Hong Kong International Arbitration Centre

ADMINISTRATIVE PANEL DECISION

Case No. DCN-0400011

Complainant : Cathay Pacific Airways Limited
Respondent : Yunnan Province Taizhongshang Technology Development Limited
Domain Name : 亞洲萬里通.公司/亞洲万里通.公司
Registrar : Civilink International Information Technology Co Ltd. (Beijing) (Now known as HiChina Web Solutions (Beijing) Limited)

1. Procedural History

The complainant in this case is Cathay Pacific Airways Limited, a company registered in Hong Kong. Its address is at 5/F, South Tower, Cathay Pacific City, 8 Scenic Road, Hong Kong International Airport, Lantau, Hong Kong. Its authorized representative in these proceedings is Messrs. Johnson Stokes & Master of Hong Kong.

The respondent is Yunnan Province Taizhongshang Technology Development Limited and its address is at Block 4, Yuxi City Chiyang Road, Yunnan Province, China (Postal Code: 653101). The respondent has not appointed any representative in these proceedings.
The domain name in dispute is <亞洲萬里通.公司>/亚洲万里通.公司>. The Registrar of the domain name is Civilink International Information Technology Co Ltd. (Beijing), now known as HiChina Web Solutions (Beijing) Limited. Its address is at 3/F, Wanwang Building, 27 Guluiwai Main Street, Eastern City Region, Beijing, China {Postal Code 100011).

On 31 March 2004, the Hong Kong International Arbitration Centre received a complaint in Chinese from the Complainant pursuant to the CNNIC Domain Name Dispute Resolution Policy ("the CNDRP") of 30 September 2002 of China Internet Network Information Centre ("CNNIC"), the Rules for CNNIC Domain Name Dispute Resolution Policy ("the Rules") and Hong Kong International Arbitration Centre Supplemental Rules to China Internet Network Information Center Domain Name Dispute Resolution Policy ("the HKIAC Supplemental Rules"), the complainant submitted a complaint in Chinese to the Hong Kong. The Complainant elected this case to be dealt with by a one-person panel.

On 7 April 2004, the Hong Kong International Arbitration Centre sent to the complainant by email an acknowledgement of the receipt of the fees for the proceedings and indicated that the Hong Kong International Arbitration Centre was to review the format of the complainant for compliance with the CNDRP, the Rules and the HKIAC Supplemental Rules.

On 14 April 2004, pursuant to the written request from the Hong Kong International Arbitration Centre, the Registrar confirmed that the domain name in dispute was registered by it, that the status was still valid, and the respondent was the domain name holder.

During that time, the Hong Kong International Arbitration Centre sent or issued to the
respondent respectively by registered mail or email the notice of commencement of proceeding, together with the complaint and annexed materials. As the respondent did not file a response in accordance with the stipulated time in the Rules and the HKIAC Supplemental Rules, the proceedings proceeded into the stage of hearing in default in the absence of the respondent.

On 11 June 2004, the Hong Kong International Arbitration Centre gave notice to the potential candidate for the panelist, Mr. Gary Soo, requesting him to confirm whether he would accept the appointment as a panelist for this case and, if so, whether he could maintain impartiality and independence between the parties in this case. On the same day, Mr. Gary Soo confirmed by email to the Hong Kong International Arbitration Centre his agreement to accept the appointment and declared his being able to maintain his impartiality and independence in dealing with this case. On 14 June 2004, Hong Kong International Arbitration Centre notified the parties and Mr. Gary Soo that the Panel was formed by Mr. Soo as the Sole Panelist. On the same day, the case was formally transferred to the Panel. The Hong Kong International Arbitration Centre also confirmed that this case was to be dealt with under the proceedings of CNDRP.

2. Factual Background

For the Complainant

The Complainant is a listed company in Hong Kong, established in 1946. Operating from Hong Kong as its base, the Complainant provides scheduled international passengers and cargos flights to 48 cities distributed among the world in the 5 Continents. In 1998, the complainant launched a frequent flyers reward scheme, named “亚洲万里通(Asia Miles)”, that covers various industries and services, whether airline connected or not. Since
September 1998, the Complainant acquired the registration as trademarks various mark of “亞洲萬里通” in traditional Chinese, in respect of various products and services.

*For the Respondent*

The Respondent registered the domain name in dispute, <亞洲萬里通.公司>/ <亞洲萬里通.公司>, on 5 February 2001.

3. **Parties’ Contention**

*The Complainant*

The Complainant assets civil rights over the two marks “亞洲萬里通” and “亞洲万里通”. Since it was established, the business of the Complainant extended over to the 5 Continents of the world. From 2000 to 2003, the Complainant’s annual average turnover was over HK$300 billions and the Complainant also received awards from elections held by various media for as well-known brand, largest Hong Kong corporation, best airlines and high quality service company.

According to the Complainant, in 1998, it already launched a frequently flyers reward scheme, named “亞洲万里通(Asia Miles)”, which was regarded as number one. The scope of the scheme included various industry and services such as airlines, banks, hotels, telecommunications, gas stations, car rentals, travel services, restaurants, information and entertainment, travel utilities, health and beauty products, flower shops, wine, insurance and internet. The Complainant notes that general consumers can accumulate for its rewards
through daily spending under the scheme. The partners that join the scheme include many other airlines and other non-airline partner such as the Bank of China and the number of partners reaches over 150 by now.

The Complainant points out that, since September 1998, the Complainant has registered the traditional Chinese version of the “亞洲萬里通” mark and the connected marks in Mainland China and Hong Kong and that the concerned products and services are of various categories. Among them, from May 2000 to December 2000, the registered trademarks in Mainland China involved those products and services including the categories Nos. 16, 39 and 42. The corresponding trademark registration certificates are respectively nos. 1397732, 1397872, 1427646, 1476723, 1397870, 1427648, 1427647, 1476705 and 1484777. Besides, the Complainant also registered in Hong Kong the trademark of “亞洲萬里通” in traditional Chinese for products and services also of categories nos. 16, 39 and 42. In December 2002, the Complainant also applied for trademark registration in Mainland China based on the “亞洲萬里通” mark in simplified Chinese and the application is still being processed.

The Complainant says that, on 21 October 2003, it has already registered the domain names in Chinese of <亞洲萬里通.中國>/ <亚洲万里通. 中国> and <亞洲萬里通.cn> /<亚洲万里通.cn> for its promotion of the “Asia Miles” scheme and that it has promoted the scheme though various promotion events such as golf tournament and travel expo. Apart from that, it has set up logo icon advertisement on sino.com, chinadaily.com and suhu.com and placed advertisement in other travel or airlines magazines for the promotion of the “Asia Miles” scheme.

In the premise, the Complainant asserts that it has established goodwill over the traditional
Chinese mark “亞洲萬里通” that should be protected and that the public would also associate the simplified Chinese mark of “亞洲万里通” uniquely with the Complainant.

The Complainant is of the view that the key component of the disputed domain name is the same or confusingly similar with the registered trademark of “亞洲萬里通” which is in traditional Chinese and is also the same or confusingly similar with the mark of “亞洲万里通” in simplified Chinese that the Complainant is applying for trademark registration.

As to the Respondent’s rights towards the disputed domain name or its key component, the Complainant points out that the registration of the disputed domain name was carried out by the Respondent without the notice or authority of the Complainant. The Complainant stresses that it has never authorized the Respondents to use the “亞洲万里通” mark as domain name or otherwise. Also, the Complainant says that the phrase “亞洲万里通” was not one in the use of daily languages and this is created by the Complainant specially for the frequent flyers scheme.

By reason of the above matters, the Complainant considers that the Respondent was without any legitimate rights over the disputed domain name or its key component. On top of this, the Complainant also makes tow points in support of its contention: Firstly, the webpage that the disputed domain name corresponded was inactive; secondly, the name of the Respondent was totally different from the disputed domain names and the Respondent has no reason whatsoever to use the name of “亞洲万里通”.

The Complainant also points out that the registration or use of the disputed domain name was with bad faith for the following reasons:-

Firstly, the Respondent registered the disputed domain name for commercial use. The
Complainant is of the view that, since Complainant has put in resources for promotion in China and overseas, the “Asia Miles” scheme was known to a definite degree and that the Respondent’s registration of the disputed domain name was for the sole purpose of selling, renting or otherwise transferring it for marking profits.

Secondly, the Respondent registered the disputed domain name to prevent the Complainant to reflect its mark or services through a corresponding domain name. In this regard, the Complainant regards that the Respondent was acting deliberately in preventing the Complainant to reflect its mark or services through a corresponding domain name.

Thirdly, the solicitors representing the Complainant has tried to contact the Respondent via the contact details supplied by the Respondent to the Registrar via email on 16 December 2003, making it clear that the Complainant has rights over the disputed domain name and expressly asking for a response from the Respondent. However, due to the invalid status of the email address, the email could not be sent through. The Complainant sees the supply of an invalid email by the Respondent was for the purpose of preventing the holder of legitimate rights over the disputed domain name to pursue legal consequences against the Respondent, thereby further confirming that the Respondent was without any real intent to use the domain name. The Complainant also regards that the ultimate goal of the Respondent was to sell the disputed domain name at price higher that market value so as to obtain profits.

Thus, the Complainant asks for the transfer of the disputed domain name to the Complainant.

*The Respondent*

The Respondent did not file a response within the stipulated period of time.
4. Findings

Article 8 of CNDRP provides that a complaint against a registered domain name shall be supported if the following conditions are fulfilled:

(i) the disputed domain name is identical with or confusingly similar to the complainant's name or mark in which the complaint has civil rights or interests;

(ii) the disputed domain name holder has no right or legitimate interest in respect of the domain name or major part of the domain name;

(iii) the disputed domain name holder has registered or is being used the domain name in bad faith.

Article 7 of CNDRP states that the complainant and the respondent shall bear the burden of proof for their own claims. For this, Article 31 of the Rules stipulates that the Panel shall, in absence of exceptional circumstances, decide the dispute based upon the complaint. Further, Article 35 of the Rules provides that, if a party, in the absence of exceptional circumstances, does not comply with any provisions of the Rules, the Panel shall draw such inferences therefrom as it considers appropriate.

Based on the complaint and the attached documents submitted by the complainant, this Panel finds as follows:-

Identical or Confusing Similarity

The Respondent registered the disputed domain name <亞洲萬里通.公司>/ <亚洲万里通.公司> on 5 February 2001. The Complainant is an airline company set up in Hong Kong and its business covers the 5 Continents of the world. In recent years, the average turnover
of the Complainant reached HK$300 billions. The Complainant also received various awards from the enterprises and airlines sectors. Since 1998, the Complainant launches a frequent flyer reward scheme named “亚洲万里通(Asia Miles)” and uses the marks of “亚洲万里通” and “亚洲万里通” in its promotion of various types. The participating industries involves various aspects of daily lives of consumers and there are over 150 partnering entities, including some from China. Also, since September 1998, the Complainant has registered in Mainland China and Hong Kong trademarks of the traditional Chinese version of the “亚洲万里通” mark, covering various products and services including hotel supply reservation, travel and transport and related airlines information and commercial promotion products. Accordingly, the Panel considers that the Complainant is in possession of civil rights over the “亚洲万里通” mark or name as required under Article 8(i) of CNDRP.

As to the simplified Chinese version of the mark, “亚洲万里通”, the Complainant’s trademark application in Mainland China is still in the process. Article 8 of CNDRP does not set out the exact scope of civil rights required. Cases under the Uniform Dispute Name Dispute Resolution Policy (“the UDRP”) do accept trademark rights acquired thorough common use and do not request that trademark rights must be derived from registration. These cases include SeekAmerica Networks Inc. v. Tariq Masood and Solo Signs (WIPO Case No. D2000-0131), Brooklyn Institute of Arts and Sciences v Fantastic Sites, Inc. (NAF Case No. FA0009000095560) and Museum of Science v. Asia Ventures Inc. (WIPO Case No. D2003-0691). A complainant who bases its rights over an unregistered trademark has to prove its continuing use of the mark to the extent that it carries with it the effect of unique association with the complainant. See Australian Trade Commission v. Matthew Reader (WIPO Case No. D2002-0786) and Keppel TatLee Bank Limited v. Lars Taylor (WIPO Case No. D2001-0168). Although legal rights required under UDRP and CNDRP are not exactly the same, the Panel considers that cases under UDRP are still of certain guidance effect and the required civil rights under CNDRP are obviously not limited to civil rights derived from registered
In this case, the Complainant attached the concerned promotion information in annex 7 of the complaint. However, apart from a few photos and part of some seminar lecture notes, the mark concerned is “亞洲萬里通” rather than “亚洲万里通”. The Complainant did not specify in detail how it uses the “亚洲万里通” mark in promoting the scheme of the Complainant. The Complainant further did not provide solid evidence of the unique association of the mark with the scheme or the Complainant by its continuing use of the mark. Although the Complainant has registered the Chinese domain names such as <亚洲万里通.中國>/<亚洲万里通. 中国>and<亚洲万里通.cn>/<亚洲万里通.cn> for the promotion of the “Asia Miles” scheme, the Complainant did not elaborate further on matters such as the content, schedule and format of its promotion. Moreover, the Complainant only applies for trademark registration in December 2002 of the simplified version of the “亚洲万里通” mark in Mainland China. and the Respondent has already registered the disputed domain name in February 2001. Taking into account of the burden of proof provisions in Article 7 of CNDRP, the Panel in this case does not regards that the Complainant has successfully proved that its has civil rights over the simplified Chinese mark “亚洲万里通” as required under Article 8(i) of CNDRP.

Article 8 of CNDRP requires that the disputed domain name is the same or confusingly similar to the mark or name that the Complainant has civil rights. In cases under UDRP, such as Microsoft Corporation v. Microsoft.com aka Tarek Ahmed (WIPO Case No. D2000-0548) that concerns the disputed domain name <microsoft.com> and Microsoft Corporation v. Mike Rushton (WIPO Case No. D2004-0123) that concerns the disputed domain name <mikerosoft.net>, it was accepted that phonetic feature of the disputed domain name could be a factor for the finding that the disputed domain name was the same or confusingly similar to the mark of the Complainant. In Kabushiki Kaisha Toshiba D/B/A Toshiba
Corporation v. Cixi Jiasheng Electrical Appliance Co.Ltd.  pcz@public.cx.nbptt.zj.cn 86-574-63243638 (WIPO Case No.D2003-0460), the panel considered that the disputed domain name <hkdongzhi.com> was the same as or confusingly similar to the complainant’s trademark of “东芝” since the key component of that domain name, “dongzhi”, is the written format of “东芝” trademark used by the complainant in China, phonetically or in Latin characters.

In the disputed domain name <亚洲万里通.公司>/ <亚洲万里通.公司>, "公司" is the top level Chinese domain name and is one of these various types of top level Chinese domain names of ".中国", "公司" and ".网络". The remaining key component is “亚洲万里通” and“亚洲万里通”. Obviously, the part “亚洲万里通” in the disputed domain name is exactly the same with the registered trademark of the Complainant. Also, even for the simplified Chinese version of “亚洲万里通”, the disputed domain name was the same phonetically with the registered trademark of the Complainant. Moreover, whether for the traditional Chinese version or the simplified Chinese version of the disputed domain name, for Chinese users, they are the same or confusingly similar with the “亚洲万里通” mark which the Complainant has civil rights, whether in written format or phonetically.

In the circumstances, the Panel decides that the Complainant has satisfied the first condition under Article 8 of CNDRP.

Rights or Legitimate Interests of the Respondent

From the documents attached to the complaint, the Respondent is an entity named “Yunnan Province Taizhongshang Technology Development Limited” and its name has no connection with “亚洲万里通” or “亚洲万里通”. At the same time, the Respondent has not provided any evidence to show its business relationship, if any, with the Complainant or
the trademark owner, or put forward any reason to support its entitlement for the use of “亞洲萬里通” or “亚洲万里通”。 The Complainant however states that it has never authorized the use by the Respondent the “亞洲萬里通” mark or name as domain name or otherwise. To these assertions, the Respondent did not file any response to deny them.

Thus, the Panel decides that the Respondent does not have rights or legitimate interests over the disputed domain name or the major part of it.

**Bad Faith**

Article 9 of CNDRP provides that in any of following circumstances, the conduct of the holder of the domain name that is subject to the complaint amounts to registration or use of a domain name in bad faith:-

(i) the disputed domain name holder has registered or acquired the domain name for the purpose of selling, renting or otherwise transferring the domain name to obtain unjustified benefits;

(ii) the disputed domain name holder registered the domain name in order to prevent the owners of the name or mark from reflecting the name or the mark in a corresponding domain name, provided that the domain name holder has been engaged in a pattern of such conduct;

(iii) the disputed domain name holder has registered or acquired the domain name for the purpose of damaging the Complainant's reputation, disrupting the Complainant's normal business or creating confusion with the Complainant's name or mark so as to mislead the public;

(iv) other circumstances which may prove the bad faith.
Evidence from the Complainant show that the Respondent registered the disputed domain name without prior notice of the Complainant. It is obvious that, as the disputed domain name has been registered, the Complainant cannot reflect its mark or service using a corresponding domain name. Yet, the Complainant has registered Chinese domain names such as <亞洲萬里通.中國>/ <亚洲万里通. 中国> and <亞洲萬里通.cn>/ <亚洲万里通.cn>, for the promotion of its “Asia Miles” scheme. The Panel does not consider that this in itself is sufficient proof of bad faith under Article 9 of CNDRP.

In the case under UDRP of Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. D2000-0003), it shows clearly that the respondent’s non-action after registration was adequate to found bad faith in special circumstances. The panel in that case, in deciding bad faith use and registration on the part of the respondent, took into account the fact that the respondent registered the domain name with knowledge of the complainant’s right and that the respondent had not used the domain name in any way at all after registration. In Wal-Mart Stores, Inc. v. Thomson Hayner d/b/s Wireless Revolution d/b/a Latin Technologies (WIPO Case No. DAS2002-0001), the complainant’s mark was a well-known mark in the country where the respondent’ situated and the Panel in that case accordingly found that the respondent was with knowledge of the complainant’s mark when it registered the domain name. In Mondich and American Vintage Wine Biscuits, Inc. v. Brown d/b/a Big Daddy's Antiques (WIPO Case No. D2000-0004), the conduct that respondent did not make use of the domain name in its business a long time after its registration and that the respondent did not provide contrary evidence in rebuttal to the complainant’s allegations was taken into consideration in deciding whether the respondent was with bad faith.

The Respondent in this case is a company situated in Mainland China. Prior to the registration of the disputed domain name by the Respondent, the Complainant has already obtained trademark registration in Mainland China and Hong Kong. The Complainant also used the mark for the promotion of its frequent flyers scheme and the area of such
promotion covered Mainland China, where the Respondent situated. The Panel considers that, due to the promotion by the Complainant of the "亚洲万里通" in China, the Complainant’s mark of "亚洲万里通" was known to a certain extent in Mainland China when the Respondent registered the disputed domain name. Also, the phase "亚洲" is a geographic description and the phase "万里通" is not one in the daily language. In the absence of contrary evidence, the Panel does not believe that the Respondent registered the disputed domain name on its own without prior knowledge of the Complainant "亚洲万里通" mark. From the name and registered information of the Respondent, no connection can be found between the Respondent and the "亚洲万里通" mark or the disputed domain name. Thus, the Panel decides that the Respondent registered the disputed domain name with prior knowledge of the Complainant’s mark of "亚洲万里通".

Moreover, the Respondent has not used the disputed domain name in its business after it has been registered for 3 years. Also, as the Respondent did not have rights or legitimate interests over the disputed domain name or its major component, if the respondent uses the disputed domain name for its business, it will infringe the civil rights enjoyed by the complainant. In addition, the complainant cannot contact the respondent using the information provided during the registration of the disputed domain name. In Pharmacia & Upjohn AB v. Dario H. Romero (WIPO Case No. D2000-1273), the complainant's providing incorrect contact information at its website corresponding to the domain name was one of the supporting evidence for finding bad faith on the part of the respondent. To these assertion, the Respondent has further failed to provide contrary evidence in rebuttal.

In the premises of the special circumstances, the Panel decides that the respondent in this case has registered and uses the disputed domain name in bad faith.

5. Decision
Based on the above analysis, the Panel decides that: (1) the disputed domain name, <亞洲萬里通.公司>/<亞洲萬里通.公司> is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interests; (2) the Respondent has no right or legitimate interest in respect of the disputed domain name or major part of that domain name; (3) the Respondent has registered or is using the domain name in bad faith. Accordingly, the Panel decides that the disputed domain name, <亞洲萬里通.公司>/<亞洲萬里通.公司>, should be transferred to the Complainant.

Sole Panelist: Gary Soo 苏国良

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