Hong Kong International Arbitration Centre

.hk Domain Name Dispute Resolution

ADMINISTRATIVE PANEL DECISION

Complainant: NUTRICIA INTERNATIONAL B.V.
Respondent: MARCARIA.COM CORP LIMITED
Case No. DHK-1600136
Disputed Domain Name: <aptamil.com.hk>

1. The Parties and Contested Domain Name

The Complainant is Nutricia International B.V. of Schiphol Boulevard 105, NL-1118 BG Schiphol, The Netherlands.

The Respondent is Marcaria.Com Corp Limited of Flat/Rm 2103 Futura Plaza, 111 How Ming St Kwun Tong 1234, Hong Kong.

The domain name at issue is <aptamil.com.hk> (“the disputed domain name”). The disputed domain name is registered with Marcaria.com International, Inc.

2. Procedural History

The Complaint was filed with the Hong Kong International Arbitration Centre ("the Centre") on November 15, 2016.

On November 16, 2016, the Centre acknowledged receipt of the Complaint and annexures and on November 16 and 21, 2016 transmitted by email to the registrar Marcaria.com International, Inc. a request for registrar verification in connection with the disputed domain name and in particular whether the Respondent was the Registrant or holder of the disputed domain name. No reply was received to either communication to the registrar.

On November 22, 2016 the Hong Kong Internet Registration Corporation Limited ("HKIRC") transmitted by email to the Centre a response that, inter alia, noted that the registrar had not provided the Centre with the information as a registrar, and that the information then communicated was based solely on the records of the HKIRC and advised the Centre that the Respondent is the domain name holder of the disputed domain name, that the Domain Name Dispute Resolution Policy for .hk and .香港 domain names ("DNDRP" or "the Policy") is applicable to this proceeding and that pursuant to Section 2a (i) of the HKIRC DNDRP Rules of Procedure under the DNDRP ("the Rules"), and provided the billing contact information for the disputed domain name.
By the same communication the HKIRC advised the Centre that the disputed domain name was currently in ACTIVE status and that on receiving the Centre’s information for the dispute filing, it had put the disputed domain name into BLACKLIST, meaning that it could not be transferred and/or deleted during the relevant period.

On November 23, 2016, the Centre, by email communication, sent to the Respondent the Notification of Commencement of Proceedings stating that the Complaint had been filed with the Centre, attaching thereto the Complainant and its annexures and advising the Respondent that it had 15 business days, i.e. on or before December 14, 2016, to submit a Response. The Respondent did not file a Response by the due date or at all.

On December 14, 2016 the Centre wrote to The Honourable Neil Anthony Brown QC by email to the effect that no Response had been received from the Respondent, that it was minded to appoint him as the sole Arbitrator of the dispute and requesting him to confirm to the Centre his availability to act as Arbitrator in this matter and if so, whether he was in a position to act independently and impartially between the parties.

On December 15, 2016 the said The Honourable Neil Anthony Brown QC wrote to the Centre by email confirming his availability to act as Arbitrator in the dispute and that he was in a position to act independently and impartially between the parties.

On December 15, 2016 the Centre wrote to the parties by email advising them that no Response had been received from the Respondent.

On December 15, 2016 the Centre wrote to the parties and to the said The Honourable Neil Anthony Brown QC by email confirming his appointment as Arbitrator and advising that a decision in the dispute was to be rendered on or before January 9, 2017.

The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rule 7.

The Panel finds that the Centre has performed its obligations under Rule 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent". Accordingly, the Panel is able to issue its decision without the benefit of a Response and based on the documents submitted and in accordance with the Policy, the Rules, the HKIAC Supplemental Rules, the eligibility requirements of the relevant Domain Name Category and the law which the Arbitration Panel deems applicable.

3. **Factual background**

The following background is taken from the submissions of the Complainant except where otherwise stated.

The Complainant is a company incorporated pursuant to the Laws of The Netherlands and is engaged in the provision of early life nutrition (baby nutrition) and medical nutrition and related goods and services. The Complainant or its predecessors in title have been engaged in the production of medical nutrition since 1905 and it launched its first baby food in 1946. The Complainant operates internationally including in Hong Kong.
The Complainant submits in substance that the disputed domain name entirely reproduces its trademark APTAMIL and that it resolves to a website that offers the Complainant’s APTAMIL products for sale.

The Respondent is a company incorporated in Hong Kong and it appears from the evidence that it registered the disputed domain name on or about July 19, 2013 in its own name.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

1. This Complaint is based on the Complainant’s following trademark rights:
   (a) Hong Kong trademark APTAMIL n° 19791517, registered since May 16, 1978 covering goods and services in class 5, more particularly set out in the Complaint; and
   (b) Hong Kong trademark APTAMIL n° 303506904, registered since August 14, 2015 covering goods and services in classes 5, 29,30,and 35 more particularly set out in the Complaint; and
   (c) European Union Trademark APTAMIL No. 007203813, registered since October 21, 2010, covering goods and services in classes 5, 29, 30 and 32, more particularly set out in the Complaint.

2. The Complainant is engaged in its aforesaid business internationally, including in Hong Kong. As part of its business, the Complainant has developed products provided under the trademark APTAMIL, including its formula milk APTAMIL with Pronutra+ Follow On and Growing Up milk, a nutritionally tailored milk to support toddlers aged 1-2 years as they continue to undergo significant growth and cognitive development and provides support through its AptaNutritional Advisory Team.

3. The Complainant has become aware of the registration of the disputed domain name <aptamil.com.hk> which entirely reproduces Complainant’s trademark APTAMIL. The disputed domain name resolves to a website entitled “German Milk Powder Store” offering Complainant’s APTAMIL goods for sale without authorisation.

4. Before commencing this proceeding, Complainant made efforts to resolve the present dispute amicably by sending a cease-and-desist letter to Respondent via registered letter and e-mail on December 16, 2015, relying on its aforesaid trademark rights. The cease-and-desist letter requested Respondent to cease the use of the domain name in dispute and to deactivate the aforementioned website. A reminder was sent to the hosting provider on December 21, 2015 but the website has not been deactivated. Accordingly, the Complainant initiated the present proceeding in order to obtain the cancellation of the disputed domain name.
5. **Policy, Paragraph 4(a)(i).** The disputed domain name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights, namely the Complainant’s Hong Kong trademark for APTAMIL n° 19791517, registered since May 16, 1978 and its Hong Kong trademark APTAMIL n° 303506904, registered since August 14, 2015 aforesaid (collectively “the APTAMIL mark”).

6. Complainant enjoys a worldwide reputation and owns numerous APTAMIL trademark registrations around the world including in Hong Kong. Complainant also commercialises various APTAMIL products in Hong Kong.

7. The disputed domain name <aptamil.com.hk> entirely reproduces the APTAMIL mark. Previous Panels have held that where a domain name incorporates the whole of the trademark, it is considered to be confusingly similar to the reproduced trademark (DHK-1500126, *Television Broadcasts Limited v Samuel Chan*, Annex 8: “It is confusingly similar to the TVB trademark because the domain name incorporates the whole of the trademark”). Likewise, by registering the said domain name, Respondent created a likelihood of confusion with Complainant’s APTAMIL mark. It is likely that the domain name could mislead Internet users into thinking that it is, in some way, associated with Complainant’s activities in Hong Kong.

8. The confusing similarity between the disputed domain name and Complainant’s trademark is further heightened with the website set up by Respondent. Indeed, the disputed domain name directs towards an online store commercialising Complainant’s products. Shipping services and contact details are also provided. Moreover, Complainant’s products and logo are reproduced on the said website. Hence, it is submitted that internet users are more likely to believe that the disputed domain name is endorsed by Complainant and is used to commercialise its products.

9. In that regard, the Complainant relies on the decision in *Nike Innovate C.V. and Nike Hong Kong Limited v UBN Limited*, DHK-1600129 as the Complainant’s products, as APTAMIL, are famous worldwide and the Complainant has used the mark APTAMIL mark in connection with a wide variety of products and services around the world. Consequently, the public has learnt to perceive the goods and services offered under this mark as being those of Complainant.
10. Moreover, the addition of generic top-level domain names such as “.com” or country code top-level domain names such as “.hk” or “.com.hk” to portions of the subject domain name is irrelevant in relation to the confusingly similar analysis (DHK-1400108, Conair Corporation v Tom Lee CCTV Ltd., ).

11. Accordingly, the disputed domain name is identical or confusingly similar to the trademark APTAMIL in which the Complainant has rights, and the requirements of Paragraph 4(a)(i) of the Policy are satisfied.

12. **Policy, Paragraph 4(a)(ii).** The Respondent has no rights or legitimate interests in respect of the disputed domain name.

13. Respondent is not commonly known by the name APTAMIL. Neither is it affiliated with Complainant in any way nor has it been authorized by Complainant to use and register its trademark, or to seek registration of any domain name incorporating said mark. Furthermore, Respondent has no prior rights or legitimate interest in the domain name. The registration of the APTAMIL mark in trademark n° 19791517 preceded the registration of the disputed domain name.

14. Moreover, the domain name in dispute is so similar to the famous APTAMIL trademark of Complainant, that Respondent cannot reasonably pretend it was intending to develop a legitimate activity through the disputed domain name.

15. Besides, Respondent did not demonstrate use of, or demonstrable preparations to use, the disputed domain name or name corresponding to the disputed domain name in connection with a bona fide offering of goods or services. Indeed, the domain name in dispute resolves to a website, <aptamil.com.hk>, imitating Complainant’s official website by offering on sale Complainant’s products and thereby creating some sort of false affiliation with Complainant. Due to the presence of APTAMIL products on the website, indicating Complainant’s APTAMIL line of products and ads of Complainant, internet users are likely to believe wrongly that it is an official website. Competitors’ products like “Babydream” and “Dontodent” are also offered on sale of the website. Indeed, when searching the denomination “Dontodent” on the website, the Internet user is redirected toward the website www.aptamil.com.hk, which offers the Complainant’s as well as competitors’ products for sale. Such circumstances do not represent a use in connection with a bona fide offering of
goods and services. Respondent is thus not accurately disclosing its relationship with Complainant.

16. Respondent is making a non-legitimate use of the domain name, with intent for commercial gain to misleadingly divert consumers from Complainant’s official website. Moreover, Respondent uses the disputed domain name to sell items which could be non-authentic. They could be hazardous to people’s health. Such behaviour is not a legitimate or fair use of the disputed domain name.

17. Accordingly, the Respondent has no rights or legitimate interests in respect to the domain name in dispute under Paragraph 4(a)(ii) of the Policy.

18. Policy, Paragraph 4(a)(iii). The disputed domain name has been registered and is being used in bad faith.

19. It is implausible that Respondent was unaware of Complainant when he registered the disputed domain name.

20. Bad faith can be found where Respondent “knew or should have known” of Complainant’s trademark rights and, nevertheless registered a domain name in which he had no rights or legitimate interest: WIPO Case No. D2009-0320, Research In Motion Limited v. Privacy Locked LLC/Nat Collicot.

21. The Respondent’s reproduction of the Complainant’s well known trademark in its entirety in the disputed domain name clearly proves that the Respondent was aware of the existence of Complainant’s trademark.

22. The web pages set up by Respondent show that it had the Complainant and its activities in mind at the time of the registration of the disputed domain name.

23. An APTAMIL trademark or Google search would have revealed to Respondent the existence of Complainant and the APTAMIL mark, showing bad faith.

24. It is inconceivable that Respondent was unaware of the existence of Complainant and the APTAMIL mark at the time of registration of the disputed domain name.
25. It is therefore apparent that Respondent registered the disputed domain name in bad faith.

26. Respondent also uses the domain name in bad faith.

27. As the disputed domain name is confusingly similar to Complainant’s trademark, there is a likelihood of confusion resulting in the diversion of internet traffic from Complainant’s website to Respondent’s website: WIPO Case No. D2006-1095, Edmunds.com, Inc. v. Triple E Holdings Limited.

28. Indeed, the disputed domain name resolves towards a website commercialising Complainant’s products, displaying Complainant’s logo and requesting personal information from customers.

29. The imitation of Complainant’s website and activities revealed by the evidence shows an unlawful commercial use misleadingly to divert consumers and the non-existence of any fair use of the disputed domain name: Nike Innovate C.V. and Nike Hong Kong Limited v UBN Limited, DHK-1600129. Moreover, promoting competitors’ products like “Babydream” and “Dontodent” also shows a bad faith use of the domain name.

30. Respondent’s primary motive in registering and using the disputed domain name to capitalize on or otherwise take advantage of Complainant’s trademark rights is shown by the creation of initial interest confusion by the Respondent.

31. It is also likely that Respondent registered the domain name to prevent Complainant from reflecting its trademark in the disputed domain name, which is bad faith use: L’oreal v. Chenxiangsheng, (WIPO Case no. D2009-0242.

32. Accordingly, the Respondent both registered and used the disputed domain name in bad faith within the meaning of Paragraph 4(a)(iii) of the Policy.

33. **Policy, Paragraph 4(a)(iv).** The fourth limb under paragraph 4(a) of the Policy is not applicable to this proceeding, as the disputed domain name has apparently not been registered by an individual person but by a body corporate.

34. Remedy.
For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Complainant requests that the Panel order that the disputed domain name <aptamil.com.hk> be cancelled.

B. Respondent

The Respondent did not file a Response in this proceeding. However, on December 15, 2016 the Centre received the following email communication purporting to originate from Aptamil Direct Germany and signed “K. Schoepl”: “Hello, sorry but the information “did not receive Response from the Respondent” is absolutely incorrect. We, "Hohosales Limited" are the owner of the "aptamil.com.hk" domain and have responded in time. Please check with Marcaria and correct the docs. Thank you.”

5. Findings and Discussion of the Issues

Paragraph 4(a) of the Domain Name Dispute Resolution Policy for .hk and 香港 domain names provides that each of following four findings must be made in order for a Complainant to prevail:

(i) The Registrant’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 Registrant has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Registrant’s Domain Name has been registered and is being used in bad faith; and

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

The Panel will address each of those elements in turn.

A) Identical / Confusingly Similar

The first question that arises is whether the Complainant has a trademark in Hong Kong on which it can rely. The Complainant has adduced evidence that the Panel accepts to the effect that the Complainant has trademark rights on which it can rely with respect to the disputed domain name.

The registered Hong Kong trademarks are the Complainant’s Hong Kong trademark for APTAMIL n° 19791517, registered since May 16, 1978 and its Hong Kong trademark APTAMIL n° 303506904, registered since August 14, 2015 aforesaid (collectively “the APTAMIL mark”).

The Complainant has proved those trademarks by evidence of registration certificates annexed to the Complaint as part of Annexure 5 and being certificates produced by a Hong Kong SARG IPD Trade Mark Search. The Panel accepts that evidence. It shows that the trademark for APTAMIL n° 19791517, has a date of registration of May 16, 1978 and an “Actual Date of Registration” of November 27, 1979, both of which are prior to the date on which the
Respondent registered the disputed domain name which was on July 19, 2013 and that it was registered in the name of the Complainant.

The evidence also shows that the trademark for APTAMIL n° 303506904 has a date of registration of August 14, 2015 and an “Actual Date of Registration” of February 19, 2016 and that it was registered in the name of the Complainant.

It is well established that for the purposes of assessing this, the first of the three elements that the Complainant must establish, it is not necessary that the trademark was registered prior to the registration of the disputed domain name, although that consideration may be relevant for the later issues of rights and legitimate interests and bad faith. However, it will also be relevant to note in due course that the trademark for APTAMIL n° 19791517 was registered by the Complainant well before the registration of the disputed domain name.

The Panel therefore finds that the Complainant has proved that it has a trademark or service mark in Hong Kong in which it has rights.

The second question that arises is whether the disputed domain name is identical or confusingly similar to the APTAMIL mark. The Panel finds that the domain name is identical to the APTAMIL mark as, in making this comparison, the gTLD suffix “com.hk” is to be ignored and the domain name incorporates the trademark in its entirety with nothing else. In other words, it is a complete copy. Even if the domain name were not identical to the trademark, it is confusingly similar to it, as in view of the prominence of the trademark and the goods known to be sold under it, an objective bystander would naturally assume that the domain name was invoking the APTAMIL mark and the products of the Complainant marketed under that trademark.

In any case it is generally accepted that if, as in the present case, a trade mark is embedded as a whole in a domain name, the domain name is to be taken as identical or confusingly similar to the trademark that has been taken without authority and used in that manner.

The Complainant has therefore established that the domain name is identical or confusingly similar to the trademark and has made out the first of the four elements that it must establish.

**B) Rights and Legitimate Interests**

It is now 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. There are many decisions to that effect under the analogous Uniform Domain Name Dispute Resolution Policy (“the UDRP”), one of the most notable of which is *Hanna-Barbara Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) where it was held that a complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the UDRP before the onus of proof shifts to the respondent to show that it does have rights or legitimate interests in the domain name.

Having regard to the substantial evidentiary case presented on behalf of the Complainant, the Panel finds that the Complainant has made out a *prima facie* case that arises from the following considerations:
(a) the Respondent has chosen to take the Complainant’s trademark and to use it in its domain name without any alteration at all being made to the trademark;

(b) the domain name has used the domain name to resolve to a website that displays the Complainant’s name and logo and purports to sell products of the Complainant, potentially counterfeit products and other similar products in competition with those of the Complainant, all under the Complainant’s trademarked name;

(c) by that means the Respondent has maintained that it is the owner of the domain name and that it is permitted to sell such products under the Complainant’s trademarked name, which is patently false;

(d) the Respondent has engaged in these activities without the consent or approval of Complainant and for what must be assumed to be commercial reasons.

These matters go to make out the prima facie case against the Respondent and it is then up to the Respondent to rebut that case.

As the Respondent has not filed a Response, or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has not rebutted the prima facie case against it and that the Respondent therefore has no rights or legitimate interests in the disputed domain name.

The Panel notes that on December 15, 2016 the Centre received the email communication referred to above purporting to originate from Aptamil Direct Germany signed “K. Schoepl” and stating: “Hello, sorry but the information "did not receive Response from the Respondent" is absolutely incorrect. We, "Hohosales Limited" are the owner of the "aptamil.com.hk" domain and have responded in time. Please check with Marcaria and correct the docs. Thank you.”

In that regard the Panel notes that according to the advice received by the Centre from HKIRC referred to above, the Respondent is the domain name holder of the disputed domain name. The evidence is to the effect that Hohosales Limited is not a party to this proceeding.

There are also two other factors that have influenced the Panel. The first is that some serious allegations were made against the Respondent in the Complaint. It had a chance to reply to all of them, but did not reply to any of them, and has made no submission to the Panel on any of these important factual issues. The Panel concludes that the real reason for the Respondent’s reticence is that anything it could honestly say about the issues would not benefit it in this proceeding but would simply confirm its untoward conduct.

The second is that products of this sort, that are either pharmaceuticals, drugs, foodstuffs or supplements and the like are notoriously risky when bought over the internet and carry substantial public and private health consequences. That underlines and exacerbates the entirely inappropriate conduct in which the Respondent has engaged and puts an even heavier burden on it to show that it was entitled to do what it did, or as the Policy puts it, to show it had a right or legitimate interest in the domain name, which, in the opinion of the Panel it has not done and which must surely be impossible for it to do.
The Respondent has therefore not rebutted the *prima facie* case against it. The Complainant has therefore shown that the Respondent does not have a right or legitimate interest in the disputed domain name and the Complainant has thus made out the second of the four elements that it must establish.

C) 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.

That case may be made out if there are facts coming within the provisions of paragraph 4(b) of the Policy. That paragraph sets out a series of circumstances that are to be taken as evidence of the registration and use of a domain name in bad faith, namely:

“...(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 on-line 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 Complainants in DNDRP, as in UDRP proceedings, may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons, the essence of which has already been dealt with under Rights and Legitimate Interests.

First, the facts come squarely within paragraph 4(b)(iii). It is clear from the evidence that the Respondent has acted dishonestly to damage the Complainant’s business, had no right to acquire the domain name and has not attempted in a Response to explain its actions. It is a reasonable inference that the primary purpose of the whole exercise was to direct internet traffic to the Respondent itself or its associates so that internet users would buy products from the Respondent’s website, and not buy products from the Complainant’s official site and to make money by encouraging internet users to do so. The products on sale on the Respondent’s website include products sold under the Complainant’s name and other products under different brands. By definition this conduct is disrupting the business of the Complainant. The case is therefore a clear application of paragraph 4(b) (iii) and the Panel so finds.
Secondly, the facts also come within paragraph 4(b) (iv) of the Policy for it is clear from the evidence that the Respondent created the confusion contemplated by the paragraph and for commercial gain, being the benefit the Respondent hoped to derive from damaging the Complainant’s business, directing internet traffic to its own or an associated website and, probably, eventually forcing the Complainant to buy the domain name from the Respondent.

Thirdly, the only inference that can be drawn from the evidence, as the Complainant submits, is that the Respondent had actual knowledge of the Complainant’s trademark. It is a prominent trademark, including where the Respondent is domiciled, it is clearly an invented name and there is no reason apparent as to why the Respondent would have chosen a domain name incorporating the APTAMIL mark other than that it knew of the APTAMIL mark and intended to use it illegally for its own commercial purposes. The Respondent therefore knew it was taking and using the Complainant’s trademark illegally, which is bad faith.

In addition, apart from applying the specific criteria in paragraph 4(b) and having regard to the totality of the evidence, the Panel finds that, in view of the Respondent’s acquisition of the disputed domain name using the trademark of the Complainant in the manner described above and in view of the Respondent’s subsequent dishonest conduct, the Respondent registered and used the disputed domain name in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the four elements that it must establish.

D) Registration Requirements

The fourth limb under paragraph 4(a) of the Policy is not applicable to this proceeding, as the disputed domain name has apparently not been registered by an individual person but by a body corporate.

6. Decision

Having established all three elements required under the Policy that the Complainant must establish in this proceeding, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name <aptamil.com.hk> be CANCELLED.

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The Honourable Neil Anthony Brown QC

Dated: December 24, 2016