1. Parties and Contested Domain Name

The Complainant is Yageo Corporation (hereinafter referred to as the “Complainant”) of New Taipei City, Taiwan.

The Respondent is Yang ShuHua (hereinafter referred to as the “Respondent”) of Guangdong Province, China.

The Complainant and the Respondent are hereinafter referred to collectively from time to time as the “Parties”.

The domain name at issue is <yageo.hk> (hereinafter referred to as “Disputed Domain Name”), registered by the Respondent with 1API GmbH (“the Registrar”) of Germany.
2. **Procedural History**

On 1 December 2020, pursuant to the Hong Kong Internet Registration Corporation Limited ("HKIRC") Domain Name Dispute Resolution Policy ("Policy"), the Domain Name Dispute Resolution Policy Rules of Procedure ("Rules") and the Hong Kong International Arbitration Centre Supplemental Rules ("Supplemental Rules"), the Complainant submitted a Complaint (including annexes) in the English language to the Hong Kong International Arbitration Centre ("HKIAC"), and elected to have the case in question be dealt with by a Panelist ("One Panelist").

On 1 December 2020, the HKIAC wrote to the Complainant acknowledging receipt of the Complaint.

On the same day, the HKIAC wrote to the Registrar a request for register verification in connection with the Disputed Domain Name.

On 2 December 2020, the Registrar informed the HKIAC its verification response disclosing the registrant information for the Disputed Domain Name which differed from the information in the Complaint.

On 7 December 2020, the HKIAC wrote to the Complainant, providing the registrant information for the Disputed Domain Name disclosed by the Registrar and invited the Complainant to submit an amended Complaint.

On 8 December 2020, the Complainant submitted the amended Complaint to the HKIAC.
On the same day, the HKIAC verified that the Complaint satisfies the formal requirements of the HKIRC Policy, the HKIRC Rules and the HKIAC Supplemental Rules.

In accordance with the HKIRC Rules, the HKIAC formally notified the Respondent of the Complaint and the proceedings commenced on 8 December 2020. In accordance with the HKIRC Rules, the due date for the Response from the Respondent was 28 December 2020.

On 17 December 2020, the HKIAC wrote to the Complainant confirmed having received the case filing fee for the case in question.

No Response from the Respondent was received by the HKIAC on 29 December 2020 and as such, the Respondent is in default.

The HKIAC appointed Dr. Christopher To as the Panelist in this matter on 31 December 2020.

The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

In accordance with Rule 15(a) of the HKIRC Rules, the Panel is of the view that it shall decide the Complaint on the basis of statements and documents submitted to it.
According to Rule 15(d) of the HKIRC Rules and Section 67 of the Hong Kong Arbitration Ordinance (Cap. 609) of the laws of the Hong Kong Special Administrative Region of the People’s Republic of China, this Panel shall issue a reasoned award.

3. Factual Background

For the Complainant

The Complainant is a leading global electronic component company founded in 1977, having 47 sales offices, 42 manufacturing sites and 15 research and development centers worldwide including China, Hong Kong Special Administrative Region of the People’s Republic of China (hereinafter referred to as “Hong Kong”), Hungary, Italy, Japan, Malaysia, Singapore, South Korea, Taiwan (being its headquarters) and United States of America.

The Complainant products target key vertical markets, including applications for consumer electronics, industrial, telecommunications, power & energy, internet of things, and automotive & transportation. The Complainant is globally ranked as the world’s number 1 in chip-resistors and number 3 in multi-layer ceramic capacitors

Since October 1993, the Complainant has been listed on the Stock Exchange of Taiwan.

In 2019, the Complainant had a total net profit of approximately Hong Kong Dollars 1.89 billion.
The Complainant has registered numerous trademarks comprising of or incorporating the “YAGEO” trade mark (collectively referred to as “YAGEO Trade Marks”) in the major jurisdictions, including but not limited to registrations in Australia, Brazil, China, the European Union, Hong Kong, Israel, Japan, Malaysia, Singapore, South Korea, Switzerland, Taiwan, Turkey and the United States of America.

The earliest YAGEO trade mark registered in Hong Kong was dated 7 July 1993. As a result of the extensive and long-standing use of the YAGEO Trade Marks by the Complainant (and its affiliates), the YAGEO Trade Marks have acquired distinctiveness and strong reputation and goodwill worldwide (including Hong Kong), so that the YAGEO Trade Marks are immediately recognizable to consumers as being associated with the Complainant, its affiliates and its businesses.

The Complainant (or its affiliates) has registered and maintains various domain names through which the general public across the world (including Hong Kong) may obtain information about the Complainant’s business. The registration dates of some of the domain names predate the registration date of the Disputed Domain Name (i.e. 18 October 2018) by at least 8 months and up to 35 years.

For the Respondent

The Respondent is an individual from Guangdong Provision, China.

The Disputed Domain Name

The Disputed Domain Name was registered on 18 October 2018.
4. The Parties’ Contention

For the Complainant

The Complainant made the following submissions in the Complaint:

The Disputed Domain Name <yageo.hk> incorporates the Complainant’s YAGEO Trade Marks (including the YAGEO Trade Marks registered in Hong Kong) in its entirety together with the country code top-level domain (“ccTLD”) “.hk”. As such, the Complainant submits that the Disputed Domain Name is identical and/or confusingly similar to its registered trademarks in Hong Kong in which the Complainant has rights.

The Respondent registered the Disputed Domain Name on 18 October 2018 at least 42 years after the YAGEO Trade Marks were first used by the Complainant in 1977.

The Complainant has not licensed, consented to or otherwise authorized the Respondent’s use of any of its YAGEO Trade Marks for the Disputed Domain Name.

The Complainant’s YAGEO Trade Marks have acquired substantial goodwill and reputation worldwide and in Hong Kong.

The Complainant submits that it has established a “prima facie” case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

The Complainant asserts that, the Respondent’s incorporation of the Complainant’s
YAGEO Trade Marks in the Disputed Domain Name and the Respondent’s use of the Disputed Domain Name in connection with a website (the “Respondent’s Website”) that sells/trades Yageo-branded products in the name of “Yageo” and “Yageo Corporation”, without the Complainant’s consent is a calculated attempt to mislead internet users into believing that Respondent's Website belongs to or is otherwise connected/affiliated with the Complainant, which enables the Respondent to make an unfair commercial gain from illegitimately riding on the Complainant’s reputation and goodwill by passing off the Respondent’s Website as the official website in Hong Kong for the Complainant’s products thus tarnishing the Complainant’s YAGEO Trade Marks.

The Complainant advocates that the Disputed Domain Name has been registered and is being used by the Respondent in bad faith in which the Respondent has no rights or legitimate interests in the Disputed Domain Name.

As mentioned above, the Complainant’s use of YAGEO Trade Marks dates back 42 years before the registration of the Disputed Domain Name. The Respondent must have been aware of the Complainant’s business, reputation and YAGEO Trade Marks before the registration of the Disputed Domain Name.

The Respondent’s conduct in using the Complainant’s YAGEO Trade Marks in the Disputed Domain Name as well as in the Respondent’s Website is clear evidence of prior knowledge of the Complainant and its YAGEO Trade Marks. From this, the Respondent has clearly registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant which is a competitor to the Respondent thus indicating bad faith on the part of the Respondent.
Internet users when visiting the Disputed Domain Name will falsely believe that they are receiving information and service from the Complainant or its affiliates, and/or entering into transactions with the Complainant or its affiliates or under the Complainant’s authorization, in fact this is misleading, which dilutes and damages the reputation of the Complainant. As such, the Complainant contends that the Respondent has registered and is using the Disputed Domain Name in bad faith.

The Respondent in this Complaint is Yang ShuHua. There is no evidence to suggest that the Respondent has been commonly known by the Disputed Domain Name. As the Disputed Domain Name is not an “.idv.hk”/ “.個人.hk” / “.個人.香港” domain name as referred to in Paragraph 4(c) of the Policy, the Complainant contends that Paragraph 4(a)(iv) of the Policy is not applicable.

In summary, the Complainant’s contentions are as follows:

1. The Complainant is known internationally and within the Hong Kong community.
2. The Disputed Domain Name is confusingly similar to the Complainant’s YAGEO Trade Marks.
3. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.
4. The Respondent is not making a bona fide commercial use of the Disputed Domain Name as it sells/trades Yageo-branded products in the name of “Yageo” and “Yageo Corporation”, without the Complainant’s consent.
5. The Complainant has not licensed, consented to or otherwise authorized the Respondent to use its YAGEO Trade Marks in any way or form.
6. The Disputed Domain Name was registered by the Respondent on 18 October 2018, some 42 years after the YAGEO Trade Marks were first used by the Complainant in 1977.

7. The Disputed Domain Name has been registered and used in bad faith.

8. The Respondent is not commonly known by the Disputed Domain Name.

**For the Respondent**

The Respondent did not reply to the Complainant’s contentions. As such, the Respondent has not contested the allegations of the Complaint and is in default.

5. **Findings**

A. **Language of the Proceedings**

Paragraph 11(a) of the HKIRC Rules provides that:

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

In the present case, the Parties had not agreed a particular language for these proceedings.
As this is an "English .hk domain name", namely, '<yageo.hk>', then in accordance with Paragraph 11(a) of the HKIRC Rules, the proceedings "shall be in English" unless the Panel determines otherwise.

In these circumstances, the Panel considers that it would be appropriate (and without prejudice to any of the parties) for the present proceedings to be conducted in the English language in accordance with Paragraph 11(a) of the HKIRC Rules, on the basis that the Complaint was submitted in the English language and that the Respondent has not contested the Complaint. As such the Panel shall proceed to decide on the matter based on the documents submitted.

B. Discussion and Findings

Having considered all the documentary evidence before me, and the Respondent’s non-participation in these proceedings after being afforded every opportunity to do so in accordance with Paragraph 5(e) of the HKIRC Rules, the Panel is of the view that it should proceed to decide on the Disputed Domain Name, based upon the Complaint and evidence as adduced by the Complainant.

The Panel does not find it necessary to deal with each and every point raised in the written submissions. Instead, the following discussion will focus on those evidence as well as submissions that are enough to dispose of the issues in dispute. For the avoidance of doubt, the Panel wishes to reiterate that whilst all the evidence adduced and submissions made have been carefully considered by the Panel, the fact that some of the matters or issues raised have not been specially dealt with below does not mean that they have been omitted and not considered by the Panel.
Paragraph 5(e) of the Rules stipulates that:

“If a Respondent does not submit a timely Response, in the absence of exceptional circumstance as determined by the Provider at its sole discretion, the Arbitration Panel shall decide the dispute based upon the Complaint and evidence submitted therewith”

Having said so, Paragraph 4(a) of the HKIRC Policy, which is applicable hereto, the Complainant has the burden of proving the following elements, namely:

“(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; and

(ii) the Registrant has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Registrant’s 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). **Identical/confusing similarity**

Paragraph 4(a)(i) of the HKIRC Policy requires the Complainant to prove that the
Disputed Domain Name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the Complainant has rights.

The Panel finds that the Complainant has rights in the trademark acquired through use and registration in Hong Kong and globally.

The Disputed Domain Name incorporates the entirety of the trademark together with the country code top-level domain ("ccTLD") "hk". The Panel is of the view that the addition of the .hk ccTLD does not distinguish the www.yageo.hk domain name from the Complainant’s trademark. The top level domain designator “.hk” is only a necessary portion to form a particular type of domain name in Hong Kong and cannot function to distinguish that name from the Complainant’s mark.

The Disputed Domain Name is likely to cause consumers to believe that the Respondent's Website accessed through the Disputed Domain Name belongs to or is otherwise connected/affiliated with the Complainant, when in effect the Complainant has not authorized the Respondent to use the YAGEO Trade Marks. As stated previously, the Respondent has not contested the allegations of the Complaint and is in default.

For all the foregoing reasons, this Panel concludes that the Complainant has discharged its burden of proof to establish the elements of identical or confusingly similar trademark or service mark in Hong Kong as stipulated in Paragraph 4(a)(i) of the HKIRC Policy.
(2). **Rights or Legitimate Interests of the Respondent**

Paragraph 4(d) of the HKIRC Policy sets out examples of circumstances where the Respondent may have rights or legitimate interests over the Disputed Domain Name:

“How to Demonstrate the Registrant’s Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint.

When the Registrant receives a Complaint as defined in Paragraph 3 of the Rules of Procedure, the Registrant should refer to Paragraph 5 of the Rules of Procedure in determining how the Registrant’s Response should be prepared.

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 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 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 is not a licensee of or otherwise affiliated with the Complainant, and the Complainant asserts in its Complaint that it “... has not licensed, consented to or otherwise authorized the Respondent's use of any of its YAGEO Trade Marks for the Disputed Domain Name or any reason whatsoever.”

The Complainant has prior rights in the trademark which precede the Respondent’s registration of the Disputed Domain Name by “at least 42 years”. Based on the information submitted, the Panel finds that there is therefore a prima facie case that the Respondent has no rights or legitimate interests in the Disputed 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 trademark rights in respect of the Disputed Domain Name or that the Disputed Domain Name has been used in connection with a bona fide offering of goods or services in Hong Kong. As the Respondent’s Website merely “sells or otherwise trades Yageo-branded products in the name of “yageo.hk”, “YECEO” and/or “Yageo Corporation”.”.

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

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

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

(3). **Bad Faith**

Paragraph 4(b) of the HKIRC Policy sets out four (4) factors in which the Panel shall take into account in determining whether the Respondent has registered and used the Disputed Domain Name in bad faith. The prescribed four (4) factors are as follows:

“The Evidence of Registration and Use in Bad Faith

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."

In the present case, the Complainant registered the trademark in Hong Kong since 7 July 1993. It would be inconvincible for the Respondent to argue that it was unaware of the Complainant’s registered trademark at the time when the Disputed Domain Name was registered on 18 October 2018. From the submissions provided, the Panel is of the view that the Respondent has no good cause or justifiable reasoning of using the Disputed Domain Name.

The Respondent’s motive in registering the Disputed Domain Name seems to be what the Complainant is alluding to, that the Respondent is “...using the Disputed Domain Name in bad faith where it intentionally and illegitimately rides on the Complainant’s goodwill and reputation and gain unfair commercial gain by misleading Internet users into believing that the Respondent’s Website belongs to or is related to the Complainant.”.

In the Complaint, the Complainant provided the Panel with evidence [Annex 13 and 14 of the Complaint] that “...the Respondent has been making dishonest misrepresentations that it is, is part of, or connected with the Complainant by using
the Complainant’s YAGEO Trade Marks and referring to “Yageo” and “Yageo Corporation” on the Respondent’s Website...primarily for the purpose of disrupting the business of the Complainant which is a competitor to the Respondent and in bad faith.”.

Such use of the Disputed Domain Name amounts to clear evidence of bad faith. The Panel therefore finds, in all the circumstances, the requisite element of bad faith has been satisfied under paragraph 4(b) of the HKIRC Policy.

For all the foregoing reasons, the Panel concludes that the Disputed Domain Name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4 (a)(iii) of the HKIRC Policy has been fulfilled.

(4). Individual category of Domain Name

As the Respondent is not called or affiliated with the name “yageo” in any way or form, the Panel is of the view that the Respondent does not meet the registration requirements for the individual category of the domain name as per paragraph 4(a) (iv) of the HKIRC Policy.

6. Conclusion

Having carefully considered all the statements, documents, representations and submissions made by the Parties (or on behalf of the Parties), the Panel hereby renders the following decision.
The Complainant has proved its case. It has a registered trademark in the name “yageo”, to which the contested domain name is confusingly similar.

The Respondent has shown no rights or legitimate interest in the Disputed Domain Name.

The Complainant has proved that the Respondent registered and used the Disputed Domain Name in bad faith.

The Respondent does not meet the registration requirements for an individual category of the domain name.

For all the foregoing reasons and in accordance with Paragraph 4 of the HKIRC Policy, the Panel concludes that the relief requested by the Complainant be granted and do hereby order the Disputed Domain Name <yageo.hk> be transferred to the Complainant – Yageo Corporation.

Unless the Panel can be of further assistance, the Panel would like to thank the Parties, their Legal Counsel and the HKIAC for their assistance rendered to the Panel in this matter.

Dated 20 day of January 2021

In the Hong Kong Special Administrative Region of the People’s Republic of China

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Dr. Christopher To
Panelist - Arbitrator