.hk Domain Name Dispute Resolution
AWARD BY ARBITRATION PANEL

Complainant: MIS Quality Management Corp.
Respondent: 孙启峰 (sun qi feng)
Case Number: DHK-1900164
Contested Domain Name: <moodys.hk>
Sole Panelist of Arbitration Panel: Raymond HO

1. The Parties and Contested Domain Name

The Complainant is MIS Quality Management Corp., whose principal place of business is situate at 7 World Trade Canter, 250 Greenwich St., New York, New York 10007, USA; and its authorized representative in this matter is Alexander J. Urbelis of 1201 Broadway, Suite 904A, New York, New York 10001, USA.

The Respondent is 孙启峰 (sun qi feng) whose address is situated at 江苏省宿迁市沭阳县颖都家园 32 号楼 2 单元 602, 223600, China.

The domain name at issue is <moodys.hk> (the “Disputed Domain Name”) registered with Nicenic International Group Co., LTD. (the “Registrar”) whose email address is support@nicenic.net.

2. Procedural History

On 15 May 2018, Hong Kong International Arbitration Centre ("HKIAC") received a complaint (subsequently revised on 23 July 2019) (“the Complaint”) filed by the Complainant pursuant to the Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Hong Kong Domain Name Internet Registration Corporation Limited (“HKIRC”) on 22 February 2011, the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure (the “Rules”) approved by HKIRC on 22 February 2011 and the HKIAC Supplemental Rules (the “Supplemental Rules”) effective from 1 March 2011.
On 16 May 2019, HKIAC transmitted by email to the Registrar, a request for registrar verification in connection with the WHOIS of the registrant of the Disputed Domain Name.

By an email on 5 July 2019, the Registrar confirmed that the Respondent is the registrant or holder of the Disputed Domain Name; and that the Policy is applicable to the current dispute; and provided HKIAC with the WHOIS information regarding the Disputed Domain Name, including the administrative and technical contacts of the Respondent.

On 23 July 2019, HKIAC served on the Respondent by email the Notification of Commencement of Proceedings (“NCP”) and that the Respondent had 15 business days, on or before 12 August 2019, to submit a Response to the Complaint in accordance with the Policy, the Rules and the Supplemental Rules. The Complaint and its annexures were attached to the NCP issued by HKIAC.

The Respondent did not respond to the Complaint by the due date; and on 15 August 2019, HKIAC issued a notification of the Respondent in Default.

On 20 August 2019, HKIAC appointed Mr. Raymond HO as the sole Panelist of the Arbitration Panel in this matter. The said sole Panelist had, prior to the appointment, submitted his Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the Rules; and the case file was transferred by HKIAC to the said sole Panelist on the same date.

3. Factual Background

The Complainant is a subsidiary of Moody’s Corporation, listed on the New York Stock Exchange (NYSE: MCO) and owns the well-known “Moody’s” marks, the trademarks or service marks used by Moody’s Corporation and its subsidiaries globally (collectively, “Moody’s Marks”). Moody’s Corporation provides credit ratings, research, tools and analysis in the global capital market; and serves its customers through its global network of offices and business affiliations in 42 countries, including in financial centers around the world, such as Hong Kong, New York, London, and Singapore, as well as Shanghai, Tokyo, Toronto, Beijing, Frankfurt, Sydney, Dubai, Mexico City, Sao Paulo and Paris. In addition, the Complainant also owns the domain name <moodys.com> registered on August 26, 1992 which provides timely, high-value services such as instant access to ratings, credit research, and risk assessment tools to Moody’s customers.

The Respondent registered the Disputed Domain Name <moodys.hk> on 20 January 2019 for one year up to 20 January 2020.

4. Parties’ Contentions
A. The Complainant

The Complainant’s contentions are summarized as follows:

(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights.

(a) The Complainant’s Moody’s Marks

(1) The Complainant avers that it has registered “Moody’s” as a trademark in the Hong Kong SAR since 1993/1994 and also as both a service mark and trademark with the United States Patent and Trademark Office (“USPTO”) since 1969. Exhibit 5 to the Complaint contains the documents evidencing the registrations of Moody’s Marks throughout the world. It is the Complainant’s contention that the Complainant has established its rights to those Moody’s Marks for nearly half a century. Furthermore, the Complainant submits that it does not matter that Respondent may reside in a place other than the places of Complainant’s registrations of Moody’s Marks (see Bed Bath & Beyond Procurement Co. Inc. v. Net Manager / Xwings Domains, FA 1796211 (FORUM Aug. 21, 2018)).

(2) The Complainant avers that the Complainant has never entered into or consented to any form of licensing arrangement with the Respondent nor authorized the Respondent to use the Moody’s Marks. The Respondent registered the Disputed Domain Name without the knowledge and authorization of the Complainant nor Moody’s Corporation.

(3) It is the Complainant’s case that the Disputed Domain Name incorporates Moody’s Marks in its entirety and it terminates with the top-level domain name “.hk”. Thus, the Complainant contends that the Deputed Domain Name does not differ from the Moody’s Marks; and it is plainly intended to be confusingly similar to Moody’s distinctive and well-known trademark.

(b) Respondent’s Domain Infringes on Moody’s Marks

(1) The Complainant avers that on January 20, 2019, the Respondent registered the Disputed Domain Name after Moody’s registered and began using its Moody’s Marks in Hong Kong, U.S. and elsewhere. It is the Complainant’s case that the Disputed Domain Name incorporates the totality of Moody’s Marks, “MOODY’S”, and adds the non-distinguishing ccTLD “.hk” only.

(2) The Complainant submits that by capturing the mark “MOODY’S” in its entirety; the Disputed Domain Name is identical to Complainant’s mark, it is “confusingly similar” (See Fareportal Inc. v. Zhao Ke, HKIAC Case No. DHK-1800155 (3 Jul. 2018)).
(3) The addition of the ccTLD “.hk” has consistently been found to not distinguish a domain from a trademark under Article 4(a)(i) of the Policy. Such an addition is insufficient to differentiate the Disputed Domain Name from Moody’s Marks (See Eataly S.R.L., et al. v. Andre Cheng et ano, HKIAC Case No. DHK-1500123 (29 Jul. 2015) and Wells Fargo & Company v. Paul Yacoubian, FA 1820921 (FORUM Jan. 9, 2019)). The Complainant therefore submits that the Panel should find that the Complainant has satisfied the first element under the Policy.

(ii) The Registrant has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant submits that the Panel may consider any relevant aspects included in, but not limited to Article 4(c) of the Policy.

(a) The Complainant avers that the Respondent is not and has not been commonly known by the Disputed Domain Name. Nothing in Respondent’s WHOIS information or the record demonstrates that Respondent is commonly known by the Domain Name. Further, as noted above, Moody’s has never entered into or consented to any form of licensing arrangement with the Respondent or authorized the Respondent to use the Moody’s Marks.

(b) It is the Complainant’s contention that the Respondent is not making a bona fide offering of goods or services through the Disputed Domain Name at issue, nor a legitimate non-commercial or fair use. Rather, the Complainant avers that the confusingly similar Disputed Domain Name resolves to a website that is soliciting offers for the domain itself. Exhibit 6 to the Complainant is a screenshot of MOODYS.HK as of 14 Mar. 2019. The Complainant submits that panels have consistently held that the use of domain names in this manner does not constitute a bona fide offering of goods or services, nor a legitimate non-commercial or fair use (see Fareportal Inc., HKIAC Case No. DHK-1800155; IHerb Inc., HKIAC Case No.DHK-1800157 and Moodle Pty Ltd and Martin Dougiamas v. beats, FA 1814644 (FORUM Dec. 6, 2018)).

(c) As in Eataly S.R.L. et al. v. Andre Cheng et ano, HKIAC Case No. DHK-1500123 (29 Jul. 2015), once a prima facie case is established by complainant that the respondent has no legitimate rights or interests in the disputed domain name, “the burden of proof then shifts to the Respondents to establish otherwise”. The Complainant submits that given this prima facie showing, the burden shifts to the Respondent to rebut Complainant’s contentions.

(d) Based on the foregoing, the Complainant submits that the Panel should find that Respondent has no rights or legitimate interests in the Disputed Domain Name, and that Complainant has satisfied the second element under the Policy.
(iii) Registrant’s Domain Name has been registered and is being used in bad faith. The Complainant submits that the Panel may consider any relevant aspects included in, but not limited to article 4(b) of the Policy.

(a) The Complainant points out that the Disputed Domain Name, MOODYS.HK, resolves to a web page that offers pay-per-click advertisements to generate income. The domain also attempts to commercialize the domain registration in bad faith by offering MOODYS.HK “for sale by its owner” (see Exhibit 6 to the Complaint). The Complainant argues that outright offers of a domain that incorporates another’s mark for sale establishes that the domain was registered and being used in bad faith (See, e.g., Qualtrics, LLC v. Shanta Chw (Top 3 Media Pte. Ltd.), HKIAC Case No. DHK-1700142 (17 July 2017); Airbnb, Inc. v. Super Privacy Service LTD c/o Dyanadot, FA 1821386 (FORUM Jan. 10, 2019); Bayerische Motoren Werke AG v. Thanh Tran, D2014-0721 (WIPO July 5, 2014)).

(b) The Complainant also points out the following deceptive acts are also strong indications of bad faith registration and use of the Disputed Domain Name: (i) Respondent’s use of the domain name at issue to pass itself off as Complainant, (ii) Respondent’s attempt to profit from Complainant’s name via pay-per-click advertisements, and (iii) Respondent’s attempt to attract bidders for the sale of the domain at issue who will likely, in turn, similarly seek to capitalize on traffic to the domain at issue (See IHerb Inc., HKIAC Case No.DHK-1800158 (Respondent’s bad faith is established by its use of complainant’s known mark for “commercial gain … by creating a likelihood of confusion with Complainant’s trademark as to the source, sponsorship affiliation or endorsement of that website.”); see also Citadel Enterprise Americas LLC and its related entity KCG IP Holdings LLC v. Andres Ybarnegaray / Citadel Inversiones, FA 1821206 (FORUM Jan. 10, 2019) (“The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from or exploit the trade mark of another). It is the Complainant’s contention that passive holding of a domain name containing a mark with a reputation can be bad faith registration and use: Capital One Financial Corp. v. haimin xu, FA 1819364 (FORUM Jan. 8, 2019).

(c) The Complainant submits that given Complainant’s long-standing use and registrations of the Moody’s Marks, and the fact that the Disputed Domain Name is virtually identical to Complainant’s Moody’s Marks, there is no question that the Respondent had knowledge of Complainant’s rights in the MOODY’S Marks when the Respondent registered the Disputed Domain Name at issue. By registering the domain name with knowledge of Complainant’s rights in the Moody’s Marks, Respondent acted in bad faith (See Helen of Troy Limited v. Intermedia Studio Limited, HKIAC Case No. DHK-1800186 (26 July 2018); Guess?, Inc. v. Kristopher-Kent Harris, HKIAC Case No. DHK-1400111 (27 Nov. 2014); HUGO BOSS Trademark Management GmbH & Co., KG and Hugo Boss AG v. Dan Thurston, FA 1706001734085 (FORUM Jun. 29, 2017); The Cannon Foundation, Inc. v. John Bonk / Land Merchandising Corp., FA 1705001733159 (FORUM Jun. 22, 2017).
(d) Finally, the Complainant avers that the Respondent’s WHOIS contact e-mail (domainjet@foxmail.com) is connected to an extensive list of other domain registrations that are, like Complainant’s mark, famous and well-known trademarks to which Respondent has no apparent ownership rights. A list of the domains with ‘domainjet@foxmail.com’ as the WHOIS contact e-mail is attached as Exhibit 7 to the Complaint. In addition, a sampling of (i) legitimate websites, followed by (ii) Respondent’s infringing domains, then (iii) the WHOIS data for each site is attached as Exhibit 8 to the Complaint. The Complainant argues that this evidence establishes a pattern of serial cybersquatting and, as a result, presumptive bad faith on the part of Respondent (See Alibaba Group Holding Limited v. DOMAIN NETWORK LIMITED / ALEXANDER CHEN, HKIAC Case No. DHK-1700151 (7 Dec. 2017) (finding bad faith where “it is apparent that Respondent is a serial ‘cybersquatter’ who targets famous marks”).

(e) Accordingly, the Complainant submits that the Panel should find that Respondent has registered and used the disputed domain in bad faith, and that Complainant has satisfied the third element under the Policy.

Based upon the above submissions, the Complainant asks that the Disputed Domain Name be transferred to the Complainant.

B. The Respondent

The Respondent did not respond to the Complaint.

5. Discussion and Findings by the Arbitration Panel

According to Paragraph 4(a) of the Policy, 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.

The Arbitration Panel will make its findings in the paragraphs below.
(1) Identical/confusing similarity

The first question that arises for determination is whether the Complainant has a trademark or service mark in Hong Kong on which it can rely.

Based on the documentary evidence in Exhibit 5 to the Complaint, the Arbitration Panel finds that the Complaint is the registered owner of the following “Moody’s Marks”, the trademarks registered in Hong Kong:

<table>
<thead>
<tr>
<th>Registration No.</th>
<th>Mark</th>
<th>Class</th>
<th>Date of Registration</th>
</tr>
</thead>
<tbody>
<tr>
<td>1993B02978</td>
<td>MOODY’S</td>
<td>16</td>
<td>18/8/1988</td>
</tr>
<tr>
<td>1994B01214</td>
<td>MOODY’S</td>
<td>36</td>
<td>02/03/1992</td>
</tr>
</tbody>
</table>

The second question that arises for determination is whether the Disputed Domain Name may be said to be identical or confusingly similar to the Complainant’s Moody’s Marks that the Complainant has rights. Obviously, the Disputed Domain Name contains the entire word “MOODY’S” of the Complainant’s Moody’s Marks as its only distinctive component, and it is identical to the Complainant’s registered Moody’s Marks. It is established that the suffix “.hk” can be ignored in making this determination. The Arbitration Panel therefore finds that the Disputed Domain Name is identical to the Complainant’s registered Hong Kong trademarks “MOODY’S” of which the Complainant has rights.

Based on the above findings, the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

(2) Rights or Legitimate Interests of Respondent

As stated in paragraph 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), once a complainant establishes a prima facie case in respect of the lack of rights or legitimate interests of a respondent, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied Paragraph 4(a)(ii) of the Policy.

Based on the statements and documents submitted with the Complaint, the Arbitration Panel finds that a prima facie case has been made out by the Complainant that the Respondent lacks any rights or legitimate interests in the Disputed Domain Name.
Paragraph 4(d) of the Policy provides as follows:

"Any of the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be proven based on its evaluation of all evidence presented to it, shall demonstrate the Registrant’s rights or legitimate interests to the Domain Name for purposes of Paragraph 4(a)(ii):

(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 organization) 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 responded to the Complaint.

Having considered all the evidence presented, and the statements made in the submissions by the Complainant, the Arbitration Panel finds none of the circumstances in paragraph 4(d) existed. As such, the Arbitration Panel concludes that the prima facie case that the Respondent lacks any rights and legitimate interests in the Disputed Domain Name has not been rebutted.

Accordingly, the Complainant has satisfied the requirement of paragraph 4(a)(ii) of the Policy.

(3) **Bad Faith**
In order to establish bad faith for the purposes of the Policy, the Complainant must show that the Disputed Domain Name was registered in bad faith and has been used in bad faith.

Paragraph 4(b) of the Policy provides:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be present, shall be evidence of the registration and use of a 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.”

However, these criteria are not exclusive and the Complainant may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to all the relevant circumstances and documentary evidence in the present case and after taking into consideration the aforesaid principles, the Arbitration Panel accepts the Complainant’s submission and finds that the Disputed Domain Name was registered and had been used in bad faith for the following reasons.

(a) The Complainant has registered the “MOODY’S” trademarks in Hong Kong since 1993/1994, long before the registration of the Disputed Domain Name by the Respondent in 2018. On the evidence presented, the Arbitration Panel is satisfied that Moody’s Marks are well-known in the global capital market. It could not be a sheer coincidence that the Respondent had chosen the word
“moodys” for the registration of the Disputed Domain Name without any knowledge of Moody’s Marks. On a totality of all the relevant evidence and circumstances of the present case, it can be irresistibly inferred that by taking the Complainant’s globally well-known Moody’s Marks for registration of the Disputed Domain Name, it is bad faith registration and use of the Disputed Domain Name by the Respondent.

(b) Exhibit 6 to the Complaint clearly shows that the Disputed Domain Name resolves to a web page that offers pay-per-click advertisements to generate income with an offer that the domain was “for sale by its owner”. The Panel accepts the Complainant’s submission that outright offers of a domain that incorporates another’s mark for sale can establish that the domain was registered and being used in bad faith. This Exhibit 6 also shows that there was no active use by the Respondent of the Disputed Domain Name. It has generally been accepted by panelists that the apparent lack of so-called active use of the domain name (passive holding) does not prevent a finding of bad faith (See WIPO Overview 3.0, paragraph 3.2).

(c) It is obvious from the evidence contained in Exhibits 7 and 8 to the Complaint that the Respondent was engaging in the conduct of serial cybersquatting and that establishes presumptive bad faith on the part of Respondent in registering and using the Disputed Domain Name.

Based on the above reasons, the Arbitration Panel finds that that Respondent has registered and used the Disputed Domain Name in bad faith under paragraph 4(b)(i) and (ii); and within the generally accepted meaning of bad faith registration and use of a domain name.

Accordingly, the Complainant has satisfied the requirement of paragraph 4(a)(iii) of the Policy.

(4) **Registration requirements for that individual category of domain name**

As the Disputed Domain Name is not a 個人.hk domain name as referred to in Paragraph 4(c) of the Policy, Paragraph 4(a)(iv) of the Policy is therefore not applicable.

For all the reasons aforesaid, the Arbitration Panel concludes that the Complainant has satisfied all the requirements under Paragraph 4(a) of the Policy.

(5) **Eligibility Requirements under the Registration Policies**

In addition to Paragraph 4(a) of the Policy, the Arbitration Panel has also considered the eligibility requirements under paragraph 3 of the Domain Name Registration Policies, Procedures and Guidelines for .hk and 香港 domain names (the “Registration Policies”) issued by HKIRC effective from 22 February 2011.
The Disputed Domain Name <moodys.hk> is a second level domain name, under paragraph 3.4 of the Registration Policies it is registrable by “all interested … entities” irrespective of the place of incorporation or registration of such entity as provided, for instance, in paragraph 3.6 of the Registration Policies.

On this basis, the Arbitration Panel considers that prima facie, the Complainant meets the eligibility requirements under the Registration Policies as a registrant of the Disputed Domain Name if an award is made in its favour in these proceedings.

6. AWARD

For all the foregoing reasons, in accordance with paragraphs 4(a) of the Policy and Paragraph 15(a) of the Rules, the Arbitration Panel AWARDS, ORDERS AND DIRECTS that Disputed Domain Name <moodys.hk> be transferred to the Complainant.

Date of Issue: 24 August 2019

Place of arbitration: Hong Kong SAR

Raymond HO
Sole Panelist of the Arbitral Tribunal