



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

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| Case No. | HK-1300549 |
| Complainant: | Hong Kong Trade Development Council |
| Respondent: | Rocmary Media Group |
| Disputed Domain Name: | <almc.com> |

1. The Parties and Disputed Domain Name

The Complainant is Hong Kong Trade Development Council of 38/F Office Tower, Convention Plaza, 1 Harbour Road, Wanchai, Hong Kong. It is internally represented.

The Respondent is Rocmary Media Group of 311 Beach Road, Gilford, Ontario, L0L 1R0, Canada. It is represented by David E. Weslow of Wiley Rein LLP.

The domain name at issue is <almc.com>, registered by the Respondent with GoDaddy.com LLC of 14455 N. Hayden Road, Ste. 226, Scottsdale, AZ 85260, USA (the "Registrar").

2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (the "Centre") on 4 October 2013. On 7 October 2013, the Centre transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On 8 October 2013 the Registrar transmitted by email to the Centre its verification response confirming that the Respondent is listed as the registrant of the Disputed Domain Name and providing the Respondent's contact details.

The Centre has verified that the Complaint satisfies the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules of Procedure under the Policy (the "Rules") and the Centre's Supplemental Rules. In accordance with the Rules, the Centre formally notified the Respondent of the Complaint and the proceeding commenced on 8 October 2013.

In compliance with the Rules to submit a response within 20 days of commencement of the Complaint (i.e. 28 October 2013), the Respondent has submitted its Response and Annexure to the Centre and the Complainant on 25 October 2013.

The Centre appointed Mr Peter Bullock as the Sole Panelist in this matter on 31 October 2013. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

The Complainant is a statutory body corporate in Hong Kong, established in 1966 pursuant to the Hong Kong Trade Development Council Ordinance (Cap. 1114). Its functions include the promotion and development of Hong Kong's trade. It has co-organised the Asian Logistics and Maritime Conference (the "**Conference**") with the Government of Hong Kong every year since 2011. The Conference has attracted international logistics and maritime service providers and businesses or users who are in search of such service providers.

The Complainant currently owns two trademarks. One trademark consisted of a "ALMC" logo together with the words "Asian Logistics and Maritime Conference" and its Chinese counterpart translation "亞洲物流及航運會議", and was registered on 17 April 2013 (the "**First Trademark**"). The other trademark, which was pending registration at the time this dispute arose, subsequently became registered on 21 August 2013, and consisted of the letters "almc" and "ALMC" (the "**Second Trademark**", and together with the First Trademark, the "**Trademarks**").

The Respondent is a Canadian company engaged in the business of registering short generic non-trademark domain names and it profits by selling or renting such domain names. Correspondence between the parties indicated that the Respondent purchased the Disputed Domain Name by way of auction on 18 September 2012.

The Disputed Domain Name was registered on 15 September 2012.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Disputed Domain Name is identical or confusingly similar to the Trademarks.
- ii. The Conference is a widely publicised event and is well acquainted to the public and mass media. Its abbreviation "ALMC" allows the public to associate it with the Conference.
- iii. The Respondent does not have legitimate rights to the Disputed Domain Name because the Disputed Domain Name: (1) is linked to a page full of advertising links, (2) is not used in connection with a bona fide offering of goods or services, and (3) has nothing to do with the functions or business activities of the Respondent.

- iv. The Disputed Domain Name was being used in bad faith because the Respondent has intentionally attempted to attract internet users to the site and attempted to make a commercial gain by offering to sell it or putting it on auction.

B. Respondent

The Respondent's contentions may be summarized as follows:

- i. The Complainant does not have rights in the Trademarks because: (1) a pending trademark application does not establish rights in a trademark, (2) a full trademark name does not automatically translate to rights in an abbreviation, (3) the Conference was only attended by 1,000 customers and was marketed under the name of "Asia Logistics and Maritime Conference" and not "ALMC", and (4) such limited use of "ALMC" does not establish common law rights in Hong Kong, nor Canada where the Respondent is located.
- ii. The Respondent has rights in respect of the Disputed Domain Name because: (1) the business of registering domain names to generate income is a legitimate business, and (2) the Respondent did not capitalise on the Trademarks as the website of the Disputed Domain Name does not contain any content or advertising links related to the Complainant.
- iii. The Respondent's registration and use of the Disputed Domain Name are not in bad faith because: (1) the registration of the Disputed Domain Name was made prior to the Complainant acquiring rights in the Trademarks and therefore the Respondent has no knowledge of the Trademarks, and (2) the purpose of registering the Disputed Domain Name was to offer to sell it to the wider public and the Respondent did not purposely target the Complainant.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

The Panel will first deal with the Second Trademark. There is no doubt that it is identical to the Disputed Domain Name. The issue is whether its status as a pending application at the time of the dispute and later becoming effective now has any bearing on the Panel's decision.

The Respondent has cited *Koç Holding A.S. v. MarketWeb A.S.* (WIPO Case No. D2000-1764) which stated that a pending application does not establish rights in a trademark. However, this authority can be distinguished with the facts of the current dispute.

The Complaint materials submitted by the Complainant indicated that the Second Trademark was published in the Hong Kong Intellectual Property Journal on 10 May 2013. Therefore, the Respondent was fully aware of the pending registration of the Second Trademark at the time of submitting its Response Form. The Panel would have expected the Respondent, who has legal representation, to conduct a search at a public registry for the status of registration (such as the Hong Kong IPD Online Search System at <http://ipsearch.ipd.gov.hk/index.html>), which would have revealed that the Second Trademark has become registered four days before the Respondent submitted its Response.

The Respondent is not correct to state in its Response that "the Complainant did not, and still does not, have rights in the English letters ALMC".

Nonetheless, according to the consensus view to Question 1.4 of the WIPO Overview 2.0:

"Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the Policy. The Policy makes no specific reference to the date on which the holder of the trademark or service mark acquired rights. However, in such circumstances it may be difficult to prove that the domain name was registered in bad faith under the third element of the UDRP".

Taking the consensus view, the Panel finds that the Complainant has rights in the Second Trademark and it is identical to the Disputed Domain Name. Consequently, the Panel finds it unnecessary to deal with the First Trademark as paragraph 4(a) of the Policy is satisfied.

B) Rights and Legitimate Interests

Question 2.1 of the WIPO Overview 2.0 states the consensus view that once a complainant makes a prima facie case in respect of the lack of rights or legitimate interests of the respondent, the respondent carries the burden of production to demonstrate it has rights or legitimate interests in the domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

It can be seen from the evidence that the Respondent is not connected or associated with the Complainant's business and is not on any other basis licensed or authorised to use the Trademarks. Further, the Respondent is not known by the "ALMC" name. Accordingly, the Panel finds that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name and therefore the Respondent now has the burden of demonstrating that it does possess such rights or legitimate interests.

The Respondent cited *Baccarat SA v. Admin - Oversee Domain Management, LLC* (WIPO Case No. D2013-0317) and argued that it acquired rights or legitimate interests in the Disputed Domain Name through use of the Disputed Domain Name in connection with a bona fide offering of goods or services.

The Panel has considered such authority and accepts that selling domain names with a profit or putting them on auction may be a legitimate business, but further scrutiny is still required. The Panel notes that the current website under the Disputed Domain Name is drastically different from the screenshot submitted by the Claimant. It now links to the website of the Rocmary Investment Group (presumably an affiliate of the Respondent) and shows an inquiry form which allows the public to submit a purchase or lease inquiry regarding internet domain names.

Turning to the screenshot submitted by the Claimant which was captured on 8 August 2013, it can be seen that the website mainly consists of advertising links for job openings and a search box for searching advertisements. At the top of the webpage is a notice which stated "ALMC.com is currently available to purchase or lease. Click here to inquire".

Although unable to verify the webpages that the job advertising links or the notice may lead to, the Panel have considered the brevity of content and in the absence of any apparent evidence that the Respondent is targeting the Complainant in any way through use of the Disputed Domain Name, the Panel is prepared to find that the Respondent's use of the Disputed Domain Name and its underlying website to offer to sell or lease domain names constitute legitimate use under the Policy. (see *Incase Designs Corp. v. Lakeside Enterprises Limited*, WIPO Case No. D2012-1700; *Manga Films SL v Name Administration Inc*, WIPO Case No. D2005-0730)

It was also noted by the Panel in *PwC Business Trust v. Ultimate Search* (WIPO Case No: D2002-0087) that there was nothing in the Policy or in current ICANN registrar registration agreements which prohibits the registration of domain names incorporating common words, generic terms, short terms, and useful phrases for the purpose of paid advertising.

The Panel accordingly finds that the Complainant has not satisfied paragraph 4(a)(ii) of the Policy in respect of the Disputed Domain Name.

C) Bad Faith

While it is not necessary for the Panel to discuss the Complaint further, the Panel would also note that the Respondent has not acted in bad faith when registering or using the Disputed Domain Name.

The registration of the Disputed Domain Name predates the registration of the Trademarks and considering that the Disputed Domain Name is generic, therefore the question of bad faith registration must be answered negatively.

While registering a domain name for the purpose of selling or renting it may be a legitimate business, it would be considered bad faith under paragraph 4(b)(i) of the Policy if the primary purpose was to sell or rent it to the trademark owner.

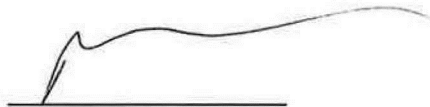
The Panel notes that the Respondent did not contact the Complainant prior to the Complaint and has offered to sell the Disputed Domain Name at a discount (compared to the auction price) only when upon receipt of Notice of Complaint from the Centre. Having considered the circumstances and the relevant correspondence, the Panel finds that the offer made by the Respondent is not in bad faith.

It would also be considered bad faith if the use of a domain name creates a likelihood of confusion with the complainant's trademark as to source, sponsorship, affiliation, or endorsement under paragraph 4(b)(iv) of the Policy.

The Panel finds that the letters "ALMC" does not solely indicate affiliation with the Conference. An Internet search shows that "ALMC" could be related to many other corporations, institutions or bodies around the world. While it may be possible that the letters "ALMC" may cause the customers or exhibitors who attended the Conference in Hong Kong to associate it with the Complainant or the Conference, it is certainly not the case outside of Hong Kong. Therefore, having considered earlier the legitimate use by the Respondent, the Panel does not find any bad faith in the use of the Disputed Domain Name.

6. Decision

For the foregoing reasons, the Complainant has failed to meet its burden to establish all of the elements in the Complaint. The Complaint is dismissed.



Peter Bullock
Sole Panelist

Dated: 13 November 2013