



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

John Swire & Sons Limited v Lily Zhu

Case No. D2001- 1025

1. The Parties

The Complainant is John Swire & Sons Limited, a company incorporated in the United Kingdom with its registered office at Swire House, 59 Buckingham Gate, London SW1E 6AJ, England.

The Complainant is represented by Ms Rosita Y.M. Li of Messrs Johnson Stokes & Masters, 19th Floor, Prince's Building, 10 Chater Road, Central, Hong Kong.

The Respondent is Ms Lily Zhu, HuaQian Rd, Shenzhen, Guangdong, China, 518080.

The Respondent is represented by Mr Ling Hsiao Wang, 2F, No. 10 Alley 6, Lane 335, Fu Hsing Road, Shu Lin City, Taipei County, Taiwan.

2. The Domain Name and Registrar

The Disputed Domain Name is <太古.com>.

The Registrar is OnlineNIC, Inc., 36 Newell St, San Francisco, CA, 94133, United States of America.

3. Procedural History

The WIPO Arbitration and Mediation Center ("the WIPO Center") received the Complaint by email on August 14, 2001 and in hard copy form on August 17, 2001. The WIPO Center issued an Acknowledgement of Receipt of Complaint on August 15, 2001. On October 24, 2001, the WIPO Center verified that the Complaint satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy ("the Policy"), WIPO's Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") and that payment was properly made. The Administrative Panel ("the Panel") is satisfied that this is the case.

The Complaint was properly filed and notified in accordance with paragraph 2(a) of the Rules.

On September 7, 2001, the Registrar verified that <太古.com> is registered through OnlineNIC, Inc. and that Lily Zhu is the current registrant, Administrative, Technical and Billing Contact. The Registrar also confirmed that the Policy is applicable to the Domain Name and that the Domain Name is not active. The Registrar indicated that the registration agreement is in the Chinese language. The Respondent has not requested that the disputed Domain Name be deleted from the domain name database nor sought to terminate this agreement with the Registrar. The Respondent is therefore bound by the provisions of the Policy. The Respondent consequently submits to the jurisdiction of the Policy at the location of the Registrar's principal office for registration agreements in the Chinese language, Fujian province, China.

The WIPO Center notified the Respondent of the Complaint by email, fax and courier on October 24, 2001 in the usual manner, and informed the Respondent that the deadline for sending his Response to the Complainant and to the WIPO Center was November 13, 2001.

With the consent of the Complainant, the Respondent submitted a Response on November 20, 2001.

The undersigned Panelist was contacted by the WIPO Center on December 14, 2001 and submitted a Statement of Acceptance and Declaration of Impartiality and Independence to the WIPO Center on December 21, 2001. The Panelist finds that the Panel was properly constituted in accordance with the Rules and the Policy.

No further submissions were received by the WIPO Center or the Panelist. In light of the previous correspondence in the case, the Panel decides to proceed in the Chinese language. Notwithstanding as a matter of courtesy and for the convenience of non-Chinese speaking readers, the decision is also provided in English text. The original date scheduled for the issuance of the Panel's Decision was January 17, 2002. The revised date scheduled for the issuance of the Panel's Decision is January 31, 2002.

4. Factual Background

The Complainant is a company incorporated under the laws of the United Kingdom. The Complainant states that its full name in Chinese is '英国太古有限公司', with the third and fourth characters constituting the distinctive part of the Complainant's Chinese name. The use of these characters in the Disputed Domain Name form the subject of these Proceedings.

The Complainant states that it has global interests but that its activities are concentrated in the Asia Pacific region, centered on Hong Kong, SAR. The majority of its businesses in this area come under Swire Pacific Limited and are grouped into five operating divisions: property, aviation, industries, trading and marine services.

The Complainant is the registered proprietor, either in its own right or through its subsidiaries, of numerous trade marks in multiple classes for '太古' in Cambodia, the PRC, Canada, Hong Kong, Malaysia, Taiwan and Vietnam. All of these trade marks were registered before the Respondent became the registered proprietor of the Disputed Domain Name on November 10, 2000.

The Respondent is Ms Lily Zhu. Ms Zhu is also the Administrative, Technical and Billing Contact for <太古.com>.

On May 2, 2001, Counsel for the Complainant sent a cease and desist letter by email and registered post to the Respondent alleging that the Respondent's registration of the Disputed Domain Name infringed the Complainant's rights and requesting that the Respondent transfer the Disputed Domain Name to the Complainant.

On May 30, 2001, the Respondent replied to the cease and desist letter by email indicating that multilingual.com domain names were not operational at that time and therefore that the Complainant could not satisfy the requirements under the Policy, specifically use by the Respondent of the Disputed Domain Name in bad faith. The Respondent also indicated that she had no intention of using the Disputed Domain Name in bad faith once it became operational.

5. Parties' Contentions

The Complainant

The Complainant contends that it and its subsidiaries have acquired substantial reputation and goodwill in the trade mark '太古'. The Complainant further submits that the Disputed Domain Name is identical and/or confusingly similar to their trade mark and the Complainant's corporate name. As such, the Complainant contends that the relevant internet-using public might reasonably associate the disputed Domain Name with the Complainant.

Additionally, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and believes that the Disputed Domain Name was registered 'in bad faith'.

The Respondent

The Respondent contends that she was not aware of the existence of the 太古 Group or trade mark at the time that she registered the Disputed Domain Name. The Respondent disputes the assertion by the Claimant that 'the two characters '太' and '古' when used together is not a term commonly used in everyday Chinese language'. The Respondent notes that forty-three Taiwanese companies have '太古' in their corporate titles.

The Respondent contends that the dictionary meaning of '太古' is 'prehistoric era'. The Respondent draws attention to the fact that she is a member of a club established by the < www.dinosaurclass.com > website. The Respondent states that she sought to register <恐龙.com > on October 28, 2000. That domain name was unavailable so the Respondent proceeded to register the Disputed Domain Name on November 10, 2000 as a link to the < www.dinosaurclass.com> website.

6. Applicable Dispute

The Policy applies to this dispute. By registering the Disputed Domain Name, the Respondent accepts the dispute resolution policy adopted by the Registrar.

7. Discussion and Findings

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- 1) That the domain name registered by the Respondent is identical or confusingly similar to a service mark or trade mark in which the Complainant has rights; and
- 2) That the Respondent has no legitimate rights or interests in respect of the domain name; and
- 3) That the domain name has been registered and is being used in bad faith.

Identical or Confusing Similarity

The submissions made by the Complainant demonstrate that the Complainant has rights in the trade mark ‘太古’ within the meaning of subparagraph 4(a)(i) of the Policy. The Respondent agrees that the Disputed Domain Name is the same as the ‘太古’ trade mark.

The Complainant’s ownership of the ‘太古’ trade mark in seven countries including Taiwan and the wide business scope of the太古 group of companies support the contention of the Complainant that the relevant Internet-using public would be likely to be confused by the Respondent’s use of the characters ‘太’ and ‘古’ in the Disputed Domain Name.

The Panel therefore finds that the domain name <太古.com> registered by the Respondent is identical or confusingly similar to a trade mark in which the Complainant has rights.

Rights or Legitimate Interests of the Respondent

Paragraph 4(c) of the Policy stipulates how a Respondent can effectively demonstrate rights or interests in the Disputed Domain Name:

“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 Complainant submits that the Respondent has no rights or legitimate interests in the Disputed Domain Name because the <太古.com> website is inactive and the name of the Respondent is not that of the website. These submissions suggest that the Respondent does not fall within either subparagraph 4(c)(i) or (ii) of the Policy. The Respondent notes that Chinese domain names were not officially available until November 14, 2001. If this is indeed the case, it goes some way to explaining the inactivity of the site given that the Complainant lodged its complaint on August 14, 2001. Nevertheless, the fact remains that the Respondent does not fall within the ambit of paragraph 4(a)(ii) of the Policy.

The Respondent infers that ‘太古’ is a generic term, claiming that it appears in the names of streets, individuals and commercial enterprises. The Respondent annexes to her submission copies of search results for ‘太古’ from the search engine <www.google.com>. The Respondent also annexes copies of four WIPO decisions and one e-Resolution decision, all of which address generic domain names. In light of the Complainant’s evidence, the panel concludes that the Disputed Domain Name is not generic. The ‘太古’ trade mark is a well-recognised and distinctive presence in the marketplace, but it is not inherently adapted to distinguish the goods and services of the Complainant from those of its competitors. The ‘太古’ trade mark has been rendered factually distinctive by extended use and wide registration but, at root, the term has a meaning beyond that which the Respondent ascribes to it, namely ‘prehistoric era’.

The Respondent’s stated aim in registering the Disputed Domain Name was to provide a link to the <www.dinosaurclass.com> website; an aim which, if accepted, falls within subparagraph 4(c)(iii) of the Policy. The Complainant has not submitted evidence to suggest that the Respondent receives any commercial gain from the Disputed Domain Name. Furthermore, there is no evidence before the Panel that the Respondent is in competition with the Complainant or has any reason to tarnish the ‘太古’ trade mark. The Panel therefore finds that the Respondent is making a legitimate non-commercial use of the Disputed Domain Name. Accordingly, the Respondent has rights or legitimate interests in the Disputed Domain Name pursuant to paragraph 4(c)(iii) of the Policy.

Bad Faith

As noted above, the Complainant bears the onus of establishing that the Respondent has no rights or legitimate interests in the Disputed Domain Name. On the evidence before it, the Panel holds that the Complainant has not established this element. It is therefore strictly academic whether the Complainant has established the final element required by paragraph 4(a) of the Policy, that of ‘bad faith’. Nevertheless, the Panel makes the following observations.

Under paragraph 4(b) of the Policy, the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) 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 related to the domain name; or

- (ii) you have registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site.

The Panel in *Telstra Corporation Limited v Nuclear Marshmallows* [WIPO Case No D2000-0003] held that, for the purposes of paragraph 4(a)(iii) of the Policy, the Complainant needs to establish use of the domain name in bad faith as well as registration in bad faith.

The Complainant asserts that 'the Respondent 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'. The Complainant has not led any evidence to support this contention. The Respondent has not sought to sell, rent or transfer the Disputed Domain Name to the Complainant. The Respondent may have, in effect, prevented the Complainant from reflecting the '太古' trade mark in a corresponding '.com' domain name but it should be noted that the Complainant has registered twenty-eight other domain names incorporating the term '太古'.

There is also no evidence before the Panel to suggest that the Respondent has engaged in a pattern of conduct aimed at frustrating the efforts of trade mark owners by preventing the reflection of the trade mark in a domain name. Finally, the Complainant and Respondent are not competitors and the Respondent has nothing to gain from the possible confusion between the '太古' trade mark and the <太古.com> website. The coincidence that a well-known company shares its name with a period of history is not sufficient in the eyes of the Panel to establish bad faith on the part of the Respondent. Even if the Complainant was able to establish that the Respondent acted in bad faith by registering the Disputed Domain Name, the Complainant would be unable to establish bad faith use of <太古.com>.

8. Decision

In light of the abovementioned findings, the Panel decides:

- a) that the <太古.com> domain name registered by the Respondent is identical or confusingly similar to the '太古' trade mark in which the Complainant has rights;
- b) that the Respondent has rights or legitimate interests in respect of the <太古.com> domain name; and
- c) that the Respondent's <太古.com> domain name was not registered 'in bad faith' and has not been used thereafter 'in bad faith'.

As such the Panel concludes that the Complainant has not established its case and dismisses the Complaint.

Loke-Khoon Tan
Sole Panelist

Dated: January 31, 2002