.hk Domain Name Dispute Resolution
ARBITRATION PANEL DECISION

Complainant: IHERB INC.
Respondent: LI LE ADVERTISING (HK) LIMITED
Case Number: DHK-1800157
Contested Domain Name: <iherb.com.hk>
Panel Members: Mr. Ike Ehiriibe, Mr. David Allison & Dr. Hong Xue

1. Parties and Contested Domain Name

1.1 The Complainant is IHERB INC., a corporation incorporated in the United States of America with its registered office at 15535 Sand Canyon Avenue, Irvine, CA 92618, USA (the “Complainant”) and represented by Marks & Clerk in Hong Kong.

1.2 The Respondent is Li Le Advertising (HK) Limited, a limited liability company with its registered office at Flat B3, G/F, Choi Kam House, 102 Prince Edward Road West Mongkok, Kowloon, Hong Kong (the “Respondent”) and unrepresented.

1.3 The disputed domain name is <iherb.com.hk> (the “Disputed Domain Name”), which was registered by the Respondent with the Hong Kong Domain Name Registration Company Limited (the “Registrar”).

2. Procedural History

2.1 The Complaint was filed with the Hong Kong International Arbitration Centre (the “HKIAC”) on 12 July 2018. On 12 July, 2018, the HKIAC transmitted by email to the Hong Kong Domain Name Registration Company Ltd a request for registrar verification in connection with the Disputed Domain Name. On 13 July, 2018, the Hong Kong Domain Name Registration Company Ltd transmitted by email to the HKIAC its verification response confirming that the Respondent is listed as the registrant and provided the contact details.
2.2 The HKIAC formally notified the Respondent of the Complaint and the
attached exhibits, by email of 25 July, 2018 and advised the Respondent of
the prescribed fifteen business days deadline within which to file a response;
being on or before 15 August, 2018. The Respondent did not file a response.

2.3 By email of 29 August 2018, the HKIAC advised the Parties that a three
member panel consisting of Mr. Ike Ehiribe, Mr. David Allison and Dr.
Hong Xue had been appointed to determine this reference.

3. Factual Background

For the Complainant

3.1 The Complainant is a corporation incorporated in the United States of
America with its registered office at 15535 Sand Canyon Avenue, Irvine CA
92618, United States. The Complainant owns the following “IHERB” and
“IHERB.COM” Trusted Brands Health Rewards trademarks in numerous
countries all over the world such as Canada, China, Taiwan, European Union,
Russia, Hong Kong, Singapore, Japan, Brazil, Australia, Norway, New
Zealand, the Philippines, Indonesia, India and the United States of America.
The Complainant engages in the online retail sale of natural products; such
as supplements, body and beauty care products, energy food, vitamins,
minerals, herbs, household cleaning products, fitness products and over 100
other categories of products to customers around the world including Hong
Kong.

For the Respondent

3.2 The Respondent is a company in the business of advertising, with its
registered office at Unit B3, G/F Choi Kam House, 102 Prince Edward Road
West Mongkok, Kowloon, Hong Kong. The Respondent registered the
Disputed Domain Name <iherb.com.hk> on 10 January, 2012 according to
the WHOIS search result attached to these proceedings.

4. Parties’ Contentions

The Complainant

4.1 The Complainant asserts that the Disputed Domain Name <iherb.com.hk> is
identical or confusingly similar to the Complainant’s “IHERB” and IHERB.COM
Trusted Brands Health Rewards trademarks owned and used by the Complainant
around the world and in Hong Kong in line with paragraph 4(a) (i) of the “hk”
Domain Name Dispute Resolution Policy. In this regard, the Complainant refers to
the marked official records of registered trademarks in numerous countries and
attached to this proceeding. The Complainant asserts that the word; “IHERB” which
is the identifying feature in the Disputed Domain Name is equally the identifying element in the Complainant’s own company name. Furthermore, it is argued that the Disputed Domain Name incorporates the entirety of the Complainant’s “IHERB” trademark. The Complainant it is said also owns the following domain names namely, <iherb.com>, <hk.iherb.com> and <iherb.hk> registered in 1997 and 2010 respectively. The Complainant argues that the Complainant had applied and registered its “IHERB” trademark in various countries around the world prior to 10 January 2012, being the date the Respondent registered the Disputed Domain Name.

4.2 The Complainant further asserts that the Respondent has no rights or legitimate interests in the Disputed Domain Name in accordance with paragraph 4(a)(ii) of the Policy in that the Respondent has never been authorized to register the Disputed Domain Name and or that the Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name. The Complainant it is said, has been using the “IHERB” trademark since 1997 and the domain names <iherb.com> and <iherb.hk> since 1997 and 2010 respectively around the world and in Hong Kong. The Complainant further contends that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, from the Complainant to use its “IHERB” mark in a domain name or in any other manner. The Complainant states further that as part of a Reward Program, the Complainant has been paying rewards earnings to customers on orders shipped to Hong Kong continuously from 2008 until 2017 with a total amount of rewards in the sum of USD 1, 662,424 derived therefrom.

4.3 The Complainant also submits that the Respondent has engaged in bad faith use and registration as provided for in paragraph 4(a)(iii) of the Policy. In support of this contention, the Complainant asserts that the Respondent ought to have been aware of the Complainant’s trademarks and or domain names before deciding to register the Disputed Domain Name. The Complainant also reveals that as from June 2012 until December 2014, the Respondent’s website which resolves to the Respondent’s Disputed Domain Name was not in active use.

4.4 As further evidence of bad faith use and registration, the Complainant contends that the Respondent’s website incorporating the Disputed Domain Name was illegitimately positioned to obtain Rewards Credit for its customers from the Complainant by automatically redirecting visitors to the Registrant’s website to the Complainant’s website, such scheme it is said, brings no benefit to the Complainant, instead, it clearly shows bad faith use by the Respondent in registering and using the Disputed Domain Name. Furthermore, it is submitted that the Respondent has for commercial gain attempted to attract Internet users to the website to which the Disputed Domain Name resolves, by exploiting the Complainant’s reputation and goodwill in its “IHERB” trademark and domain names, thereby, creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, endorsement of the website as well as the services offered on the website.
5. **Findings**

According to Paragraph 4a 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 Name 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 Name; and

(iii) the Disputed Domain Name 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 registration.

(1). **Identical/confusing similarity**

This Panel is satisfied that the Complainant has long established rights in the “IHERB” trademark in numerous jurisdictions including in Hong Kong where the Respondent is based and is said to operate from. The Panel is also satisfied that on a careful comparison of the Disputed Domain Name <iherb.com.hk> with the Complainant’s trademark, it is undoubtedly obvious that the Disputed Domain Name is identical or confusingly similar to the Complainant’s trademark and indeed the Complainant’s other domain names, since the Disputed Domain Name entirely incorporates the Complainant’s “IHERB” trademark. In support, see in particular, a recent and consolidated UDRP decision in WhatsApp Inc. v. Private Whois whois whatsappandroid.com, Private Whois whois whatsappipad.com and Private Whois whois whatsappiphone.com, WIPO Case No. D2012-0674, where the disputed domain names namely: (i) <whatsappandroid.com>; (ii) <whatsappipad.com>; and (iii) <whatsappiphone.com> were all found to be confusingly similar and identical to the complainant’s trademark.

Furthermore, the fact that the Disputed Domain Name includes the generic top level domain “. com” and the country abbreviation “hk” does not preclude a finding of identical or confusing similarity. See in this regard a

In the circumstances the Panel finds that the Complainant has satisfied the requirements of paragraph 4 (a)(i) of the Policy.

(2). Rights or Legitimate Interests of Respondent

The Panel accepts, as is contended by the Complainant that the Respondent is not a licensee of, or is it affiliated with the Complainant in any manner to suggest that it is authorized by the Complainant to use the Complainant’s “IHHERB” trademark. The Respondent has failed to provide any evidence to establish that it has been commonly known by, or has been making a *bona fide* use of the Disputed Domain Name in connection with the offering of goods or services or has been making a legitimate non-commercial or fair use of the Disputed Domain Name. Accordingly, this Panel is satisfied that the Respondent’s practice of diverting internet visitors from the Respondent’s website to the Complainant’s website and thereby compromising the Complainant’s established Rewards Program for its customers demonstrates (i) unauthorized usage on the part of the Respondent, and (ii) that the Respondent has no rights or legitimate interests in the Disputed Domain Name. As such unauthorized usage can never be described as a *bona fide* offering of goods and services nor a legitimate non-commercial or fair use of the disputed Domain Name See generally in this regard, *Oki Data Americas Inc. v. ASD Inc.*, WIPO Case No.D2001-0903.

In the circumstances and considering the Respondent’s failure to furnish a defence in these proceedings, the Panel finds that the Complainant has satisfied the requirements of paragraph 4 (a)(ii) of the Policy.

(3). Bad faith

On the question of bad faith use and registration, the Panel finds that the Respondent undoubtedly registered the Disputed Domain Name in bad faith and engaged in bad faith use. In arriving at this conclusion, the Panel has taken into account a number of irrefutable factors. In the first instance, the Panel finds that the Respondent must have known or ought to have known of the Complainant’s extensive exclusive rights in the “IHHERB” trademark in numerous countries all over the world and particularly in Hong Kong where the Respondent is located and is said to operate from. Obviously, the
Respondent elected to register the Disputed Domain Name on 10 January 2012, well after the Complainant had obtained registration of its trademark and domain names in Hong Kong and other diverse countries since 1997. The Panel without any hesitation finds that the intention to exploit the Complainant’s worldwide reputation and goodwill in the said “HERB” trademark was the motivating factor behind the registration of the Disputed Domain Name. Secondly, the Panel finds that the Respondent has made use of the Disputed Domain Name to mislead the public into believing that the Respondent’s website is an official website of the Complainant by the use of the Complainant’s “HERB” trademark. Thirdly, the Respondent has attempted to use the Disputed Domain name to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship affiliation or endorsement of that website. Fourthly, the Panel finds the Respondent’s failure to respond to the Complainant’s complaint is further evidence of bad faith use. Finally, and in any event the Panel has drawn adverse inferences from the Respondent’s failure and or refusal to respond to the evidence and submissions presented by the Complainant in these proceedings.

The Panel therefore finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

6. Conclusions

At paragraph 7 of the complaint, titled “Remedies Sought” the Complainant has requested that the Panel transfer the Disputed Domain Name to the Complainant. Normally, in the event of a successful complaint, the disputed domain name would be transferred to the Complainant. However, Article 3.6 of the Domain Name Registration Policies, Procedures and Guidelines, effective 22 February 2011, stipulates that Commercial entities registered in HKSAR are eligible to register a.com.hk English Domain Name. Therefore as the Complainant is not a commercial entity registered in Hong Kong, the Disputed Domain Name shall be transferred to Marks & Clerk the Complainant’s solicitors and agents in Hong Kong. Therefore, upon the Complainant’s Solicitors confirming that they have been nominated to receive the Disputed Domain Name, the Panel directs the transfer of the Disputed Domain Name to Messrs Marks & Clerk at Level 9, Cyberport 1, 100 Cyberport Road, Pok Fu Lam, Hong Kong.

7. Decision
For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel directs that the Disputed Domain Name <therb.com.hk> be transferred to the Complainant's solicitors and agents in Hong Kong being Marks & Clerk.

Dated: 19 September 2018

Mr. Ike Ehiribe  
Presiding Panelist

Mr. David Allison  
Co - Panelist

Dr. Xue  
Hong  
Co - Panelist