.hk Domain Name Dispute Resolution
AWARD BY ARBITRATION PANEL

Complainant: Mozilla Foundation (First Complainant), and Mozilla Corporation (Second Complainant).

Respondent: 田洋/Tian Yang

Case Number: DHK-1800160

Contested Domain Name: <firefox.hk>

Panel Member: Dr. Yijun TIAN

1. Parties and Contested Domain Name

Complainant in this administrative proceeding is Mozilla Foundation (First Complainant), and its wholly-owned subsidiary, Mozilla Corporation (Second Complainant), both with their principal place of business at 331 East Evelyn Ave, Mountain View, California 94041, United States of America (hereinafter collectively ‘Complainant’ or ‘Mozilla’).

Respondent in this administrative proceeding is 田洋/Tian Yang of si chuan sheng cheng du sheng deng lu 111 hao, Chengdu 610031, China

The disputed domain name <firefox.hk> was registered by Respondent through Registrar - West263 International Limited; Address: 12/F., San Toi Building, 137-139 Connaught Road Central, China Hong Kong.

2. Procedural History

The Complainant filed the Complaint with the Hong Kong International Arbitration Centre (HKIAC) on 28 November 2018, in accordance with the Hong Kong Internet Registration Corporation Limited (HKIRC) Domain Name Dispute Resolution Policy (the "Policy") issued by CNNIC on 22 February 2011.

On 28 November 2018, the HKIAC confirmed receipt of the Complaint, and then sent an email to the Registrar of the Domain Name requesting verification in connection with the relevant information of the Domain Name at issue.
On 28 November 2018, the Registrar of the Domain Name confirmed that Respondent is 田洋/Tian Yang of Chengdu, Sihuan China, and the Domain Name is registered with West263 International Limited.

On 7 January 2019, the HKIAC sent Respondent a written notice of complaint which involved a notification that a complaint concerning the Domain Name <firefox.hk> was submitted against Respondent and a requirement to submit a Response within 15 days from 7 January 2019 (on or before 28 January 2019), and forwarded the Complaint (along with its Annexes) to the Respondent pursuant to the Policy, the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure, approved by HKIRC on 22 February 2011 (the “Rules”) and the HKIAC Supplemental Rules (the “Supplemental Rules”) effective from 1 March 2011. The formal date of the commencement of the administrative proceeding on was 7 January 2019.

On 29 January 2019, the HKIAC confirmed that it did not receive a Response from the Respondent in respect of the Complaint concerning the Domain Name within the required period.

On 8 March 2019, the HKIAC appointed Dr Yijun TIAN as the sole Panelist for this Domain Name dispute, and the case files were transferred to the Panelist, on the same day.

3. Factual Background

For the Complainant

Complainant, Mozilla, is a company incorporated in Mountain View, California, United States of America (USA). Founded in 2003, Complainant is best known for creating the world-renowned Firefox internet browser. Today, more than half a billion people around the world use Firefox as their internet browser, making it the 3rd most-used web browser in the world and 4th in Hong Kong China. Complainant has particularly developed its business in China since 2005. At the end of 2007, Complainant established a long-term partnership with Baidu so as to feature the latter as the default search engine provider for its Chinese Firefox browser. Complainant also released a special edition of Firefox for the Beijing 2008 Summer Olympic Games and, in the same year, launched Firefox China Edition, a web browser designed with the needs of Chinese internet users in mind (Annex 6 to Complainant).

Complainant has exclusive rights in the FIREFOX trademark globally. Complainant is the exclusive owner of well-known registered trademark FIREFOX in many countries, including China (since 2012; see Annex 5 to the Complaint); Hong Kong China (since 2014). Complainant has also registered
the trademark FIREFOX as a domain name under many gTLDs and ccTLDs worldwide, such as <firefox.com> (created in 1998). (Annex 6 to the Complaint).

For the Respondent

Respondent in this administrative proceeding is 天洋/Tian Yang of Chengdu Sihuan, China. The disputed domain name <firefox.hk> was registered on May 26, 2014, long after the FIREFOX trademark became internationally well-known (Annexes 4 and 10 to the Complaint).

4. Parties’ Contentions

The Complainant

The Complainant’s contentions may be summarized as follows:

Complainant contends that the disputed domain name <firefox.hk> is identical or confusingly similar to its trademark or service mark FIREFOX in Hong Kong China in which Complainant has rights.

Complainant contends that Respondent has no rights or legitimate interests in respect of the disputed domain name.

Complainant contends that the disputed domain name has been registered and is being used in bad faith.

Complainant requests that the disputed domain name <firefox.hk> be transferred to it.

The Respondent

Respondent did not reply to Complainant’s contentions.

5. Findings by the Arbitration Panel

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; 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 Panel finds that Complainant has rights in the FIREFOX marks acquired through registration. The FIREFOX marks have been registered in China (2012) and Hong Kong China (2014). The disputed domain name <firefox.hk> comprises the FIREFOX mark in its entirety.

Generally, a respondent may not avoid likely confusion by appropriating another’s entire mark and adding descriptive or non-distinctive matter to it. *(The Argento Wine Company Limited v. Argento Beijing Trading Company, WIPO Case No. D2009-0610; PCCW-HKT DataCom Services Limited v. Yingke, ADNDRC Case No. HK0500065).*

The disputed domain name only differs from Complainant’s trademarks by the gTLD suffix “.hk” to the FIREFOX marks. This does not eliminate the confusing similarity between Complainant’s registered trademarks and the disputed domain name.

Thus, the Panel finds that disregarding the gTLD suffix “.hk”, the disputed domain name is confusingly similar to the FIREFOX marks. The Panel therefore holds that Complainant fulfils the first condition of paragraph 4(a) of the Policy.

(2). Rights or Legitimate Interests of Respondent

Complainant is the exclusive owner of famous and well-known registered trademark FIREFOX in many countries, including USA (since 2005), China (since 2012) (Annex 5 to the Complaint), which precedes Respondent’s registration of the disputed domain name (May 26, 2014).

According to Complainant, Compliant is best known for creating the world-renowned Firefox internet browser. More than half a billion people worldwide
use Firefox as their internet browser, making it the 3rd most-used web browser in the world and 4th in Hong Kong China.

Moreover, Respondent is not an authorized dealer of FIREFOX-branded products or services. Complainant has therefore established a prima facie case that Respondent has no rights or legitimate interests in the disputed domain name and thereby shifted the burden to Respondent to produce evidence to rebut this presumption (The Argento Wine Company Limited v. Argento Beijing Trading Company, supra; Do The Hustle, LLC v. Tropic Web, WIPO Case No. D2000-0624; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455).

Based on the following reasons the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name:

(a) There has been no evidence adduced to show that Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. Respondent has not provided evidence of a legitimate use of the disputed domain name or reasons to justify the choice of the word “firefox” in its business operation or the use of the FIREFOX trademark and design on its website (without disclaimer or other clarifying details). There has been no evidence to show that Complainant has licensed or otherwise permitted Respondent to use the FIREFOX trademark or to apply for or use any domain name incorporating the FIREFOX trademark;

(b) There has been no evidence adduced to show that Respondent has been commonly known by the disputed domain name. There has been no evidence adduced to show that Respondent has any registered trademark rights with respect to the disputed domain name. Respondent registered the disputed domain name <firefox.hk> on May 26, 2014. The disputed domain name is identical or confusingly similar to Complainant’s FIREFOX trademark.

(c) There has been no evidence adduced to show that Respondent is making a legitimate noncommercial or fair use of the disputed domain name. By contrast, according to the information provided by Complainant, the disputed domain name <firefox.hk> is connected to the homepage of promoting the services of the Respondent's company – a company called ‘Chengdu Firefox Technology’, which may appear to some Internet users as an official website in Chengdu endorsed or sponsored by Complainant (Annex 12 to the Complaint), when in fact the Respondent is not an authorized dealer of FIREFOX-branded products or services.

The Panel finds that Respondent has failed to produce any evidence to establish its rights or legitimate interests in the disputed domain name in light of Complainant’s prima facie case. The Panel therefore holds that the Complaint fulfils the second condition of paragraph 4(a) of the Policy.

(3). Bad faith
Paragraph 4(b) of the Policy sets out four circumstances which, without limitation, shall be evidence of the registration and use of the disputed 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.

The Panel concludes that the circumstances referred to in paragraph 4(b)(iv) of the Policy are applicable to the present case and upon the evidence of these circumstances and other relevant circumstances, it is adequate to conclude that Respondent has registered and used the disputed domain name in bad faith.

a) Registered in Bad Faith

The Panel finds that Complainant has a widespread reputation in the FIREFOX marks with regard to its products and services. As mentioned above, Compliant is best known for creating the world-renowned Firefox internet browser. More than half a billion people around the world use Firefox as their internet browser, and Complainant has particularly developed its business in China since 2005. Complainant established a long-term partnership with Baidu so as to feature the latter as the default search engine provider for its Chinese Firefox browser since 2007, and launched Firefox China Edition, a web browser designed with the needs of Chinese internet users in mind (Annex 6 to Compliant). Complainant has rights in the FIREFOX marks in China and internationally.

It is not conceivable that Respondent would not have been aware of Complainant’s trademark rights at the time of the registration of the disputed
domain name (in 2014) particularly given that Respondent has used Complainant’s marks and the website at the disputed domain name is designed to appear as the website authorized by Complainant.

Thus, the Panel concludes that the disputed domain name was registered in bad faith.

b) Used in Bad Faith

Given the widespread reputation of the FIREFOX trademark, the confusingly similar domain name, as well as the content on the website mentioned above, the Panel finds that the public is likely to be confused into thinking that the disputed domain name has a connection with Complainant, contrary to the fact. There is a strong likelihood of confusion as to source, sponsorship, affiliation or endorsement of the website to which the disputed domain name is resolved (Annexes 12 to the Complaint). In other words, Respondent has through the use of a confusingly similar domain name and webpage contents created a likelihood of confusion with the FIREFOX trademark.

Noting also that apparently no clarification as to Respondent’s relationship to Complainant is made on the homepage of the disputed domain name, potential Internet users are likely led to believe that the website at <firefox.hk> is either Complainant’s site or the site of official authorized agents of Complainant in Hong Kong or Chengdu China, which it is not. Moreover, Respondent has not responded formally to the Complaint. The Panel therefore concludes that the disputed domain name was used by Respondent in bad faith.

In summary, Respondent, by choosing to register and use a domain name which is confusingly similar to Complainant’s trademark, intended to ride on the goodwill of Complainant’s trademark, disrupt the Complainant's normal business, and create confusion with the Complainant’s name or mark so as to mislead the public. In the absence of evidence to the contrary and rebuttal from Respondent, the choice of the disputed domain name and the conduct of Respondent as far as the website on to which the disputed domain name resolves is indicative of registration and use of the disputed domain name in bad faith.

The Panel therefore holds that the Complaint fulfils the third condition of paragraph 4(a) of the Policy.

(4). 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
Paragraph 4(c) of the Policy sets out the circumstances which shall be evidence of the registration in violation of the eligibility requirements for .idv.hk/.個人.hk / .個人.香港 Domain Names ('Individual Domain Name Categories'). These include ‘the name incorporated in the Domain Name is not the Registrant’s legal name for 個人.hk and 個人.香港 domain names as set out in the Registration Agreement and the Registration Policies, Procedures and Guidelines and the Published Policies’.

The Panel finds that the fourth condition of paragraph 4(a) of the Policy is not applicable to this proceeding, as the disputed domain name has not been registered by an individual person. (See Tencent Holdings Limited (騰訊控股有限公司) v. Sunfore Technology Limited (訊科技術有限公司), HKIAC Case No. DHK-1800159).

6. **AWARD**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <firefox.hk> be transferred to Complainant.

Date of Issue: April 12, 2019

Place of arbitration: Sydney

Yijun Tian
Sole Panelist of the Arbitral Tribunal