.hk Domain Name Dispute Resolution
AWARD BY ARBITRATION PANEL

Complainant: 1. Colonial Services Pty Ltd
              2. First State Investments (Hong Kong) Limited Exchange

Respondent: Italy Technology Recommend Center (Asia) Investment Co., Limited

Case Number: DHK-1700149

Contested Domain Name: <firststateinvestments.com.hk>

Panel Member: Dr Clive Trotman

1. Parties and Contested Domain Name

The first Complainant is Colonial Services Pty Ltd, of 11 Harbour Street, Sydney, NSW 2000, Australia. The second Complainant, which holds the eligibility requirements, is First State Investments (Hong Kong) Limited Exchange, of Square Block 1 and 2, 25, 8 Connaught Pl, Mid-level, Hong Kong. The Complainants are represented by SILKA Law AB, Strandvägen 7A, 11456, Stockholm, Sweden.

The Respondent is Italy Technology Recommend Center (Asia) Investment Co., Limited, of Flat/Rm A23, 9/F Silvercorp Int Tower, 707-713 Nathan Rd, Mongkok, Hong Kong, 999077, Hong Kong.

The disputed domain name is <firststateinvestments.com.hk>. The Registrar is 1API GmbH, Homburg, Germany, and the date of registration according to the WhoIs was May 16, 2017.

2. Procedural History

The Complaint was received by the Hong Kong International Arbitration Centre (the “Centre” or the “HKIAC”) on August 23, 2017. The Centre acknowledged receipt of the Complaint on August 24, 2017. On August 24, 2017 the Centre sent a request by email to the Registrar, 1API GmbH, requesting verification of the registrant of the disputed domain name.

On August 24, 2017, the Registrar replied to the Centre confirming the Respondent is the registrant or holder of the Disputed Domain Name; that the Domain Name Dispute Resolution Policy for .hk and .香港 domain names is applicable to the dispute; and providing the Centre with the administrative and technical contacts of the Respondent.
On August 29, 2017 the Centre notified the Complainant of a deficiency in the Complaint. The Complainant sent an Amended Complaint to the Centre on August 29, 2017, receipt of which was acknowledged on August 30, 2017.

On August 30, 2017, the Centre confirmed the Amended Complaint (“Complaint”) to be in compliance with the Domain Name Dispute Resolution Policy for .hk and .香港 domain names (the “DNDRP”) adopted by the Hong Kong Internet Registration Corporation Limited (“HKIRC”) effective February 22, 2011.

On August 31, 2017, the Respondent was formally notified of the Complaint, in English and in Chinese, in accordance with the provisions of the HKIRC Rules of Procedure for the DNDRP (the “Rules”), and the HKIAC Domain Name Dispute Supplemental Rules (the “Supplemental Rules”).

The due date for a Response was September 21, 2017. No Response was received.

Dr. Clive Trotman, who confirms his independence and impartiality in respect of this case, was appointed as the single member Arbitration Panel and the Parties were so notified by email on September 29, 2017.

3. **Factual Background**

For the Complainants

The First Complainant is an Australian company. The Second Complainant is an entity registered in Hong Kong Special Administrative Region (“HKSAR”). Both Complainants are part of a group structure involved in asset management and investment services, mainly at the wholesale level, with offices world-wide. The group operates as First State Investments internationally and Colonial First State Global Asset Management in Australia. The parent company is the Commonwealth Bank of Australia (“CBA”).

The First Complainant holds the following trademark:

FIRST STATE, registered at the Trade Marks Registry, Intellectual Property Department, The Government of the HKSAR, registration application December 11, 1997, registration granted July 21, 1999, registration number 199909280, class 36. The trademark owner provides its Australian address and an address for service in Hong Kong.

The Complainants or an associated entity also use the domain name <firststateinvestments.com>.

For the Respondent

No factual background is available about the Respondent except for the name Italy Technology Recommend Center (Asia) Investment Co., Limited, provided to the
Registrar for the purpose of registration of the disputed domain name, and the administrative and technical contact name Zhang Liang of the same address.

4. Parties’ Contentions

The Complainants

The Complainants contend that the disputed domain name is confusingly similar to the First Complainant’s trademark FIRST STATE and nearly identical to the Second Complainant’s business name. The additional generic word “investments” should not distinguish the disputed domain name and the First Complainant’s trademark. The Internet directory designation “.com.hk” should not detract from confusing similarity between the disputed domain name and the First Complainant’s trademark.

The Complainants further contend that the Respondent does not have a legitimate interest in the disputed domain name. The First Complainant's trademark FIRST STATE was registered in 1999. To the best of the Complainants’ knowledge the Respondent does not hold any similar trademark. The Respondent is not making a legitimate non-commercial or fair use of, or been commonly known by, the disputed domain name. The word “investments” in the disputed domain name shows that the Respondent had the Complainants’ trademark and business in mind.

The Complainants say that the disputed domain name has been registered and used in bad faith. The Respondent ought to have known of the Complainants’ rights in the trademark FIRST STATE, which was registered well before the disputed domain name. The Complainants say that the Respondent intended to exploit the Complainant’s goodwill in the trademark. The Respondent’s website to which the disputed domain name resolves is inactive or passive, constituting bad faith. There is no evidence of preparation for use of the disputed domain name by the Respondent. Nothing connects the Respondent’s name as given in the WhoIs information to the name FIRST STATE.

The Complainants have cited decisions in cases heard under the Uniform Domain Name Dispute Resolution Policy (UDRP) (as Approved by ICANN, October 24, 1999) in support of their position.

The Complainants request the transfer of the disputed domain name to the Second Complainant.

The Respondent

The Respondent has not submitted any Response to the Complaint.
5. Findings by the Arbitration Panel

Paragraph 4(a) of the DNDRP requires the Complainant to prove 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 Arbitration Panel is satisfied by the copy of the trademark registration document produced in evidence that the First Complainant has the requisite rights in the Hong Kong registered trademark FIRST STATE.

The disputed domain name is <firststateinvestments.com.hk>, which may be read as “first state investments”, followed by the second level and country code designations “.com.hk” that may generally be disregarded in the determination of confusing similarity. What remains is “first state”, being effectively identical to the trademark FIRST STATE, followed by the generic or descriptive word “investments”. The Arbitration Panel finds the disputed domain name to be confusingly similar to the First Complainant’s trademark and the confusing similarity to be exacerbated by the inclusion of the generic word “investments”, which is in general terms descriptive of the field of business of the Complainants. Accordingly the Arbitration Panel finds for the Complainants in the terms of Paragraph 4(a)(i) of the DNDRP.

(2). Rights or Legitimate Interests of Respondent

The Complainants have stated a prima facie case to the effect that the Respondent has not been granted and does not have rights or legitimate interests in the disputed domain name.

Paragraph 4(d) of the DNDRP provides for the Respondent to seek to refute the Complainant’s assertions and to demonstrate relevant rights or legitimate interests in the disputed domain name, by showing:

“(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 Respondent has not made any submissions under paragraph 4(d) of the DNDRP. In particular, since there is no evidence of any legitimate service associated with the disputed domain name, the Respondent could not prevail under paragraphs 4(d)(i) or 4(d)(iv) of the DNDRP. There is no evidence that the Respondent has been commonly known as “first state” or “first state investments” or has held identical trademark or service mark rights in the terms of paragraph 4(d)(ii) or 4(d)(iii) of the DNDRP. The disputed domain name is registered to a company name and not in one of the Individual Domain Name Categories within the contemplation of paragraph 4(d)(v) of the DNDRP. Accordingly the Arbitration panel finds for the Complainants under paragraph 4(a)(ii) of the DNDRP.

(3) Bad faith

The Complainant is required to prove that the Respondent has registered and is using the disputed domain name in bad faith. Paragraph 4(b) of the DNDRP lists certain illustrative circumstances, but without limitation, that shall be evidence of the registration and use of a disputed 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 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.”

According to a screen capture produced by the Complainants in evidence, an attempt to reach the website to which disputed domain name might resolve was unsuccessful. Presumably because the Complainants’ representative is located in Sweden, the screen capture stated in Swedish that (colloquially) the website cannot be accessed and that <firststateinvestments.com.hk> rejected the connection. The Complainants’ own website <firststateinvestments.com> was automatically suggested as an alternative.

Thus, prima facie, the disputed domain name may appear not to be in use and to be passively held. Whilst decisions made under the UDRP do not have precedential status even under the UDRP, and the DNDRP differs from the UDRP in various respects, nevertheless certain principles have been widely respected under disparate domain name dispute jurisdictions. The Panelist in the early UDRP case Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, considered circumstances in which a domain name passively held may nevertheless be deemed to be in use.

In this respect it is notable in the present case that, among other things: confusion with the First Complainant’s trademark is enhanced by the inclusion in the disputed domain name of the word “investments”, being descriptive of the Complainants’ field of business; the Respondent has not offered any indication of good faith intent or replied to the Complaint at all; and no reasonably plausible and innocent use for the disputed domain name in the hands of the Respondent, without intent to leverage off the goodwill embodied in the Complainants’ trademark, is conceivable to the Arbitration Panel. Without specific reference to the provisions of paragraph 4(b) of the DNDRP, which are without limitation, the Arbitration Panel finds on the evidence, and on the balance of probabilities, that the disputed domain name has been used in bad faith, and on the balance of probabilities, was registered for the bad faith purpose for which it has been used. Accordingly the Arbitration Panel finds registration and use of the disputed domain name in bad faith and finds for the Complainants in the terms of paragraph 4(a) of the DNDRP.

(4). Individual Category of Domain Name

The disputed domain name is not registered under an Individual Category of Domain Name. Paragraph 4(a)(iv) of the DNDRP is not applicable.
(5). **Eligibility for transfer**

Article 3.6 of the Registration Policies provides that only commercial entities registered in HKSAR are eligible to register a “.com.hk” English Domain Name. Annexed to the Complaint is a copy of an online search result from the Cyber Search Centre of the Integrated Companies Registry Information System (ICRIS), The Government of the Hong Kong Special Administrative Region, showing First State Investments (Hong Kong) Limited, incorporated December 22, 1987, and under its present name since November 30, 2001, CR No. 0206616, to be duly registered.

6. **AWARD**

The Arbitration Panel finds that the First Complainant has rights in Hong Kong in the trademark FIRST STATE; the disputed domain name is confusingly similar to that trademark; the Respondent has no rights or legitimate interests in respect of the disputed domain name; and the disputed domain name has been registered and is being used in bad faith.

Only commercial entities registered in HKSAR are eligible to register a “.com.hk” English Domain Name. The disputed domain name <firststateinvestments.com.hk> is ordered to be transferred to the Second Complainant.

Date of Issue: October 19, 2017

Place of arbitration: Dunedin, New Zealand

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Dr. Clive Trotman
Sole Panelist of the Arbitral Tribunal