.hk Domain Name Dispute Resolution
ARBITRATION PANEL DECISION

Complainant:  Siu Siu Style Company Limited
Respondent:  LAI WEIPING
Case Number:  DHK-1600133
Contested Domain Name:  <doughnut.hk>
Panel Member:  Raymond HO

1. Parties and Contested Domain Name

The Complainant is Siu Siu Style Company Limited whose registered office is situate at G/F., 68 Fuk Wah Street, Shamshuipo, Kowloon, Hong Kong; and its authorized representative is Messrs. Benny Kong & Tsai of 19B, OTB Building, 160 Gloucester Road, Wan Chai, Hong Kong.

The Respondent is LAI WEIPING whose email address is 80085950@qq.com.

The domain name at issue is <doughnut.hk> (the “Disputed Domain Name”). The Disputed Domain Name is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”) whose email address is domain@west263.com.

2. Procedural History

On 23 August 2016 the Complainant filed with Hong Kong International Arbitration Centre ("the Centre") a Complaint pursuant to the Domain Name Dispute Resolution Policy, adopted by the Hong Kong Domain Name Internet Registration Corporation Limited (HKIRC) on 22 February 2011 (the “Policy”), the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure, approved by HKIRC on 22 February 2011 (the “Rules”) and the HKIAC Supplemental Rules (the “Supplemental Rules”) effective from 1 March 2011.

On 23 August 2016, the Centre transmitted by email to the Registrar, a request for registrar verification in connection with the registrant of the Disputed Domain Name.
On 24 August 2016, the Registrar confirmed that the Respondent is the registrant or holder of the Disputed Domain Name; and that the Policy is applicable to the current dispute; and provided the Centre with the WHOIS information regarding the Disputed Domain Name, including the administrative and technical contacts of the Respondent.

On 30 August 2016 the Complainant filed a revised Complaint after the administrative check by the Centre. All references to the Complaint hereafter shall mean the Complaint as revised on 30 August 2016.

On 31 August 2016 the Centre served on the Respondent by email the notification of commencement of proceedings (“NCP”) in Chinese and English and stated that under Article 18 of the Rules the language of the proceedings is English and that if the Respondent requested to use Chinese in the proceedings the Respondent should submit his case to the Centre within 5 days. In the NCP, it was stated that the due date for the Respondent to submit his Response was 22 September 2016. However, the Respondent did not make any language request nor submit the Response. The Complaint and its annexures were attached to the NCP and all these documents were emailed to the Respondent’s email address as provided by the Registrar.

On 24 September 2016, the Centre issued a notice of the “Respondent in Default” by email to all parties.

On 29 September 2016, the Centre issued a notice of “Confirmation of Arbitration Panel” and appointed Mr. Raymond HO as sole Panelist in this case, the said Mr. Raymond Ho had, prior to the appointment, submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the Rules. On the same date, the case was transferred to the Arbitration Panel.

3. Factual Background

The Complainant is a company incorporated in Hong Kong and is engaged in the business of designing, manufacturing, selling and distributing backpacks, bags accessories and other travel essentials under the brand names and trademarks “Doughnut”.

The Respondent registered the Disputed Domain Name on 24 May 2016 for a period of one year from 24 May 2016 to 24 May 2017 and operates the website “www.doughnut.hk”.

4. Parties’ Contentions
A  The Complainant

The Complainant’s contentions are as follows:

2.1 The Disputed Domain Name is identical to the “Doughnut” trademark

The Complainant refers Exhibits 2 and 3 attached to the Complaint that show respectively a table of the “Doughnut” trademarks registered by the Complainant and related printouts of The Hong Kong Trade Marks Registry’s records on these trademarks. It is the Complainant’s contention that by reason of the substantial sales and extensive advertising of goods under the “Doughnut” trademarks, these trademarks have become well known and distinctive throughout the world including in Hong Kong as goods of the Complainant.

The Complainant submits that the Disputed Domain Name <doughnut.hk> contains the word component of “doughnut” which is the only distinctive component in the Disputed Domain Name, and it is identical to the “Doughnut” trademark in which the Complainant has acquired and enjoys legitimate rights and interests. The Complainant also submits that the word “hk” is short for Hong Kong on the Internet; and as such the Disputed Domain Name can be comprehended as “doughnut in Hong Kong” to ordinary network users or customers.

2.2 The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name

The Complainant refers to Exhibit 4 attached to the Complaint which shows the screenshots of the website “www.doughnut.hk” operated by the Respondent. The Complainant points out that in that website the Respondent purported to offer for sale goods identical and in direct competition to those of the Complainant under and by reference to the Complainant’s “Doughnut” trademarks. The Complainant also notes that the Respondent’s website is substantively similar to the Complainant’s official website “www.doughnutofficial.com”. In addition, the Complainant considers that the Respondent has made use of the full information shown at the Complainant’s official website, including the brand name, the address and the telephone number as his contact information.

It is the Complainant’s contention that the Respondent has not made any legitimate or active use of the Disputed Domain Name except the infringing activities described above. The Complainant submits that the Respondent has not been commonly known by the Disputed Domain Name. It is the Complainant’s case that based on the evidence of the imitation of the Complainant’s website; the Respondent is using the Disputed Domain Name for unlawful commercial use to “misleadingly divert consumers”.
Furthermore, the Complainant notes that the Respondent does not own any trademark registrations reflecting or corresponding to the Disputed Domain Name, and has not made any legitimate non-commercial or fair use of the Disputed Domain Name anywhere in the world.

The Complainant points out that the Respondent has no connection or affiliation with the Complainant and has received no authorization, license or consent from the Complainant to use any of the Complainant’s “Doughnut” trademarks.

2.3 The Disputed Domain Name has been registered and is being used in bad faith

The Complainant also refers to the evidence shown in Exhibit 4 attached to the Complaint.

It is the Complainant’s contention based on the matters shown on Exhibit 4, the Respondent clearly has registered and used the Disputed Domain Name in bad faith in order to mislead the public into the mistaken belief that his services or goods are in some way related to or associated with the Complainant. The Complainant submits further or in the alternative, the Respondent hosts a website in the name of the Disputed Domain Name with the purpose of attracting Internet users for commercial profits through the selling of goods on such a website for which “doughnut.hk” can be confused as Doughnut in Hong Kong to ordinary internet users or customers, which severely damaged the business of the Complainant. The Complainant submits that such conduct in essence violates the principle of honesty and credibility, causing severe damage to the legitimate rights and interests of ordinary customers and for that matter the general public and that of the Complainant.

2.4 The Disputed Domain Name is registered by an individual person; the Registrant does not meet the registration requirements for that individual category of domain name

The Complainant submits that the Respondent is not called “Doughnut” or anything similar; and consequently, the Respondent as the registrant of the Disputed Domain Name does not meet the registration requirements for that individual category of domain name.

Based on the foregoing, it is the Complainant’s contention that all the four elements in paragraph 4(a) of the Policy are established in this case. In accordance with the Policy, the Complainant therefore asks the Panel to make an order that the Disputed Domain Name be transferred to the Complainant.
B. The Respondent

The Respondent has filed no Response to the Complaint.

5. Findings

According to Paragraph 4(a) of 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; and

(iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name.

(1) Identical/confusing similarity

The first question for determination is whether the Complainant has a trademark or service mark in Hong Kong on which it can rely.

Based on the documentary evidence provided by the Complainant, the Panel finds that the Complainant is the registered holder of the following trademark registered at the Hong Kong Trade Marks Registry:

“Doughnut” trademark, registration no. 302817964, class 18. Registration is valid from 28 November 2013 to 27 November 2023.
The other trademark “” registration no. 301908720 referred to in Exhibits 2 and 3 of the Complaint is not registered in the name of the Complainant; and there is no evidence to show the relationship of the registered holder of this trademark with the Complainant. The Panel therefore makes no finding that the Complainant has any right in this “Doughnut” trademark.

The second question that arises for determination is whether the Disputed Domain Name is identical or confusingly similar to the “Doughnut” trademark that the Complainant has rights under paragraph 4(a)(i) of the Policy. The Panel accepts the Complainant’s submission that the Disputed Domain Name contains the distinct word component of “Doughnut” that is identical to the Complainant’s registered “Doughnut” trademark. It is established that the suffix “.hk” can be ignored in making this comparison. The Panel therefore finds that the Disputed Domain Name is identical or confusingly similar to the “Doughnut” trademark registered by the Complainant.

Accordingly, the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

(2) Rights or Legitimate Interests of Respondent

It is well established that the Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the Disputed Domain Name under paragraph 4(a)(ii) of the Policy and then the onus of proof shifts to the Respondent to show it does have rights or legitimate interests.

Based on the evidence adduced by the Complainant, a prima facie case has made out against the Respondent that he lacks rights and legitimate interests in the Disputed Domain Name; and it is then up to the Respondent to rebut the case.

The Panel notes that the Respondent has filed no Response to the Complaint.

Paragraph 4(d) of the Policy provides as follows:

“Any of the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be proven based on its evaluation of all evidence presented to it, shall demonstrate the Registrant’s rights or legitimate interests to the Domain Name for purposes of Paragraph 4(a)(ii):
(i) before any notice to the Registrant of the dispute, the Registrant’s use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services in Hong Kong; or

(ii) the Registrant (as an individual, business, or other organisation) has been commonly known by the Domain Name, even if the Registrant has acquired no trade mark or service mark rights in Hong Kong; or

(iii) the Registrant has trademark or service mark rights that the mark is identical to the Domain Name the Registrant is holding; or

(iv) the Registrant is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue; or

(v) If the Domain Name is registered in one of the Individual Domain Name Categories, the Domain Name registered must be the Registrant’s own “individual name”, which can be either (1) the Registrant’s legal name, or (2) a name by which the Registrant is commonly known and can include, for example, a pseudonym the Registrant uses if the Registrant is an author or a painter, or a stage name if the Registrant is a singer or actor, or the name of a fictional character if the Registrant has created or can otherwise show it has rights in such fictional character.”

The evidence of the Complainant has shown that the Respondent’s website “www.doughnut.com” is a replicate of the Complainant’s official website with a trademark identical to the “Doughnut” trademark registered by the Complainant prominently shown on top of it. This website operates the same line of business as that of the Complainant. On this finding it could not be regarded as the use of the Disputed Domain Name “in connection with a bona fide offering of goods or services in Hong Kong” by the Respondent.

Having considered all the evidence, the Panel finds none of the circumstances in paragraph 4(d) has been established.

Accordingly, the Complainant has satisfied the requirement of paragraph 4(a)(ii) of the Policy.

(3) Bad Faith

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the Disputed Domain Name was registered in bad faith and has been used in bad faith.
Paragraph 4(b) of the Policy provides:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

(i) circumstances indicating that the Registrant has registered or has acquired the 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 Registrant’s documented out-of-pocket costs directly related to the Domain Name; or

(ii) the Registrant has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Name, provided that the Registrant has engaged in a pattern of such conduct; or

(iii) the Registrant has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Domain Name, the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s web site or other online location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Registrant’s web site or location or of a product or service on the Registrant’s web site or location.”

However, those criteria are not exclusive and the Complainant may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to these principles, the Panel finds that the Disputed Domain Name was registered and used in bad faith for the following reasons.

(a) Given that the Respondent’s website uses the Complainant’s registered trademark, it is clear that the Respondent had actual knowledge at the time of registration of the Disputed Domain Name in 2016 of the Complainant’s “Doughnut” trademark registered in 2013.

(b) Given also that the line of business as shown on the Respondent’s website is similar to that of the Complainant, it is clear the Respondent is operating in competition with the Complainant.

(c) On totality of evidence in the present case, it is irresistible to infer that the registration of the Disputed Domain Name was primarily for the purpose of disrupting the business of the Complainant; and that the Respondent has intentionally used the Disputed Domain Name to create a confusion with the Complainant’s “Doughnut” trademark as to the source or affiliation of the
Respondent’s website with that of the Complainant and the goods offered for sale on that website.

Based on the above, the Panel finds that Respondent has registered and used the Disputed Domain Name in bad faith under paragraph 4(b)(iii) and within the generally accepted meaning of bad faith.

Accordingly, the Complainant has satisfied the requirement of paragraph 4(a)(iii) of the Policy.

(4) If the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of domain name

As the Disputed Domain Name is not a 個人.hk domain name as referred to in Paragraph 4(c) of the Policy, Paragraph 4(a)(iv) of the Policy is therefore not applicable.

6. DECISION

For all the foregoing reasons, in accordance with paragraphs 4(a) of the Policy, the Panel orders that domain name <doughnut.hk> be transferred to the Complainant.

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Raymond HO
Sole Panelist of the Arbitration Panel
7 October 2016