Complainant: The Prudential Assurance Company Limited

Respondents: Beijing Cinet Information Co.

Domain Names: <prudential.com.cn>, <prudential.cn>

Registrar: HiChina Web Solutions (Beijing) Limited

1. Procedural History

The complainant in this case is The Prudential Assurance Company Limited, a company registered in England, United Kingdom. Its address is 142 Holborn Bars, London, EC1N 2NH, United Kingdom. Its authorized representative in these proceedings is Gabriela Kennedy of Lovells, Hong Kong.

The respondent is Beijing Cinet Information Company. Its address is No. 88 Jianguo Road, Chaoyang District, Beijing 100022, China. It has not appointed any representative in these proceedings.

The domain names in dispute are <prudential.com.cn> and <prudential.cn>. The Registrar of the domain names is HiChina Web Solutions (Beijing) Limited (“HiChina”), and its address is 3/F, HiChina Mansion, No. 27 Gulouwai Avenue, Dongcheng District, Beijing 100011, China.

On 16 October 2003, pursuant to the CNNIC Domain Name Dispute Resolution Policy (“the CNDRP”) of 30 September 2002 of the 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 Centre Domain Name Dispute Resolution Policy (“the HKIAC Supplemental Rules”), the Complainant submitted a complaint in the Chinese language to the Hong Kong International Arbitration Centre (“HKIAC”) and elected this case to be dealt with by a three-member Panel. On the same day, the HKIAC also received payment in the correct amount for the three-member panel. On 17 October 2003, the HKIAC sent to the Complainant by email an acknowledgement of the receipt of the Complaint and reviewed the format of the complaint for compliance with the CNDRP, the Rules and the HKIAC Supplemental Rules.

On 24 October 2003, the HKIAC notified the Respondent by email that a complaint had been filed against them.

On 3 November 2003, the HKIAC served a Notification of Commencement of Proceedings on the Respondent. The Notification stated that the Respondent had twenty
calendar days from 3 November 2003 to submit a response to the complaint. The Respondent failed to submit a response within the required time.

On 17 October 2003 and again on 20, 21 and 23 October 2003, the HKIAC requested HiChina to confirm that the domain names at issue were registered by the Respondent. On 23 October 2003, HiChina confirmed that the domain names at issue were registered by Mr. Sun Jie on behalf of the Respondent.

On 24 November 2003, the HKIAC informed the Respondent that a response from them had not been submitted within the time specified in the Rules, the HKIAC Supplemental Rules, and that stated in the Notification of Commencement of Proceedings. Since the Respondent did not file a response in accordance with the time specified, the HKIAC appointed a Panel to proceed to render the decision.

On 5 December 2003, the HKIAC informed the three members of the Panel, Mr. Michael Hwang, Ms. Xue Hong and Mr Paul Stephenson of their appointment in this case. The Panel determines that the appointment was made in accordance with Rules, Article 26(ii).

On 8 December 2003, the HKIAC transferred the files of this case to the Panel.

2. Factual Background

For the Complainant

The Complainant is a corporation and is in the business of insurance. It also provides financial and fund management services, valuation services, investment management services, pension fund management, asset consultancy and unit trust services. The Complainant is a leading global financial services company, employing more than 20,000 people and has more than 13 million clients worldwide. The Complainant has registered the trademark PRUDENTIAL in more than 42 countries around the world, including China. Complaint, Tab J. The Prudential trademark was registered in China in 1995. Complaint, Tab K and L.

The Complainant set up its first office in China in 1994. In 2000, Prudential set up CITIC-Prudential Life Insurance Company (“China Prudential”) to manage its business in China. Prudential’s products in China includes 11 types of life insurance policies and 17 other types of insurance products. Prudential was ranked amongst 100 top brands by various Chinese websites, such as <ezhon.net> and <economy.enorth.com.cn>. Complaint, Tab C. China Prudential has 600,000 clients in China and employs 230 people.

The Complainant has registered about 90 domain names with the Prudential trademark, including <prudential.co.uk>, <prudential.org.cn>, <prudential.net.cn> and <citic-prudential.com.cn>. Complaint, Tab M.
For the Respondent

The Respondent registered the domain names <prudential.com.cn> on 6 May 1999 and on 17 March 2003, became the registrant of the domain name <prudential.cn>.

3. Parties’ Contentions

The Complainant

The Complainant asserts that the domain names at issue are identical or confusingly similar to its own registered trademark, in that both domain names contain as their major component the Complainant’s registered trademark.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the domain names or major part of the domain names. The Complainant argues that the disputed domain names have not been used for any working website and that it has not allowed or consented to the Respondent registering or using these domain names for business or any other purposes. The Complainant further argues that the Respondent does not have any registered trademark relating to the “Prudential” name, and that at the time when the Complainant registered the Prudential trademark in China, there was no indication that the Respondent had registered any trademark relating to Prudential. Lastly, the Complainant argues that the Respondent engages in the business of information technology and is an internet service provider, and that the Respondent has not used the name “Prudential” in any part of its businesses, services or products.

Finally, the Complainant alleges that the domain names at issue have been registered or are being used in bad faith. The Complainant sets out three supporting arguments:

Firstly, the Complainant argues that the Respondent registered the disputed domain names with the intention of selling or transferring them for unjustified benefits. The Complainant alleges the following facts. On 16 November 2001, the Complainant, authorised its lawyer Ms. Vivian Lui to enquire with the Respondent as to the possible sale of the domain name <prudential.com.cn>. On 23 November 2001, Ms. Lui contacted Ms. Zhang Jie of the Respondent company, and enquired about the price of the domain name <prudential.com.cn>. Ms. Lui suggested the price of US$2000 for the domain name. Ms. Zhang then requested Ms. Lui to send her an email setting out the proposal for the transaction. On 12 December 2001, Ms. Lui contacted Ms. Zhang, who informed Ms. Lui that her company will not be selling the domain name and intends to retain the domain name for its own use. Complaint, Tab O.

Secondly, the Complainant argues that the Respondent registered the disputed domain names in order to prevent the Complainant from reflecting the Prudential name in a corresponding domain name. The Complainant asserts that the Respondent has established a pattern of such conduct in the past. In support of this, the Complainant attaches a printout of a list of domain name disputes filed with the China International Economic and Trade Arbitration Centre (“CIETAC”) against the Respondent which lists out 11 such complaints involving well known trademarks such as Vogue, Allure, Oreo.
and Homedepot. Of these 11 complaints, 9 found that the Respondent had registered the respective domain names in bad faith. *Complaint, Tab S.* Further, the Chinese courts have also ruled against the Respondent in a number of domain name disputes involving the names of IKEA, Dupont, Cartier and Whisper. *Complaint, Tab T and U.*

Thirdly, the Complainant argues that the disputed domain names are not currently in use, nor have they ever been used for any working website. The Complainant also argues that it has not found any evidence of the Respondent’s use of the disputed domain names or that a website has been created with these domain names.

*The Respondent*

The Respondent did not file a response within the stipulated time.

4. **Findings**

   **A. Respondent in Default**

   The Rules, Article 31 provides that “If a Respondent does not submit a response, the Panel shall, in absence of exceptional circumstances, decide the dispute based upon the complaint.” Further, the Rules, Article 34 provides that “In the event that a party, in the absence of exceptional circumstances, does not comply with any of the provisions established by these Rules or any of the time periods fixed by the Panel, the Panel shall proceed to a decision on the complaint.” The Panel finds no exceptional circumstances to exist, and it will proceed to determine the dispute based upon the complaint.

   **B. The Language of the Proceedings**

   Article 6 of the CNDRP provides that “The language of the domain name dispute resolution proceeding shall be Chinese, unless otherwise agreed by the parties or determined by the Panel.” Article 8 of the Rules also provides that “Unless otherwise agreed by the Parties or determined in exceptional cases by the Panel, the language of the domain name dispute resolution proceedings shall be in Chinese.”

   In the present case, the domain names are in the English language, the Complainant is an English company and the communications between the HKIAC and the Panelists, Complainant and Respondent were all in the English language. The Panel finds that the above facts constitute a sufficiently exceptional case, and the Panel determines that the language of the proceedings shall be English.

   **C. The Merits**

   Article 8 of the CNDRP provides that a complaint filed 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 Complainant 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 using 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.

Article 31 of the Rules provides that “The Panel shall…decide a complaint on the basis of the statements and documents submitted and in accordance with CNNIC DRP, as well as any rules and principles of law which it deems applicable.”

In applying the CNDRP and the Rules, the Panel will refer to prior HKIAC Administrative Panel decisions as well as CIETAC decisions for guidance, as both tribunals apply the same rules.

Based on the Complaint and the supporting documents submitted by the Complainant, the CNDRP, and the Rules, this Panel finds as follows:

1) Identical or Confusing Similarity

The Respondent registered the domain name <prudential.com.cn> on 6 May 1999 and became the registrant of the domain name <prudential.cn> on 17 March 2003. However, the Complainant has been registered as “The Prudential Assurance Company” since 1881, and the name “Prudential” was used by Prudential as early as 1848. Therefore, the “Prudential” name has been used by the Complainant for more than 150 years now. Further, the Complainant has registered the Prudential trademark in more than 42 countries around the world, including India, Japan, Hong Kong, France, Germany, Israel and England, and in 1995, the Complainant registered the Prudential trademark in China. The Prudential trademark is an internationally recognised brand name, having built up its name and reputation through vigorous campaigns and advertisements throughout the past. Since 2000, this campaign was extended to China. Complaint, Tab E, F, G & H.

The Respondent has failed to submit a response objecting that the Complainant has civil rights or interests in the Prudential name or mark. The Panel considers that the Complainant is in possession of the civil rights against the “Prudential” name or mark as required under Article 8(i) of CNDRP.

In the disputed domain names of <prudential.com.cn> and <prudential.cn>, “.cn” is the country code domain name, while “.com” is the secondary generic domain name. The Panel finds that the remaining part, after taking out the “.cn” country code domain name and the “.com” secondary generic domain name, is identical to or
confusingly similar to the Complainant’s mark. *Maxtor Corporation v Shenyang Shixin Co., Ltd.*, HKIAC Case No. DCN-0300001; *Hewlett-Packard Company v Mohammad Hossein Erfani and the Kotobi Group*, HKIAC Case No. DCN-0300005

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

2) **Rights or Legitimate Interests of Respondent**

From the documents attached to the Complaint, the Respondent is a company named “Beijing Cinet Information Co.”, which has no connection with the “Prudential” name at all. The Complaint asserts that the Respondent engages in the business of information technology and is an internet service provider. None of its businesses, services and products are in the “Prudential” mark or name. Further, the Complainant asserts that there is no evidence that the Respondent has put to use the disputed domain names, and that it has not given any consent or allowed the Respondent to use or register the disputed domain names. The Complainant also asserts that the Respondent does not have any registered trademark in the Prudential name. To these assertions, the Respondent has failed to submit a Response to deny them, and has thus failed to provide any evidence that the assertions are untrue.

Accordingly, the Panel decides that the Complainant has satisfied the second condition under Article 8 of the CNDRP.

3) **Bad Faith**

Article 9 of the CNDRP provides that in any of the 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 where:-

(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.

The evidence from the Complainant indicates that the Respondent was willing to sell the disputed domain name <prudential.com.cn>, even though there was no eventual sale. The Complainant’s lawyer Ms. Vivian Lui offered Ms. Zhange Jie of the
Respondent company US$2000 for the domain name, to which Ms. Zhang requested Ms. Lui to email to her the proposal for the transaction. The Complainant asserts that the Respondent did ask Ms. Lui to name a price for the sale of the domain name. Further, the Complainant asserts that because the Respondent has already been made a party in various similar complaints in which the Respondent was found to have registered domain names in bad faith, the Respondent was very careful in not stating the price for the domain names. The Complainant also asserts that the Respondent in refusing to accept the US$2000 proposal for the sale of the domain name, had not only the intention of recovering the costs of registration of the domain name, but also the intention of obtaining unjustified benefits.

The Panel finds that the above facts amount to evidence of the Respondent registering the disputed domain names in bad faith in violation of CNDRP Article 9(i).

The Complainant also asserts that the Respondent registered the disputed domain names in order to prevent the Complainant from reflecting the Prudential name or mark in a corresponding domain name, and that the Respondent has established a pattern of conduct, as evidenced by past complaints against it, most of which have been successful against the Respondent.

In support of its contentions, the Complainant relies on three cases decided by CIETAC. The Panel considers that the principles in these cases are applicable to the present case. The cases are as follows: In Case No. DN20010006, CIETAC found that to sell the disputed domain names in that case for a profit amounts to registration of those domain names in bad faith. In Case No. CND0300017, CIETAC found that the registration of the disputed domain names in that case prevented the Complainant from reflecting the “Caesars World” name or mark in a corresponding domain name, and that amounted to registration of those domain names in bad faith. Lastly, in Case No. CND0300008, CIETAC decided that bad faith could be inferred where there is no evidence of use of the disputed domain names.

5. Decision

Based on the above analysis, the Panel decides that: (1) the disputed domain names are 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, pursuant to CNDRP Article 13 the Panel decides that the disputed domain names, <prudential.com.cn> and <prudential.cn>, should be transferred to the Complainant.

22 December 2003       Presiding Panelist: Michael Hwang
                         Co-Panelists: Xue Hong, Paul Stephenson