1. The Parties and Contested Domain Name

The Complainant is ALPARGATAS S.A. whose registered office is situated at Av. das Nações Unidas, 14261, Conj 1001A - Ala A1, CEP: 04.794-000, Vila Gertrudes, São Paulo - SP, Brazil; and its authorized representatives in this matter are Luiza Duarte Pereira, Lucas Muinos and Maria Eduarda Dib Barreto whose address is situate at Rua Dezenove de Fevereiro, 30, 5 º andar, Botafogo, CEP: 22280-030, Rio de Janeiro, RJ, Brazil.

The Respondent is Liqun Wang whose address is situated at Chendan Zhen Wuxian Cun 174, Zip: 338000, Xinyu, China.

The domain name at issue is <HAVAIANAS.HK> (the “Disputed Domain Name”) registered with 1API GmbH (the “Registrar”) whose address is situated at Im Oberen Werk 1 66386 St. Ingbert, Germany.
2. Procedural History

On 18 July 2020, Hong Kong International Arbitration Centre ("HKIAC") received a complaint (which was subsequently amended on 12 August 2020) (the “Complaint”) filed by the Complainant pursuant to the Domain Name Dispute Resolution Policy for .hk and 香港 domain names (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 effective from 15 July 2020, and the HKIAC Supplemental Rules for HKIRC Domain Name Dispute Resolution Policy ("Supplemental Rules"), effective from 15 July 2020.

On 22 July 2020, 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 email of 30 July 2020, 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 20 August 2020, 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 9 September 2020, 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 11 September 2020, HKIAC issued a notification of the Respondent in Default.

On 12 September 2020, HKIAC appointed Mr. Raymond HO as the sole Panelist of the Arbitration Panel in this matter. The said sole Panelist has, 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 traditional Brazilian company established in 1907 dedicated to the manufacture and sale of footwear. Its brand “HAVAIANAS” has been registered as a trademark since 1970; and the Brazilian Patent and Trademark Office has, under Article 125 of the Brazilian Industrial Property Law, granted special protection to the HAVAIANAS trademark. The Complainant holds trademark registrations for its brand “HAVAIANAS” worldwide in more than 30 countries and territories, including Hong Kong. The Complainant has also relied on the Internet to advertise and sell its HAVAIANAS goods; and has registered and used domain names bearing its HAVAIANAS mark, including <HAVAIANAS.COM>, <HAVAIANAS.COM.BR>, <HAVAIANAS.COM.HK>, <HAVAIANAS.CN> and <HAVAIANAS.JP>.

The Respondent, based in China, has registered the Disputed Domain Name <HAVAIANAS.HK> on 14 March 2020 for a duration of one year. At the date of this Award, the Disputed Domain Name resolved to a parking page offering with several links with heading: “This website is for sale!” At the foot of the parking page, it states that the webpage was generated by using Sedo Domain Parking (“Sedo”).

4. Parties’ Contentions

A. The Complainant

The Complainant’s contentions are as follows:

i. The Registrant’s Domain Name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights:

a) It is the Complainant’s case that the Disputed Domain Name reproduces the Complainant’s famous HAVAIANAS mark, which is distinctive and well-known and, as such, should be afforded a wide scope of protection.

b) In addition, the Complainant avers that the Complainant is using its domain name <HAVAIANAS.COM.HK> as the official HAVAIANAS online store in Hong Kong; and has
also registered other domain names bearing the HAVAIANAS mark, such as <HAVAIANAS.COM>, <HAVAIANAS.COM.BR>, <HAVAIANAS.JP> and <HAVAIANAS.CN>.

c) As evidenced by the comparison above, the Complainant submits that the Disputed Domain Name reproduces HAVAIANAS mark and is identical to Complainant’s several domain name registrations.

d) In a quick search on Google website, when typing HAVAIANAS.HK, the site suggests that the user is looking for HAVAIANAS.COM, as shown on the screen-print of such a search reproduced in the Complainant.

e) The Complainant contends that Internet users are likely to type in the Disputed Domain Name when seeking HAVAIANAS’ online stores or may reasonably assume that the Disputed Domain Name is HAVAIANAS’ official website or at least sponsored by or affiliated with the Complainant.

f) In Chanel v. KANG ZHANG, Case ID DHK-1100069, it was decided that:

“(...) the domain name chanel.hk is identical to Complainant's registered CHANEL mark. (..) that the domain name registered by Respondent is identical to the mark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name at issue, and that the Respondent's domain name has been registered and is being used in bad faith.”


g) Furthermore, in Adidas-Salomon AG v. Chan Ma Lee, HKIAC's Case ID DHK-0400004, it was found that

“(...) The Complainant has provided substantial evidence of its right in the mark “Adidas.” I have been provided with evidence of the trademark registrations for Adidas held by the Complainant worldwide, some of which date back to the 1950’s. I have in particular been provided with documentary evidence of the Certificates of Registration in Hong Kong under the Trademarks Ordinance and that the marks have been registered for many years. I find that the domain name registered by the Respondent is identical to the registered trademark of the Complainant in which the Complainant has long established rights.”

h) The Complainant therefore submits that based on the above comparison between Complainant’s mark HAVAIANAS, its several domain names and the Disputed Domain
Name, as well as on the prior decisions rendered by HKIAC, it is possible to ascertain that the Disputed Domain Name is identical to Complainant’s mark HAVAIANAS, registered around the world, including Hong Kong.

ii. The Registrant has no rights or legitimate interests in respect of the Domain Name:

a) The Complainant avers that the Complainant has never authorized the Respondent to register the Disputed Domain Name, nor was there any licensing or business relationship with the Respondent.

b) The Complainant stresses that Disputed Domain Name is a parking page offering several pay-per-click links that lead consumers into third parties’ websites to buy similar products as shown on the screen-print reproduced in the Complaint.

c) The Complainant admits that HAVAIANAS is a dictionary word, meaning “Hawaiian” in Portuguese, but panels have recognized that this fact itself does not confer rights or legitimate interests to the Respondent. According to Section 2.10 of WIPO Overview:

“(…) For example, a hypothetical respondent may well have a legitimate interest in the domain name <orange.com> if it uses the domain name for a website providing information about the fruit or the color orange. The same respondent would not however have a legitimate interest in the domain name if the corresponding website is aimed at goods or services that target a third-party trademark (in this example: Orange, well-known inter alia for telecommunications and Internet services) which uses the same term as a trademark in a non-dictionary sense”.

d) In Instagram, LLC v. Zafer Demir, Yok, WIPO case No. D2019-1072, it was decided that “once a complainant has made a prima facie showing that a registrant does not have rights or legitimate interests in a domain name, the burden shifts to the respondent to provide evidence of its rights or interests”.

e) In this specific case, the Complainant submits that Respondent has no rights or legitimate claims over the Disputed Domain Name, as it does not use the Disputed Domain Name to provide content related to the meaning of the term HAVAIANAS, but to Complainant’s trademark.

f) Nevertheless, the Complainant adds that Respondent does not meet any of the requirements set forth in Paragraph 4(d) of the Policy:

• Policy’s Paragraph 4(d)(i) – bona fide offering of goods or services in Hong Kong:

  a) Respondents in a HKIAC case may indicate their legitimate interests in a domain name as long that *bona fide* offering of goods or services through the domain name is established in Hong Kong. However, this is not the case, since (i) there is no relationship whatsoever between Respondent and Complainant; and (ii) the Disputed Domain Name was never actually used by the Respondent since it has been used as a parking page offering *pay-per-click* links.

  b) Since the Disputed Domain Name has been used to identify *pay-per-click* pages, it is not possible to affirm that the Respondent has intent to bona fide offer goods and services, even if it demonstrates preparations for developing a website.

  c) Furthermore, according to the standards articulated in Oki Data Americas, Inc v. ASD, Inc, WIPO Case No. D2001-0903, the offering must meet the following minimum requirements in order to be considered in *bona fide*: “(...) (i) actually be offering the goods or services at issue; (ii) use the website only to sell the trademarked goods; (iii) accurately disclose the respondent’s relationship with the trademark owner; it should not falsely suggest that it is that of the trademark owner, or that it is the official site; and (iv) not try to corner the market in domain names pertaining to the trademark.”

  d) Thus, the Complainant submits that the Respondent fails all the four tests.

• Policy’s Paragraph 4(d)(ii) – commonly known by the domain name, even if the Registrant has acquired no trade mark or service mark rights in Hong Kong:
a) The Disputed Domain Name was registered 14 years after Complainant obtained exclusive rights over HAVAIANAS mark in Hong Kong, and more than 11 years after Complainant registered the domain name <HAVAIANAS.COM.HK>.

b) Therefore, it is impossible to suggest that Respondent is commonly known by the Disputed Domain Name, since it refers to Complainant’s mark in its domain with pay-per-click links that redirect to third-parties’ websites, attempting to divert consumers.

- Policy’s Paragraph 4(d)(iii) – the Registrant has trademark or service mark rights that the mark is identical to the Domain Name the Registrant is holding

a) According to a quick search on Hong Kong’s Trademark Office’s database (https://esearch.ipd.gov.hk/nis-pos-view/tm#/quicksearch), the only trademarks composed by HAVAIANAS registered in Hong Kong are owned by the Complainant.

b) Considering that the Respondent does not own any trademark registration composed by HAVAIANAS, it does not have any rights over the Disputed Domain Name.

- Policy’s Paragraph 4(d)(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:

a) The Complainant contends that the Respondent has carefully chosen the Disputed Domain Name because it was aware of the well-known trademark HAVAIANAS and that many users would deem it as Havaianas’ official website in Hong Kong or related to Complainant.

b) Considering that the Disputed Domain Name may lead consumers to think that it is an official website of the Complainant, the Complainant submits that the Disputed Domain Name is not being in fair use.

- Policy’s Paragraph 4(d)(v) – the Domain Name is composed by the Respondent’s individual name, legal name or a name/pseudonym by which Respondent is commonly known:
a) As detailed above, the term HAVAIANAS consists of Complainant’s globally well-known mark. It also has a dictionary meaning, since it refers to “Hawaiian” in Portuguese.

b) However, according to the “WHOIS” information of the Disputed Domain Name, it is not possible to imply that Respondent has an individual name also composed by the term HAVAIANAS, or is legally known by the name/pseudonym HAVAIANAS, especially because the Disputed Domain Name has not been used to display any information regarding Respondent.

c) Based on all the above considerations, the Complainant contends that the reproduction of Complainant’s mark in a domain name supports a finding that Respondent’s uses are not (a) bona fide offering of goods or services; nor (b) non-commercial or fair use of the Disputed Domain Name.

iii. The domain name was registered and is being used in bad faith:

a) The Complainant avers that HAVAIANAS is a world-famous mark and widely advertised in Hong Kong and several other territories; and submits that the Respondent has acted in bad faith by registering the Disputed Domain Name thereby preventing Complainant from registering it.

b) The Complainant contends that by using the Disputed Domain Name, the Respondent has intentionally attempted to attract for commercial gain Internet users to Respondent’s website, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website. The “HAVAIANAS” name at the top of the homepage demonstrates that the Respondent is attempting to confuse Complainant’s consumers.

c) Regarding this matter, it was decided in WIPO Case No. D2014-0548 that:

“(…) the disputed domain name is not being currently used with an online website, which constitutes "passive holding", which may also, in certain circumstances, constitute evidence of bad faith use. (…) Some panels have also found that the concept
of passive holding may apply even in the event of sporadic use, or of the mere “parking” by a third party of a domain name (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).”

d) Also, the offer of pay-per-click links redirecting consumers to third parties’ websites offering for sale footwear and apparel is considered bad faith, since it evidences the commercial gain intending to create likelihood of confusion with the Complaint’s mark: Section 3.1.4, a) of WIPO Overview 3.0:

“Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark: (...) (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the complainant’s (or a competitor’s) website, and (vi) absence of any conceivable good faith use.”

e) When analyzing this issue, it was found in WIPO Case No. D2015-2103 that:

“(…) the Respondent must have been aware of the Complainant’s existence and rights when it registered the Domain Name. This is emphasized by the fact that the Domain Name is being used as a parking page with pay-per-click links. (…) This behavior of the Respondent fits the example of paragraph 4(b)(iv) of the Policy, i.e., that by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant’s mark.”

f) Even if the pay-per-click material is generated “automatically” in a domain name, this does not prevent the finding of the Respondent’s bad faith: Section 3.5 of WIPO Overview 3.0:

“Particularly with respect to “automatically” generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests)”.
g) Furthermore, pursuant to Paragraph 4 (b) of the Policy, bad faith use and registration may also be established when:

“(…) 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”.

h) In this sense, the Complainant submits that it was found in HKIAC Case DHK-1300092 that:

“(…) his stated willingness to sell the Disputed Domain Name for what he termed a high price, and his awareness that he was dealing ultimately with the holder of the trademark GMAIL, the Panel finds on the balance of probabilities that the Respondent’s primary intention was to sell the Disputed Domain Name profitably to the Complainant. The Panel finds the Respondent’s actions to constitute registration in bad faith and use in bad faith within the meaning of Paragraphs 4(b)(i) and 4(a)(iii) of the Policy.”

i) When analysing this issue, it was found in HKIAC Case No. DHK-1000060 that:

“(…) The Complainant’s trademark BARBIE was registered and widely known and used in Hong Kong many years before the domain name was registered. The only explanation of what has happened is that the Respondent’s motive in registering and using the sites seems to be, as the Complaint says, simply to disrupt the Complainant’s relationship with its customers or potential customers, attempt to attract Internet users for potential gain or persuade the Complainant to buy the domain name from it for an amount in excess of the Respondent’s out-of-pocket expenses. These all constitute evidence of registration and use in bad faith: paragraph 4(b) of the Policy.”

j) The Complainant shows in evidence that the Complainant has tried to obtain the Disputed Domain Name from the Respondent through Sedo; and the initial offer for its sale was USD 8,500.
k) As the Complainant did not accept this offer, the evidence shows that the Respondent made a counteroffer for sale of the Disputed Domain Name at USD 5,999.

l) The Complainant submits that these offers demonstrate that the main reason for registering the Disputed Domain Name is to pursue the Complainant to buy it under an extremely high price, to obtain profit from the Complainant.

m) Additionally, it is not the first time that the Respondent has registered a domain name composed by a famous trademark, since it was also a contested party recently before HKIAC in Case No. DHK-1900163 (Puma SE v. Wang Liqun). The panel in that case considered that the high price of the offer is sufficient for demonstrating the Respondent’s bad faith:

“In the present case, passive holding of the Disputed Domain Name by the Respondent coupled with the Respondent’s “best offer” of US$ 6,999 for the transfer of the Disputed Domain Name to the Complainant that is well in excess of reasonable out-of-pocket costs directly related to its registration, are enough in the view of the Arbitration Panel to characterize bad faith registration and use of the Disputed Domain Name by the Respondent.”

n) As set in Case No. DNL2016-0054 (Glashütter Uhrenbetrieb GmbH v. Wang Liqun):

“This commercial intent is further confirmed by the circumstance that Respondent tried to sell the Domain Name to Complainant for a price far in excess of the registration cost. Complainant also asserts that Respondent is engaged in a pattern of cybersquatting conduct, which was demonstrated in several earlier Uniform Domain Name Dispute Resolution Policy (“UDRP”) and Uniform Rapid Suspension System (“URS”) cases which were brought against Respondent. (...) Moreover, the Panel agrees with Complainant’s assertion that the above cybersquatting circumstances are apparently part of a pattern of conduct by Respondent. Considering the assertions and exhibits put forward by Complainant, the Panel agrees that there seems to be a link between Respondent and certain named parties in other UDRP and URS. The Panel finds it likely that Respondent is indeed one and the same party in all these cases.”

o) Based on all the above, the Complainant submits that the Disputed Domain Name was registered and/or is being used in bad faith by the Respondent, since
(i) HAVAIANAS.HK reproduces the famous mark HAVAIANAS.

(ii) Respondent’s bad faith action to offer the Disputed Domain Name for sale for a high amount prevents Complainant from registering the Domain Name that is formed by its famous mark.

(iii) Respondent’s lack of use of the Disputed Domain Name for its own content constitutes a passive holding in bad faith due to the circumstances surrounding this case, especially because it consists exclusively of a parking page offering pay-per-click links redirecting consumers to third parties’ websites. Thus, the Respondent is engaged in cybersquatting conduct by registering of famous trademarks in domain names, which demonstrates bad faith in its behaviour.

Based on all the aforesaid reasons in the Complainant’s contention, the Complainant seeks an order 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

Preliminary issues

Paragraph 14 of the Rules provides that (a) in the event that a Party, in the absence of exceptional circumstances as determined by the Arbitration Panel in its sole discretion, does not comply with any of the time periods established by the Rules, the Supplemental Rules or the Arbitration Panel, the Arbitration Panel shall proceed to a decision on the Complaint; and (b) if a Party, in the absence of exceptional circumstances as determined by an Arbitration Panel in its sole discretion, does not comply with any provision of, or requirement under the Rules, the Supplemental Rules or any request from an Arbitration Panel, the Arbitration Panel may draw such inferences therefrom as it considers appropriate.

On the evidence contained in the case file of this matter, the Arbitration Panel is
satisfied that the NCP of the Complaint was duly served on the Respondent by HKIAC in accordance with the Policy, the Rules and the Supplementary Rules.

Based on the confirmation given by the Registrar, the Arbitration Panel finds that the language of the proceedings in this matter is English.

In accordance with Paragraph 15(a) of the Rules, the Arbitration Panel shall decide the Complaint on the basis of the statements and documents submitted to it and in accordance with the Policy, the Rules, the Supplemental Rules, the eligibility requirements of the relevant Domain Name Category and the law which the Arbitration Panel deems applicable.

**Substantive issues**

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

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 undisputed documents in respect of the Complainant’s HAVAIANAS trademark as exhibited to the Complaint, and the search on Hong Kong’s Trademark Office’s database (https://esearch.ipd.gov.hk/nis-pos-view/tm#/quicksearch), the Arbitration Panel finds that the Complaint is the registered holder of the following HAVAIANAS trademarks registered in Hong Kong prior to the registration of the Disputed Domain Name in 2020:

<table>
<thead>
<tr>
<th>Number</th>
<th>Granting Date DD/MM/YYYY</th>
<th>Mark</th>
<th>Class / Goods</th>
</tr>
</thead>
<tbody>
<tr>
<td>300437562</td>
<td>18/07/2006</td>
<td>HAVAIANAS (word mark)</td>
<td>25 – Clothing in general, shorts, jackets, Bermuda, knickers, T-shirts, sportswear, jogging suits, dresses, sweat pants, sweat shirts, stockings, cap, socks, stockings in general, underpants, uniforms, polo shirts, social shirt, social pants, sports pants, bikinis, body, long skirts, short skirts, sunshades, hats, overcoat, coat, suit, blazers, parkas; footwear in general, tennis shoes, sports shoes, shoes for practicing sports, soccer shoes, boots for practicing sports, boots in general, ankle boots, gymnastics shoes, bathing sandals, bathing thongs, sandals and social shoes.</td>
</tr>
<tr>
<td>300894925</td>
<td>12/12/2007</td>
<td>HAVAIANAS (word mark)</td>
<td>18 – Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</td>
</tr>
<tr>
<td>303483955</td>
<td>05/02/2016</td>
<td>HAVAIANAS (word mark)</td>
<td>09 – Cell phone cases; spectacle frames; eyeglass cords; eyeglass chains; eyeglass cases; spectacle lenses; anti-glare glasses;</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 trademark of which the Complainant has rights. Obviously, the Disputed Domain Name contains the entire word “HAVAIANAS” of the Complainant’s trademark as its only distinctive component, and it is identical to the Complainant’s registered Hong Kong trademarks to which the Complainant has rights. It is established that the suffix “.hk” can be ignored in making this determination. The Arbitration Panel therefore concludes that the Disputed Domain Name is identical to the Complainant’s registered Hong Kong trademarks 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.

The Respondent did not respond to the Complaint.

Given that HAVAIANAS has a dictionary meaning of “Hawaiian” in Portuguese, could that confer a right or legitimate interest for the Respondent to register the Disputed Domain Name? The Arbitration Panel does not think so and agrees with the Complainant that this fact itself does not confer rights or legitimate interests to the Respondent. The example of the hypothetical respondent referred to in Section 2.10 of WIPO Overview 3.0 illustrates very well this point:

“(…) For example, a hypothetical respondent may well have a legitimate interest in the domain name <orange.com> if it uses the domain name for a website providing...
information about the fruit or the color orange. The same respondent would not however have a legitimate interest in the domain name if the corresponding website is aimed at goods or services that target a third-party trademark (in this example: Orange, well-known inter alia for telecommunications and Internet services) which uses the same term as a trademark in a non-dictionary sense“.

In the present case, it is evident that the Disputed Domain Name has been resolved to a parking webpage generated by Sedo patently offering the website for sale with a few pay-per-click links to footwear products. It is a form of passive holding of a domain name that targets at the Complainant’s “HAVAIANAS” trademark; and as such the Respondent could not have any legitimate interest in the Disputed Domain Name.

Based upon the statements, documents and submissions in the Complaint, the Arbitration Panel finds that a prima facie case has been made out 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.”

Having carefully considered all the documentary evidence, statements of facts and submissions presented by the Complainant, the Arbitration Panel has no difficulty to conclude that 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 by the Respondent for the following reasons.

(a) The Complainant has registered its “HAVAIANAS” trademark in many countries and territories including Hong Kong long before the registration of the Disputed Domain Name by the Respondent in March 2020.

(b) Under Article 125 of the Brazilian Industrial Property Law – Law No. 9.279/96, “a mark that is registered in Brazil and considered to be high-renown shall be assured special protection in all branches of activity”. Evidently, the Complainant’s “HAVAIANAS” trademark is considered “high-renown”; and given its long history of use in footwear products across the globe, the “HAVAIANAS” mark is probably well-known among consumers of footwear in Hong Kong. It can reasonably be inferred that the Respondent was well aware of the Complainant’s “HAVAIANAS” brand at the time of registering the Disputed Domain Name for a short duration of one year on 14 March 2020.
(c) As can be clearly seen from the parking webpage to which the Disputed Domain Name was resolved, it is not being actively used for any online business except a few pay-per-click links redirecting consumers to third parties’ websites offering for sale footwear; and as such it demonstrates the intention of creating a likelihood of confusion with the Complaint’s “HAVAIANAS” mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website without any disclaimer.

(d) The counteroffer price of USD 5,999 by the Respondent for the sale of the Disputed Domain Name is evidence that the Respondent has registered the Disputed Domain Name primarily for the purpose of selling or otherwise transferring its registration to the Complainant far in excess of the related out-of-pocket costs and expenses.

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 (iv) 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 15 July 2020, the Disputed Domain Name <HAVAIANAS.HK> is a second level domain name; and 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 <HAVAIANAS.HK> be transferred to the Complainant.

Date of Issue: 22 September 2020

Place of arbitration: Hong Kong

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Raymond HO
Sole Panelist of the Arbitration Panel