Complainant: Eucalyptus Bio-Technology Co., Ltd.
Respondent: PA Extra Medical Co., Ltd.
Case Number: DHK-0900048
Contested Domain Name: <paextra.com.hk>
Panel Member: Mr. William Law

1. Parties and Contested Domain Name

The Complainant is Eucalyptus Bio-Technology Co., Ltd. with address at Rm. 1301, Java Comm. Centre, 128 Java Rd., North Point, Hong Kong. It is represented by Mr. Tommy Wong.

The Respondent is PA Extra Medical Co., Ltd., with address at Flat A, 9/F, West Gate Tower, 7 Wing Hong St., Cheung Sha Wan, Kowloon. It is represented by Benny Kong & Yeung.

The domain name under disputed is <paextra.com.hk> ("Disputed Domain") which is registered with HK Domain Name Registration Co Ltd. on June 28, 2009.

2. Procedural History

On July 15, 2009, the Complainant submitted a Complaint in English language with Hong Kong International Arbitration Centre ("HKIAC") and elected the case to be dealt with by one single panelist according to the HKDNR Domain Name Dispute Resolution Policy (the "Policy"). On July 18, 2009, HKIAC transmitted the acknowledgment of receipt to the Complainant.

On July 20, 2009, HK Domain Name Registration Co Ltd confirmed with HKIAC that the Respondent is the registrant of the Disputed Domain and the Policy shall apply.
On July 28, 2009, HKIAC transmitted the Complaint to the Respondent by email and informed the Respondent of the 15-day period to file a Response.

On August 18, 2009, the Respondent through its representative filed a Response with HKIAC.

On September 16, 2009, HKIAC informed the parties of the appointment of Mr. William Law as the sole panelist and the decision would be rendered on or before October 7, 2009.

The Complaint enclosed a copy of the Registration Agreement with HK Domain Name Registration Co Ltd in Chinese but the Complainant’s grounds are submitted, on the other hand, in English. The panelist has considered the language requirement laid down in the HKDNR Domain Name Dispute Policy Rules of Procedures (“Rules”) and the reality that both the Complainant and the Respondent, without objection, submitted their respective submissions in English. The panelist is of the view (and also agrees) that it is the common intention of both parties to use English in the proceedings notwithstanding the language of the Registration Agreement.

3. **Factual Background**

**For the Complainant**

The Complaint alleged the followings:

1). “PA Extra” trade mark registered by Trade Marks Registry Intellectual Property Dept. of HKSAR on 17/7/2006 as holder of Eucalyptus Bio-Technology Co., Ltd.


3). Hong Kong Customs & Excise Dept. replied the complaint letter for copyright & trademark infringement on 19/11/2008.

4). Notice of warning letter to infringement company.

**For the Respondent**

The Respondent’s background has been merged with the contentions as in below.

4. **Parties’ Contentions**

**The Complainant**

The Complainant contends that it is illegal to sale and purchase the Complaint’s product on internet website: PAEXTRA.COM.HK. and to sell infringing, pirated and
counterfeiting goods. The Complainant also reserved the right to claim damages from the Respondent.

The Respondent

(1) The Respondent is the sole and genuine owner of the two “PA Extra & Device” marks.

(2) The Respondent was incorporated in 29th July 2002 while the Complainant in 4th February 2004. Long before the date of incorporation of the Claimant, the Respondent has been widely promoting and using the said Marks in Hong Kong.

(3) The public recognizes the said Marks as the marks of the Respondent, but no others.

(4) On 21st July 2009, the Respondent filed a Writ of Summons with the High Court of Hong Kong (H.C. Action No.1631 of 2009) claiming against the Complainant for passing off and seeking an order to expunge the registered trademark no.300681633[sic] (“the Registered Trademark”).

(5) The Complainant deceived the Hong Kong Domain Name Registration Company Limited.

(6) The Complainant obtained the Registered Trademark unlawfully and the Complainant has no right to the said Marks or any of them at all.

(7) Copies of the following documents are enclosed:

(a) Letter to the Hong Kong Customs & Excise Department dated 4th August 2009.

(b) Writ of Summons (H.C. Action no.1631 of 2009).

5. Findings

According to Paragraph 4(a) of the HKDNR Domain Name Dispute Resolution Policy (the "Policy") which is applicable hereto, the Complainant has the burden of proving that:

(i) the Disputed Domain is identical or confusingly similar to a trade mark 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 Disputed Domain; and
(iii) the Disputed Domain has been registered and is being used in bad faith.

(1). Identical/confusing similarity

The Complainant submitted that it is the trademark owner of “PA EXTRA” trademark in Class 3 registered with HK’s Trade Marks Registry (“Registry”) as of July 17, 2006. There is no difficulty in finding that the Disputed Domain is almost identical or confusingly similar to the Complainant’s registration.

However, after commencing the proceedings, the Respondent by Writ of Summons filed with the High Court of HKSAR on July 21, 2009 seeks to, among others, expunge the above trademark from the Registry. None of the parties provided the Panelist any grounds for such trademark cancellation action and, and if so, it is not within the jurisdiction of the Panelist to decide on the merit of such trademark matter. However, none of the parties request that the arbitral proceedings be stayed pending the final court judgment.

Once a trademark has been registered, the owner will have unfettered right to use, license, transfer or mortgage the mark before the mark is expunged or cancelled or expired. In this case, the Panelist takes the view that the trademark no.300681633 is by far a valid registration and Paragraph 4(a)(i) of the Policy has been satisfied.

(2). Rights or Legitimate Interests of Respondent

The Complainant, probably un-represented, did not submit any ground to support this ground. In fact, the burden of proof of this ground will fall on the Respondent once the Complainant has made an even very simple submission. Neither the Respondent in this case has submitted any evidence to show its legitimate interest. The Panelist notices that the Disputed Domain is similar to the business name of the Respondent but I am not able to find out, without the help of the parties by way of evidence, the Respondent has legitimate rights or interest over the Disputed Domain or vice versa.

Therefore, Paragraph 4(a)(ii) is not satisfied here.

(3). Bad faith

The Complaint failed to adduce any evidence to show that the Disputed Domain has been registered and is being used in bad faith. The mere evidence of sending warning letter, putting newspaper advertisement and filing complaints with Hong Kong Customs & Excise Department alleging selling of counterfeit goods by the Respondent do not discharge the burden to show bad faith. The evidence should have been more concrete than the above.

Similarly, the Respondent also failed to justify the use of the Domain Name under dispute. This is less crucial as the burden is not on the Respondent.
As such, Paragraph 4(a)(iii) is not satisfied here.

6. Decision

The Complaint filed by the Complainant is quite simple. It is probably due to that the Complainant is not legally represented and that it is not familiar with the Policy and the evidential requirement. The Policy and Forms available for download on www.hkiac.org set out very clearly what are required and the previous decisions should provide clear guidelines on how to draft the Complaint and Response. It is not up to the Panelist after reviewing the unorganized submission and evidence to guess or second-guess what the evidence tries to speak for.

Another fatal issue is that the Complainant does not seek to transfer the Disputed Domain but to reserve the right to seek damages from the Respondent. Similarly, the Respondent also seeks to dismiss the Complaint with costs awarded to the Respondent, to be taxed by the High Court if not agreed. The Policy does not give any power to the Panelist to award any damages or legal costs in relation to the proceedings. Again, I believe this is due to the unfamiliarity of the Policy of the parties.

The Panelist also finds that the Respondent filed a lot of evidence which are supposed to be internal communication between the Respondent and its solicitors in respect of strategies and fee quotes. None of the legal advice from the Respondent’s solicitors shall be admitted as evidence and they will attach no weight in giving this decision.

The Policy states that the Complainant has to satisfy the Panelist that all three grounds in Paragraph 4(a) exist. As there is not much information or evidence provided by the Complainant for the Panelist to access or review, I am bound by the Policy to dismiss the Complaint.

Dated: September 24, 2009

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Name of the Panelist: Law Hang, William