



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Hang Seng Data Services Limited v. Liu Xiaodong

Case No. D2001-0750

1. The Parties

Complainant: Hang Seng Data Services Limited
83 Dex Voeux Road, Central
Hong Kong, PRC

Respondent: Liu Xiaodong
No. 32 Zhongchang Street
Shahekou District
Dalian, Liaoning Province
PRC

2. The Domain Name and Registrar

Domain Name: <恒生指数.com>
(RACE Language Encoding: bq- -3bqfe5i7mmdwk4a.com)

Registrar: Internet Names WorldWide

3. Procedural History

The Complaint was received by WIPO by email on June 12, 2001, and in hardcopy form on June 6, 2001. WIPO has verified that the Complaint satisfies the formal requirements of the Policy, the Rules and the Supplemental Rules and that payment was properly made. The Administrative Panel (“the Panel”) is satisfied that this is the case.

The Complaint was properly notified in accordance with the Rules, paragraph 2(a). The Registrar has confirmed that <恒生指数.com> (“the Domain Name”) was registered through Internet Names WorldWide and that Liu Xiadong is the current registrant. The Registrar has further confirmed that the Policy is applicable to the Domain Names.

On June 14, 2001, WIPO notified the Respondent of the Complaint in the usual manner and informed the Respondent *inter alia* that the last day for sending its Response to the Complainant and to WIPO was July 4, 2001. WIPO issued to the Respondent a Default Notice on July 6, 2001. No Response was received.

The Panel was properly constituted. The undersigned Panellists submitted Statements of Acceptance and Declarations of Impartiality and Independence.

No further submissions were received by WIPO or the Panel, as a consequence of which the date scheduled for the issuance of the Panel's Decision is August 20, 2001.

4. Factual Background

The Complainant is a company incorporated in Hong Kong. It maintains the well-known Hang Seng family of indices and in particular the world famous Hang Seng Index itself which was launched in 1964.

The Complainant is the registered proprietor of a large number of trade mark and service mark registrations for the name Hang Seng Index in both the English form and in its Chinese equivalent form. Examples of such registrations are:

- Hong Kong Registration No 01605 dated May 30, 1995, in respect of administration, operation and management of unit trusts relating to selected stocks listed on The Stock Exchange of Hong Kong Limited.
- The Peoples Republic of China Registration No 777580 for the provision of information relating to the stock exchange, provision of information relating to financial services.

The Complainant and its parent and associated companies are the registrants of a number of domain names featuring the name Hang Seng Index in both the English and Chinese forms. For example, Hang Seng Bank Limited is the registrant of domain name <hangsengindex.com>, which was first registered on January 11, 2000.

The Respondent registered the Domain Name on November 30, 2000.

On February 19, 2001, the Complainant's representative wrote to the Respondent drawing the Respondent's attention to the Complainant's rights in the name Hang Seng Index (both English and Chinese versions of the name), claiming that the Respondent's registration of the Domain Name infringed the Complainant's rights and inviting the Respondent to cancel the Domain Name.

As will be seen below the Complainant states that no reply was received to that letter but that subsequently the Complainant's representative telephoned the Respondent to check that the letter had been received. Apparently it had been received. The Complainant states that in the course of that telephone conversation, the Respondent made a request for a substantial sum of money before he would agree to cancel the Domain Name. The Complainant's representative indicated that the Complainant would not agree to pay any sum of money and the Respondent has not cancelled the Domain Name.

The Domain Name is not in active use.

5. Parties' Contentions

A. Complainant

The substance of the Complaint is short and reads as follows:

The Complaint is based on the Complainant's registrations for the mark “恒生指數” (Chinese equivalent of “Hang Seng Index”) in respect of various services throughout the world. A list of these registrations together with copies of some trade mark registration certificates are provided as Annex D to this Complaint. The Complainant and the Complainant's parent/associate companies have also registered, inter alia, the domain names <hangsengindex.com>, <hangsengindex.net> and <hangsengindex.org> on January 11, 2000, January 13, 2001, and January 19, 2001, respectively. A list of the domain names registered by the Complainant and its parent/associate companies and copies of the whois search results on <hangsengindex.com>, <hangsengindex.net> and <hangsengindex.org> respectively are provided as Annex E.

The mark “恒生指數” (Chinese equivalent of “Hang Seng Index”) (“the Mark”) is the dominant part of the names of the Hang Seng family of indexes provided by the Complainant. The Mark is extensively used and advertised throughout the world. The Hang Seng family of indexes, including the Hang Seng Index which was launched in 1964, has become an important indicator of stock market performance worldwide especially in Hong Kong, London and the Asia Region. The families of indexes maintained by the Complainant includes, but not limited to, Hang Seng Index, Hang Seng China Enterprises Index, New Hang Seng MidCap 50 Index, Hang Seng China Affiliated Corporations Index, Hang Seng 100, Hang Seng IT Index, Hang Seng IT Portfolio Index, Hang Seng London Reference Index and Hang Seng Asia Index.

Amongst the above indexes, the Hang Seng Index is a barometer of the Hong Kong stock market. The constituent stocks are grouped under Commerce and Industry, Finance, Properties and Utilities sub-indexes. The Hang Seng Index currently comprises 33 constituent stocks which are representative of the market. The aggregate market capitalisation of these stocks accounts for about 70% of the total market capitalisation on The Stock Exchange of Hong Kong Limited.

It has recently come to the Complainant's attention that the Respondent has registered the multilingual Domain Name <恒生指数.com> (Chinese equivalent of “Hang Seng Index.com”) without its knowledge or authorization. As noted from Annex D, the Complainant has registered the mark “恒生指數” (Chinese equivalent of “Hang Seng Index”) and “Hang Seng Index” in respect of various goods and services throughout the world. In this regard, please note that the Chinese word “数” in “恒生指数” is the simplified form of the word “數” in our client's registered mark “恒生指數”. The Respondent has no rights or legitimate interests in respect of the Domain Name because (a) its <恒生指数.com> (Chinese equivalent of “Hang Seng Index.com”) website is currently substantively inactive and there is no substantial use of the website by the Respondent; (b) the Respondent's name is different from the Domain Name. The Respondent is therefore not commonly known by the domain name.

The Complainant submits that the Domain Name has been registered and used in bad faith. The Registrant registered the Domain Name early on November 2000, but has not constructed any homepage. A copy of the page under the Domain Name printed on May 11, 2001, is provided as Annex F.

The Complainant's Authorized Representative sent a cease and desist letter by fax and by registered post to the Registrant on February 19, 2001, notifying him that his registration of the Domain Name has infringed the Complainant's right and asking him to cancel the registration of the Domain Name forthwith. A copy of the said cease and desist letter is provided as Annex G. The Complainant's Authorized Representative received no reply from the Registrant after the cease and desist letter and then telephoned the Registrant to ask for a reply. The Registrant confirmed in the telephone his receipt of the cease and desist letter. The Registrant requested a substantial amount to be paid by the Complainant before he would agree to cancel the Domain Name. The Complainant's Authorized Representative immediately made it clear to the Registrant that he had no rights in the Domain Name and the Complainant would not be prepared to pay him any money. The Registrant has failed to cancel the Domain name to date.

The Complainant submits that the Registrant was actually a bad-faith pre-emptive registrant whose sole purpose for the registration was for selling, renting, or otherwise transferring the Domain Name registration for profits. Moreover, the Registrant's registration has in fact obstruct (*sic*) the Complainant from reflecting its mark and services in a corresponding domain name.

The Complainant reiterates that it has legitimate rights to use the name/mark “恒生指數” (Chinese equivalent of “Hang Seng Index”). It is the Complainant's submission that the Respondent has deliberately registered the Domain Name in order to prevent the Complainant from reflecting its marks and services in a corresponding domain name.”

B. Respondent

The Respondent has not responded.

6. Discussion and Findings

General

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) The Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interest in respect of the Domain Name; and
- (iii) The Domain Name has been registered and is being used in bad faith.

Where a Respondent who has been properly notified of the Complaint fails to respond, the Panel is entitled to draw such inferences as it considers appropriate (Rule 14(b)).

In this case the consequence of the Respondent's failure to respond is that the Panel accepts as fact the uncontraverted assertions of the Complainant and in particular that:

- The telephone conversation referred to above took place.
- In the course of that telephone conversation the Respondent demanded of the Complainant a substantial sum of money in return for cancellation of the Domain Name.

Identical or confusing similarity

The Respondent registered the Domain Name <恒生指数.com>, in which the Chinese character “数” is the simplified form of the character “數” in the Complainant's registered trademark “恒生指數”. Just as the same English word could have multiple but similar spellings (for example, “organization” and “organisation”), the same Chinese character could have multiple but similar appearances as well. In this case, “數” in the Complainant's registered trademark “恒生指數” and “数” in the Domain Name <恒生指数.com> are the same Chinese character, but the former is in the traditional form and the latter is in the simplified form.

The Domain Name comprising as it does the simplified Chinese form of the Complainant's trade mark/service mark, is substantially identical. For this purpose the .com suffix may be ignored.

Accordingly the Panel finds that the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

Rights or legitimate interest of the Respondent

The Domain Name reproduces the name of a world famous service product of the Complainant from the ownership details of the Domain Name it is apparent that the Domain Name is not the registered name of the Respondent.

Paragraph 4(c) of the Policy which is addressed to Registrants reads as follows:

“How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding to a Complaint. When you receive a complaint, you should refer to **Paragraph 5** of the Rules of Procedure in determining how your response should be prepared. Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of **Paragraph 4(a)(ii)**:

- (i) before any notice to you of the dispute, your 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; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 trademark or service mark at issue”.

The Respondent has not sought to put forward any justification for his selection of the Domain Name. It does not appear to the Panel that any of the circumstances set out in paragraph 4(c) of the Policy are applicable here. Moreover, the Panel cannot think of any other reason why the Respondent might reasonably be said to have any rights or legitimate interests in respect of the Domain Name.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name on the basis that its <恒生指数.com> website “is currently substantively inactive”. The Complainant asserts further that the Respondent has not constructed any homepage. The Respondent has not seen fit to deny these allegations. Although the prevalent use of domain names is as HTTP World Wide Web addresses on the Internet, they may be used for other Internet services (eg. FTP, email, etc). The Respondent has not submitted any evidence to suggest that the Domain Name has been used for any Internet service. Therefore, the Panel finds that there has been no active use of the Domain Name.

In the result, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

Bad Faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances which “if found by the Panel to be present shall be evidence of the registration and use of the domain name in bad faith”. Sub-paragraph (i) of 4(b) reads as follows:

“circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name”.

The Respondent registered the Domain Name in November 2000, and has made no active use of it. As indicated, the Domain Name is a famous name of the Complainant and, as the Panel has already found, the Respondent has no rights or legitimate interests in respect of it.

The Complainant’s representative telephoned the Respondent and in the course of that conversation the Respondent indicated that he would only agree to cancel the Domain Name if the Complainant paid a substantial sum of money. The evidence to substantiate this telephone conversation is sparse in the extreme (not even an attendance note recording the terms of the conversation), but the Panel has no reason to doubt the word of the Complainant’s representative. Moreover, the Respondent, who is aware of the allegation, has not denied it. In the result, the Panel finds that the Respondent registered the Domain Name knowing that it was a name in which the Complainant had rights and in the hope and expectation that the Complainant would pay to the Respondent a sum of money for the Domain Name being a sum of money in excess of the Respondent’s out of pocket expenses.

The Panel finds that the Domain Name was registered in bad faith and is being used in bad faith within the meaning of Sub-paragraph 4(b)(i) of the Policy.

7. Decision

In light of the foregoing findings, namely that the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights and that the Respondent has no rights or legitimate interests in respect of the Domain Name and that the Domain Name was registered in bad faith and is being used in bad faith, the Complaint succeeds.

Pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the Panel directs that the Domain Name <恒生指数.com> be transferred to the Complainant.

Tony Willoughby
Presiding Panelist

SOH Kar Liang
Panelist

XUE Hong
Panelist

Dated: August 17, 2001