.hk Domain Name Dispute Resolution
ARBITRATION PANEL DECISION

Complainant: Qualtrics, LLC
Respondent: Shanta Chw (Top3 Media Pte. Ltd.)
Case Number: DHK-1700142
Contested Domain Name: qualtrics.hk
Panel Member: Peter Bullock (Sole Panelist)

1. Parties and Contested Domain Name

The complainant is Qualtrics, LLC (the “Complainant”) with registered address at 333 W. River Park Drive, Provo, Utah, 84604, U.S.A.

The respondent is Shanta Chw (Top3 Media Pte. LTD.) (the “Respondent”) with registered address at 401 Havelock Road, #02-13, Singapore, 169631 Singapore.

The disputed domain name is “qualtrics.hk” (the “Domain Name”) which was registered in Australia with Instra Corporation Pty Ltd. (“Instra”) on 14 April 2016 (See WhoIs search exhibited by Complainant).

2. Procedural History

The Complainant filed a complaint in this matter with the Hong Kong International Arbitration Centre (the “HKIAC”) on 24 May 2017 (“the Complaint”) pursuant to the Hong Kong Internet Registration Corporation Ltd (“HKIRC”) Domain Name Dispute Resolution Policy (the “Policy”) and its Rules of Procedure. The HKIAC notified the registrar of the Domain Name of the proceedings by email on 24 May 2017. On 24 May 2017 the registrar of the Domain Name notified the HKIAC that the proper respondent to the dispute is the Respondent.

The HKIAC sent notification of commencement of proceedings, the Complaint and its exhibits to the Respondent by email on 2 June 2017. Process has been duly served and no response was submitted by the Respondent on or before the prescribed deadline of 23 June 2017. The HKIAC informed the Respondent of the same by email on 26 June 2017.

On 5 July 2017 the HKIAC informed the parties by email that a sole panelist, Peter Bullock had been appointed to the Panel.
3. **Factual Background**

For the Complainant

The Complainant, is a limited liability company founded in 2002 in Utah, United States ("US"). They are a Software as a Service ("SaaS") company that enables users to collect and analyze data online, such as experience management, market research, customer satisfaction, product testing and employee evaluations. The Complainant runs an international business with their software used in over 90 countries, has over 8,500 brands and organizations as clients and over 2 million individual users. In addition to their four US offices, they also have offices in Dublin, London, Munich, Sydney, Melbourne and Canberra.

The Complainant holds trademark rights in the word "Qualtrics" (the "Trademark") in a total of 43 countries. The term was coined by the Complainant and has been used by them since 2005 for their goods and services. Specifically, the Trademark is used for goods and services which provide temporary use of non-downloadable computer software accessed via the internet in the field of research surveys.

The Complainant registered the Trademark in Hong Kong on 14 August 2015. The Trademark has been used in Hong Kong since 2008.

For the Respondent

The Respondent registered the Domain Name on 14 April 2016 and the website of the Domain Name is currently inactive. An internet search of the Respondent reveals that they are an online marketing agency. Their services include search engine optimization, branding, web design, e-commerce, adwords, social media marketing and mobile apps.

A representative of the Complainant contacted the Respondent via a series of emails in April 2016 (exhibited to the Complaint). The Respondent indicated that they have registered the Trademark as their domain name in Singapore, New Zealand and Australia as well. In an email dated 11 April 2016, the Respondent indicated that they were not presently using the Domain Name but intended to use the Domain Name "for an unrelated business".

4. **Parties’ Contentions**

The Complainant

The Complainant asserts the following:

- The Domain Name contains a mark which is identical or confusingly similar to the Complainant’s Trademark.
- The Respondent has no rights or legitimate interests in respect of the Domain Name on the grounds that (i) it has made use of, or demonstrable preparations
to use, the Domain Name in connection with a bona fide offering of goods or services in Hong Kong; (ii) it has been commonly known by the Domain Name; or (iii) it is making a legitimate non-commercial or fair use of the Domain Name.

- The Respondent has used the Domain Name in bad faith due to the registration of the Domain Name for the purpose of selling, renting, or otherwise transferring the Domain Name registration to another person for valuable consideration on excess of documented out of pocket costs directly related to the domain name.

The Respondent

The Respondent did not file a response within the stipulated time.

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 has produced evidence that it registered the Trademark in Hong Kong on 14 August 2015. The Respondent registered the Domain Name with Instra on 14 April 2016. The Panel accepts the evidence adduced by the Complainant and finds that the Complainant has trademarked rights in the Trademark that pre-date the registration of the Domain Name by the Respondent.

The Panel accepts the Complainant’s contention that the distinctive and dominant element of the Domain Name is identical to the Trademark. The fact that the Trademark is used in the Domain Name in its entirety would likely mislead the public to associate the Domain Name with the Complainant.

Furthermore, “qualtrics” is a unique word created by the Complainant. Since “qualtrics” cannot be considered to be a generic term, the Panel is of the view that the Respondent used the word in the Domain Name to create an impression of association with the Complainant.
In relation to the use of "hk" in the Domain Name, it is now well established that the generic top-level domain may be disregarded when evaluating whether a Domain Name is identical or confusingly similar (Den Braven Sealants B.V v. Bross Holding AD WIPO Case No. D2012-2163).

Thus the Panel is satisfied that the requirement of paragraph 4(a)(i) of the Policy is met.

(2). **Rights or Legitimate Interests of Respondent**

According to paragraph 4(d) of the Policy, the Respondent may establish rights to or legitimate interests in the Domain Name by demonstrating any of the following:

- The Respondent’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

- The Respondent 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

- The Respondent has trademark or service mark rights that the mark is identical to the Domain Name the Registrant is holding; or

- The Respondent 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.

The Respondent has the burden of proof once the Complainant demonstrates *prima facie* evidence that the Respondent lacks rights or legitimate interests.

The Complainant produced evidence that the Respondent failed to make active use of the Domain Name. There was produced no evidence of any demonstrable preparations for commercial use, despite the Respondent’s claim in the 11 April 2016 email exhibit that they intended to use it “for an unrelated business”. The Panel finds that the Respondent’s failure to make active use of the Domain Name is not a *bona fide* offering of goods and services (*Electro-Motive Diesel, Inc. v Focus Sevice, Inc* WIPO Case No. D2012-1848).

A lack of meaningful internet search results of the Respondent and their use of the Domain Name, while not necessarily conclusive, is a strong indication that the Respondent has not been commonly known by the Domain Name. Based on *Marriott International Inc. v Thomas Burstein and Miller* WIPO Case No. D2000-0610, no legitimate interest (or legitimate non-commercial
or fair use) can be established when there is no evidence that the Respondent is commonly known by the Domain Name.

The Complainant asserts that it has never authorized, consented to, licensed, transferred or assigned the use of the Trademark to the Respondent at any time. Meanwhile there is no evidence to suggest the Respondent has any rights to the Trademark in any way.

Having been presented with a prima facie case by the Complainant and in the absence of a reply from the Respondent, there is a lack of evidence before the Panel to suggest that the Respondent has established rights or legitimate interests based on any of the grounds mentioned above.

In conclusion, the Panel is satisfied that the condition under paragraph 4(a)(ii) is met.

(3) Bad faith

For the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy sets out four non-exhaustive circumstances which shall be evidence of registration and use of a domain name in bad faith. These are as follows:

- 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

- the Respondent 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

- the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

- 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.

The Respondent has registered numerous domains that infringe on the Complainants Trademark including “qualtrics.sg”, “qualtrics.com.sg” and
“qualtrics.com.au”. These domains were registered after the Complainant had begun to do business in those regions.

In the exhibited email dated 14 April 2016, the Respondent states “(I) mentioned $5000 US-$10,000 US per domain not AUD. If you will take the 3, $US15,000 would be the minimum that (I) will consider for them.”. In an email from the Complainant dated 22 April 2016 it is pointed out that “Domains generally cost anywhere from $5 to $50/year to register, which is a tiny fraction of what you’re telling me these are worth”. Throughout the email exchange, the Complainant offers first $360 for three domains and then US$500 (see email dated 20 April 2016). However, the US$15,000 is repeatedly demanded.

The act of demanding an amount in excess of the Respondent’s out-of-pocket expenses is a clear example of registering a domain name in bad faith (See NBA Properties, Inc v Holladio, Inc WIPO Case No. D2000-1626).

In the absence of a response from the Respondent, and taking into consideration the lack of use of the Domain Name by the Respondent and the April 2016 email exchange exhibit, the Panel finds that the Respondent registered the Domain Name in bad faith.

Thus the Panel is satisfied that the requirement of paragraph 4(a)(iii) of the Policy is met.

6. Conclusions

In light of the foregoing paragraphs, the elements of paragraph 4(a) of the Policy are present in this case. The Panel orders the Domain Name to be transferred to the Complainant.

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Peter Bullock

Dated: 17 July 2017