.hk Domain Name Dispute Resolution
AWARD BY ARBITRATION PANEL

Complainant: Tencent Holdings Limited (騰訊控股有限公司)
Respondent: Sunfore Technology Limited (訊科技術有限公司)
Case Number: DHK-1800159
Contested Domain Name: <wechat.com.hk>
Panel Member: Sebastian Hughes

1. Parties and Contested Domain Name

The Complainant is Tencent Holdings Limited (騰訊控股有限公司), of P.O. Box 2681 GT, Century Yard, Cricket Square, Hutchins Drive, George Town, Grand Cayman, Cayman Islands, represented by Paddy Tam, CSC Digital Brand Services Group AB.

The Respondent is Sunfore Technology Limited, of Suite 1802, Fortune Commercial Building, 362 Sha Tsui Rd., Tsuen Wan, N. T., Hong Kong, self-represented.

The contested domain name is <wechat.com.hk> (the “Domain Name”), registered by the Respondent with Hong Kong Domain Name Registration Company Limited.

2. Procedural History

The Complaint was filed with the Hong Kong International Arbitration Centre (the “Centre”) on October 24, 2018. On the same day, the Centre transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 24, 2018, the Registrar transmitted by email to the Centre its verification response disclosing an address for the Respondent which differed from the address for the Respondent listed in the Complaint. The Centre sent an email communication to the Complainant on October 24, 2018 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 25, 2018.

The Centre verified that the Complaint satisfied the formal requirements of the HKDNR Domain Name Dispute Resolution Policy (the “Policy”) and the HKDNR Domain Name Dispute Resolution Rules (the “Rules”).
In accordance with paragraphs 2(a) and 4(a) of the Rules, the Centre formally notified the Respondent of the Complaint, and the proceeding commenced, on October 26, 2018.

On October 26, 2018, an English language email was sent to the Centre on behalf of the Respondent requesting that the language of the proceeding be Chinese. On October 29, 2018, the Centre sent an email to the Respondent noting that, in accordance with paragraph 11(a) of the Rules, the language of the proceeding should normally be English. On October 29, 2018, the Complainant’s representatives sent an email to the Centre requesting that the proceeding continue in English, in accordance with paragraph 11(a) of the Rules. On October 29, 2018, the Centre sent an email to the Parties, advising that the question of the language of the proceeding would be determined by the Panelist.

In accordance with paragraph 5(a) of the Rules, the due date for Response was November 15, 2018. The Respondent did not submit any response. Accordingly, the Centre notified the Parties of the Respondent’s default on November 16, 2018.

The Centre appointed Sebastian Hughes as the sole Panelist in this matter on November 26, 2018. The Panel finds that it was properly constituted. The Panel has confirmed its impartiality and independence, in accordance with paragraph 7 of the Rules.

3. **Factual Background**

A. **Complainant**

The Complainant is a Hong Kong listed company incorporated in the Cayman Islands, and a leading provider of Internet value added services in China.

The Complainant is the owner of numerous registrations in jurisdictions worldwide for the word and device trade mark WECHAT (the “Trade Mark”), including Hong Kong registration No. 302060252, with a registration date of November 17, 2011.

The Complainant has been using the Trade Mark since 2011 in respect of its 微信/WeChat multi-purpose mobile digital lifestyle app - a platform integrating instant messaging, social entertainment and mobile payment functions. In the first quarter of 2017, there were more than 938 million monthly active users of the Complainant’s 微信/WeChat app.

The Complainant is also the owner of registrations for the device trade mark WECHAT PAY and the device trade mark 微信支付, used by the Complainant in respect of its mobile payment services (collectively, the “WECHAT PAY Trade Marks”), including Hong Kong registration No. 303724353 for the WECHAT PAY
mark, with a registration date of March 24, 2016; and Hong Kong registration No. 303724353 for the 微信支付 mark, with a registration date of March 27, 2015.

The Complainant promotes and uses its WECHAT and WECHAT PAY services under the Trade Mark and the WECHAT PAY Trade Marks using distinctive green corporate livery and branding.

B. Respondent

The Respondent is a company incorporated in Hong Kong.

C. The Contested Domain Name

The Domain Name was registered on October 26, 2012.

D. Use of the Contested Domain Name

The Domain Name has previously been used in respect of a website featuring the Trade Mark and the WECHAT PAY Trade Marks and using the same green corporate livery and branding used by the Complainant in respect of its WECHAT and WECHAT PAY mobile payment services, and apparently offering mobile payment services under the name WECHAT PAY HK (the “Website”). As at the date of filing of the Complaint and as at the date of this Decision, the Domain Name is not being used.

4. Parties’ Contentions

The Complainant

The Complainant contends that the Domain Name is identical to the Trade Mark, the Respondent has no rights or legitimate interests in respect of the Domain Name, and the Domain Name has been registered and is being used in bad faith.

The Respondent

The Respondent did not reply to the Complainant’s contentions.

5. Findings

5.1 Language of the Proceeding

Paragraph 11(a) of the Rules provides as follows:

“11. Language of the Arbitration Proceedings

(a) Unless otherwise agreed by the Parties, the language of the arbitration proceedings shall be in English for English .hk domain name, and in Chinese
for Chinese .hk domain name or 香港 domain name, subject always to the authority of the Arbitration Panel to determine otherwise, having regard to all the circumstances of the arbitration proceeding.”

As the Domain Name is an English .hk domain name, the language of the proceeding should normally be English.

The Respondent has not provided any reasons or filed any evidence in support of the Respondent’s (English language) request for the language of the proceeding to be Chinese.

The Complainant submits that the Respondent’s English language request, and the fact the Website contained English as well as Chinese language content, demonstrate that the Respondent is able to read, write and understand English.

The Panel agrees that the evidence suggests the likely possibility that the Respondent is conversant in English. The Panel is also minded of the need to avoid additional translation costs and the need to avoid delay.

In all the circumstances, and in light of the Respondent’s failure to provide any reasons or evidence in support of its language request, the Panel can see no reason to deviate from the normal position under paragraph 11(a) of the Rules. The Panel therefore determines that the language of the proceeding shall be English.

5.2 Substantive Elements of the Policy

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving that:

(i) The 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 Domain Name; and

(iii) The 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.

(1) Identity/confusing similarity

The Panel finds that the Complainant has rights in the Trade Mark acquired through use and registration.

The disputed domain name comprises the Trade Mark in its entirety and is therefore, excluding the ccTLD “.com.hk”, identical to the Trade Mark.
Accordingly, the first element under paragraph 4(a) of the Policy has been made out.

(2). Rights or Legitimate Interests

Paragraph 4(d) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a registrant has rights or legitimate interests in a contested domain name:

(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 trade mark or service mark rights that are 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.

There is no evidence that the Complainant has authorised, licensed, or permitted the Respondent to register and use the Domain Name. The Complainant has prior rights in the Trade Mark which precede the Respondent’s registration of the Domain Name. The Panel finds on the record that there is therefore a prima facie case that the Respondent has no rights or legitimate interests in the Domain Name, and the burden is thus on the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that it has acquired any trade mark rights in respect of the Domain Name or that the Domain Name has been used in connection with a bona fide offering of goods or services. To the contrary, the Domain Name has previously been used in respect of the Website, to offer mobile payment services in direct competition with those offered by the Complainant under the Trade Mark and the WECHAT PAY Trade Marks.

There has been no evidence adduced to show that the Respondent has been commonly known by the Domain Name.

There has been no evidence adduced to show that the Respondent is making a legitimate non-commercial or fair use of the Domain Name.

The Panel finds that the Respondent has failed to produce any evidence to establish rights or legitimate interests in the Domain Name. The Panel therefore finds that the Complaint fulfils the second condition of paragraph 4(a) of the Policy.
(3). **Bad faith**

In light of the manner of use by the Respondent of the Website, the Panel has no hesitation in concluding that bad faith registration and use has been made out, under paragraph 4(b)(iv) of the Policy.

The Website flagrantly reproduced the Trade Mark and the WECHAT PAY Trade Marks, as well as the corporate livery used by the Complainant, in order to offer mobile payment services in direct competition with those offered by the Complainant under the Trade Mark and the WECHAT PAY Trade Marks. The undisputed evidence submitted by the Complainant demonstrates that the Respondent has registered and used the Domain Name in order to pass itself off as the Complainant, or an entity licensed, sponsored, endorsed or approved by the Complainant, contrary to the fact.

In all the circumstances, there can be no question that the Respondent must have been aware of the Complainant and of its relevant trade mark rights at the time of registration of the Domain Name.

The Panel finds that the Respondent’s acts in (1) taking down the Website; and (2) failing to file any response (having initially made its language request to the Centre), provide further grounds in support of a finding of bad faith.

(4). **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 fourth limb under paragraph 4(a) of the Policy is not applicable to this proceeding, as the Domain Name has not been registered by an individual person.

6. **Award**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <wechat.com.hk> be transferred to the Complainant.

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Sebastian Hughes
Dated: December 4, 2018