



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

The Hongkong and Shanghai Banking Corporation Limited –v- Bill Lynn

Case No. D 2001-0915

1. The Parties

The Complainant is The Hongkong and Shanghai Banking Corporation Limited, L37 HSBC Main Building, 1 Queen’s Road Central, Hong Kong, PRC.

Represented by Messrs. Johnson Stokes & Master, 19th Floor, Princes’ Building, 10 Chater Road, Central, Hong Kong, PRC.

The Respondent is Bill Lynn, PO Box 130304, New York, NY 10013, USA.

2. The Domain Name(s) and Registrar(s)

The Domain Name is <香港上海匯豐銀行.com>. RACE Language Encoding: Bq--3cmzs3rpjyfg252tf6gfbearbga.com.

The Registrar is Register.com, Inc.

3. Procedural History

The electronic copy of the original Complaint was submitted to the World Intellectual Property Organization Arbitration and Mediation Center (the “Center”) on July 17, 2001. The hardcopy of the Complaint was received on July 20, 2001. Therein, the Complainant requested for a single-member Panel. The Center sent an Acknowledgement of Receipt to the Complainant on July 18, 2001.

The Center sent a Request for Registrar Verification to the Registrar on July 24, 2001, and the Registrar confirmed the identity of the Respondent on the same day. On July 27, 2001, the Center forwarded the Respondent a copy of the Complaint to and the notification of the commencement of this administrative proceeding in the usual manner and informed the Respondent of the deadline to file a Response, that is, August 16, 2001. No Response was received and the Center issued a Notification of Respondent Default on August 17, 2001.

The Center properly constituted and appointed this Panel in accordance with the Rules and Supplemental Rules. No further submissions were received by the Center or this Panel, as a consequence of which the date scheduled for the issuance of the Panel's Decision is October 1, 2001.

4. Factual Background

The Complainant was established in 1865 and is the founding member of the HSBC Group. The Complainant is the largest bank in Hong Kong. It is one of the three note-issuing banks in Hong Kong. The HSBC Group is one of the largest banking and financial service organizations in the world, having an international network of over 6,500 offices in 79 countries.

The Complainant's full name in Chinese is “香港上海滙豐銀行有限公司” and is commonly known and referred to as “香港上海滙豐銀行”, which corresponds to the Complainant's name. The characters have the following meanings:

- “香港” – Hong Kong
- “上海” – Shanghai
- “滙豐” – abundant remittance
- “銀行” – bank
- “有限公司” – limited company

The Complainant has registered the following trademarks throughout the world in respect of various services:

1. “滙豐” (eg, Hong Kong registration no 1555/1993)
2. “汇丰” (eg, China registration no 967955)
3. “WAYFOONG” (eg, Hong Kong registration no 1559/1993)
4. “滙豐銀行” (eg, US registration no 1,446,772)

The above trademarks have been used and advertised throughout the world. The full list of the trademark registrations is found in Annex C to the Complaint. “滙豐” and “汇丰” have the same pronunciation and meanings and are for all intents and purposes identical. “WAYFOONG” is a transliteration of “滙豐”/“汇丰”. The character “滙” and “匯” are regarded as the same in Chinese. No trademark registration for “香港上海滙豐銀行”, “香港上海匯豐銀行” or “香港上海汇丰銀行” was submitted by the Complainant.

The Complainant and its parent/associated companies have registered many domain names based on the above trademarks. The full list of domain name registrations is found in Annex D to the Complaint. Among the registrations are <香港上海滙豐銀行.net>, <香港上海匯豐銀行.org>, <香港上海汇丰銀行.net> and <香港上海汇丰銀行.org>.

The Respondent registered the Domain Name on November 10, 2000.

5. Parties' Contentions

A. The Complainant

The substance of the Complaint is short and is reproduced below:

“It has recently come to the Complainant’s attention that the Respondent has registered the Chinese multilingual domain name “香港上海滙豐銀行.com” without its knowledge or authorization. As noted from Annex C, the Complainant has registered the marks “滙豐”, “滙豐銀行”, “汇丰” and “WAYFOONG” in respect of various goods and services throughout the world. In this regard, please note that the word “滙” is the same as “匯” under the Chinese characters system.

The Respondent has no rights or legitimate interests in respect of the Domain Name because (a) its “香港上海滙豐銀行.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; (c) the Respondent is not a bank and the registration and/or use of the Domain Name bearing the characters “銀行” which mean “bank” in Chinese will be deceptive.

The Complainant submits that the Domain Name has been registered and is intended to be used in bad faith. The Complainant further 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. It was reported on Hong Kong Economic Times on 3 January 2001 that a person with username “taklee8” offered to sell the Domain Name in a Hong Kong based online auction site Go2HK (<http://www.go2hk.com>) at a starting price of HK\$200,000. A copy of the said newspaper report and its translation are provided as Annex F.

Moreover, the Registrant’s registration has in fact obstructed 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 “香港上海滙豐銀行”. 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.

The Complainant’s Authorized Representative sent a cease and desist letter by email and by post to the Registrant on 15 May 2001 notifying him that his registration of the Domain Name has infringed the Complainant’s right and asking him to assign the Domain Name to the Complainant. A copy of the said cease and desist letter is provided as Annex E. 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 said that the matter was “negotiable” and would ask his lawyer to give a reply to the Complainant’s Authorized Representative. However, the Complainant’s Authorized Representative and/or the Complainant only received an email from the Registrant stating that he would reply but received no final response from the Registrant and/or his lawyer to date despite a reminder was sent to the Registrant.”

B. The Respondent

The Respondent failed to respond.

6. Discussion and Findings

In order to succeed in this proceeding, Article 4(a) of the Policy requires the Complainant to prove the existence of each of the following elements:

1. The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. The Respondent has no rights or legitimate interests in respect of the Domain Name; and
3. The Domain Name has been registered and is being used in bad faith.

As the Respondent failed to respond, despite having been properly notified of the Complaint, the Panel is entitled to draw appropriate inferences pursuant to Rule 14(b). In this case, the Panel accepts the unchallenged assertions of the Complainant as fact, in particular, in relation to:

1. The inactivity of the Domain Name as an address of a website;
2. The offer for sale of the Domain Name at the online auction site at <http://www.go2hk.com>;
3. The cease and desist letter to the Respondent on May 15, 2001; and
4. The telephone conversation between the Complainant's authorized representative and the Respondent.

Identical or Confusingly Similar Trademark

Under the Singapore Trade Marks Act (Cap 332, 1999 Edition), a trademark (or "trade mark" as identified therein) means "any visually perceptible sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other persons". This definition is similar to that adopted in many jurisdictions and this Panel shall be guided by the same. The Chinese character combinations "香港上海滙豐銀行", "香港上海滙豐銀行", "香港上海汇丰银行" and the Complainant's name as a result of their history and use clearly fall within this definition.

In view of the long and extensive use of these character combinations and their English equivalent (ie, the Complainant's name) as an identifier of the Complainant's business, this Panel is satisfied that the Complainant would have acquired common law rights over the same. As such, this Panel finds that "香港上海滙豐銀行", "香港上海滙豐銀行", "香港上海汇丰银行" and the Complainant's name are trademarks in which the Complainant has rights within the meaning of Article 4(a), bearing in mind that a plain reading of Article 4(a) does not require the trademark concerned to be registered.

It is an established practice to ignore the ".com" portion of domain names when comparing them against corresponding trademarks since it is a non-distinguishing

feature. On this basis, this Panel finds that the Domain Name (disregarding the “.com” portion) is identical to “香港上海滙豐銀行”, “香港上海匯豐銀行” and “香港上海汇丰银行” and confusingly similar to the Complainant’s name in English.

Legitimate Interest

“香港上海滙豐銀行” corresponds to the Complainant’s name and the Complainant has shown that it has legitimate rights to want to use the Domain Name. The Domain Name refers to the name of a bank but the Respondent is an individual. The Respondent has not provided any justification for his selection of the Domain Name. The Panel is unable to identify any reason, including the circumstances set out in paragraph 4(c) of the Policy, which allows the Respondent to claim any right or legitimate interest in respect of the Domain Name.

The Respondent has not seen fit to deny the Complainant’s allegations that the Domain Name is currently not used to support a website. Although domain names may be used for internet services other than world wide web services (eg, FTP, email, etc), the prevalent use of domain names is as internet world wide web addresses. 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 use of the Domain Name.

The Panel accordingly finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

Bad Faith Registration and Use

Paragraph 4(b)(i) of the Policy, which provides a ground for finding bad faith registration and use, 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.”

There is no evidence to suggest that the Respondent has used the Domain Name since its registration in November 2000. The Panel has already found that the Respondent has no rights or legitimate interests in the Domain Name. In view of non-use of the Domain Name since registration and the absence of contrary evidence, it is difficult to ignore the likelihood of bad faith registration.

In addition, the Domain Name was offered by a “taklee8” for sale by auction for HK\$200,000, an amount which is way beyond the cost of registering and maintaining a domain name. Although there is no direct evidence linking “taklee8” to the Respondent, the circumstances are such as to raise a reasonable inference that the Domain Name is available for sale.

There is no evidence that the Respondent has denied the availability of the Domain Name for sale in response to the newspaper report. The Respondent did not respond substantively to the Complainant’s cease and desist letter. The Respondent effectively ignored the Complainant’s threat of legal proceedings. The Respondent has chosen not to respond to the Complaint. All in all, the Panel finds that the Respondent’s failure to

express any denial or explanation despite the various opportunities offered to him reinforces the inference of bad faith registration and bad faith use.

It is the view of this Panel on a balance of probability that the Respondent has registered the Domain Name in bad faith and the Domain Name is being used in bad faith.

7. Decision

Based on the findings and reasons stated above, the Panel determines that the Complainant succeeds and hereby directs that the Domain Name <香港上海滙豐銀行.com> be transferred to The Hongkong and Shanghai Banking Corporation Limited.

Soh Kar Liang
Sole Panelist

Dated: September 28, 2001