP, a 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 Identical or Confusingly Similar to a Trademark or Service Mark in Hong Kong in which the Complainant has Rights

From the trademark records provided by the Complainant, the Complainant is the owner of the trademark "LAMPE BERGER" in Hong Kong. The Complainant also asserts that its trademark has been used in many Asian and elsewhere cities, for more than one century, and is with renowned reputation. These are also so stated in the cease and desist letter dated 31 July 2006, sent to the Respondent via the fax number as appeared in the registration details of the Disputed Domain Name. There was and still is no response nor objection to these from the Respondent. Indeed, no Response has been submitted to suggest the contrary.

On this basis, the Panel accepts that the Complainant owns the necessary rights under paragraph 4(a)(i) of the HKDNRP in respect of the mark of “LAMPE BERGER”.

In the Disputed Domain Name, the part “.hk” is the ccTLD for Hong Kong. The Panel also agrees with the Complainant that the main and most prominent features of the Disputed Domain Name is “lampeberger” and this is, to the Internet users, identical or confusingly similar to the “LAMPE BERGER” trademark of the Complainant.

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

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

The burden is on the Complainant to establish this from the evidence. Also, 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.

The Panel accepts that the Complainant has not authorized, licensed or otherwise permitted the Respondent to register or use the Disputed Domain Name or its trademark. To the Panel, there is no evidence that the Respondent holds any registered trademark or trade names in Hong Kong in relation to the “lampeberger” name or mark. Further, even from the name of the Respondent or its personnel, the Panel notices that there is no direct link between it and the distinctive part of the Disputed Domain Name, that is to say “lampeberger”.

The Complainant does suggest that, with the trademark rights of the Complainant that exist prior to the registration of the Disputed Domain Name, the Respondent must be well aware of its trademark being protected by law. To these, there is no denial or rebutting evidence from the Respondent and there is nothing from the Respondent explaining why it chooses to register the Disputed Domain Name.

Also, the Panel finds no evidence to support a finding of any of the circumstances in paragraph 4(c) of the HKDNRP. As a matter of fact, the Panel is of the view that the evidence relied on by the Complainant indicates 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, in relation to 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 the 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 does not indicate any disagreement. In any case, what seems clear from the evidence is that the Respondent has registered the Disputed Domain Name and kept it unused for quite a long time. The Panel accepts the reasoning as said in *Telstra Corporation Ltd. v. Nuclear Marchmallows* (WIPO Case No. D2000-0003), as regards the potential factors for identifying bad faith registration and use. Indeed, the Panel finds in these circumstances that such mere passive holding of the Disputed Domain Name during such a relatively long period of time does constitute bad faith on the part of the Respondent. Also, there is 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.

Moreover, the Panel is of the view that the name or mark of "LAMPE BERGER" is not one that is in the use of daily communications or languages. In the premises, this Panel further finds that the Respondent was aware of the trademark "LAMPE BERGER" when registered the Disputed Domain Name and, therefore, that the registration and use of it is with bad faith.

Therefore, taking into consideration of the overall evidence and submissions, the Panel finds that the Complainant has established that the registration and use of the Disputed Domain Name by the Respondent is in bad faith, as per paragraph 4(a)(ii) or (iii) of the HKDNRP.

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 the Panel accordingly directs the registration of the Disputed Domain Name <lampeberger.hk> be transferred to the Complainant.

Gary Soo
Arbitration Panelist

Date: 2 February 2008