

亞洲域名爭議解決中心
ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

Decision Submission

Decision ID	
Case ID	HK-0300030
Disputed Domain Name	jsm.com
Case Administrator	Iris Wong
Submitted By	Edward C. Chiasson, Q.C.
Participated Panelists	Edward C. Chiasson, Q.C., Arthur Chang, David Sandborg
Date of Decision	November 20, 2003
Claimant	Johnson Stokes & Master Holding Ltd (BVI)
Respondent	Kingdom Way Ltd.

Procedural History

On August 14, 2003, the Complainant submitted its Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (the “ADNDRC” or the “Centre”), in accordance with the Uniform Domain Name Dispute Resolution Policy (the “Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the “Rules”), and ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy Disputes (the “ADNDRC Supplemental Rules”). The Complainant sought a panel of three.

On August 14, 2003, the Centre received the required filing fee from the Complainant and confirmed the receipt of the Complaint and on the same day the Centre forwarded a copy of the Complaint to the Respondent by on-line system and email as well as a copy of the Complaint by on-line system and email to the Registrar of the domain name in dispute, Register.Com, 575-8th Ave – 11th Floor, New York, NY 10018, United States of America.

The Respondent filed a Response with the Centre on September 5, 2003.

After confirming their independence and impartiality, on September 24, 2003 the Centre informed the Complainant and the Respondent that Edward C. Chiasson, Q.C., David Sandborg and Arthur Chang were appointed as Panellists in this matter.

On September 24, 2003, the Centre transferred the case file to the Panellists by post.

The Panellists find that the Administrative Panel was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

The Administrative Panel did not receive any requests from the Parties for additional submissions, but the Administrative Panel itself asked for, received and has considered supplemental submissions on the issue of bad faith. There is no need, as an exceptional matter, to hold any in-person hearings as necessary for deciding the Complaint, as provided for in Paragraphs 12 and 13 of the Rules.

As a result of the additional submissions concerning bad faith and communication difficulties associated with receiving them, the Administrative Panel extended the time for its decision to November 21, 2003.

The language of the proceeding is English, it being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and there being no express agreement to the contrary by the parties.

Factual Background

For Claimant

The following information derives from the Complaint.

The Complaint is based on the Complainant's registrations of the mark "JSM" ("Mark") in respect of legal consultancy and research services; intellectual property consultancy services in Hong Kong and China. Pursuant to an Assignment dated March 7, 2003, the Hong Kong trademark registration under registration no. B16771/2000 for the Mark ("Hong Kong Registration") together with the goodwill of the business was assigned to the Complainant by Johnson Stokes & Master ("Firm").

The Firm is the largest law firm in Hong Kong and one of Asia's leading law practices. The Firm's head office is in Hong Kong and it has offices in Beijing, Shanghai, Hanoi, Ho Chi Minh City and Bangkok, with over 230 lawyers.

The Firm was established by the late Mr. Edmund Sharp in 1863, who was joined by the late Mr. Alfred Johnson in 1876. In 1895, the late Messrs Alfred Stokes and Godfrey Master joined as supporting partners. On the retirement of the founder in 1890, the practice adopted the name "Johnson Stokes & Master" which it still bears today. The book "Partners in Law", written by Katherine Mattock and published in 1990, set out the history of the Firm.

The Firm has a reputation throughout Asia for its ability to offer clients constructive advice on most commercial issues including: aviation; banking and finance; collective investment schemes; construction; corporate finance; corporate restructuring and insolvency; e-business; employment and employee benefits; environmental law; general commercial; hospitality and leisure; insurance; project finance; probate; shipping and maritime law; intellectual property; litigation and arbitration; PRC law; property; telecommunications; tax and trust.

The Firm was voted "Hong Kong Law Firm of the Year" in 2000 and 2001 in the Asian Law Award and by the International Financial Law Review and, for the third year in a row, at the 2002 Asian Legal Business Awards.

The Firm is actively involved in the legal and economic affairs of Hong Kong and the other countries where it has offices through participation in professional and commercial associations. Members of the Complainant hold positions in the Law Society of Hong Kong. They also serve on and assist committees representing other professional and commercial bodies such as the Hong Kong General Chamber of Commerce, the Hong Kong Shipowners' Association, the Hong Kong branch of the International Fiscal Association, the Hong Kong Equipment Leasing Association, the Hong Kong Institute of Trade Mark Practitioners, Asian Patent Attorneys Association, the Hong Kong Retirement Schemes Association and the Global Alliance for eCommerce Law.

In Mainland China, the Firm contributes advisory papers on legislative changes and is actively involved in principal Chambers of Commerce in Mainland China.

In Thailand and Vietnam, the Firm regularly meets with government officials to discuss the development of legislation and current issues and is a member of business groups involving the local and international commercial community.

Internationally, the Firm has an active role in many professional organizations such as the International Bar Association, the Inter-Pacific Bar Association, the International Federation of Commercial Arbitration Institutions and the International Trademark Association. The Firm is also the Hong Kong representative for Lex Mundi, the world's leading association of independent law firms.

In addition to registration, the Firm has established a protectable reputation in the Mark through extensive use. The Complainant continues to use the Mark under licence by and for its benefit.

The Firm has registered, *inter alia*, the domain names "jsm.com.hk" on 25 August 1995 and "jsm-law.com" on November 7, 2000.

The internet site to which the subject domain name resolves is only a simple one-page website which operates as a mini search engine and provides hyperlinks to others' websites.

The only use of the subject domain name is to direct users to other sites. At times, the Respondent's website gives no response by clicking any links or entering any keywords into the search engine and hence has no substantial function or content at all.

The subject domain name is not the registered name of the Respondent. The Respondent is not commonly known by the subject domain name.

The website to which the subject domain name resolves contains categories of hyperlinks such as 'real estate', 'home loan' and 'home buying'.

The administrative contact of the Respondent is Thomas Tse whose email address is thomas@ytt.com.hk. Ytt.com.hk is the domain name of a Hong Kong law firm, Messrs Yip Tse Tang. The Respondent's registered address is the same as that of Messrs Yip Tse Tang. Thomas Tse likely is Thomas Lin Chung Tse who is a partner of Messrs Yip Tse Tang and is a solicitor admitted in Hong Kong since 1991.

A cease and desist letter and reminder were sent to the Respondent on March 14 and 25, 2003, but the Respondent failed to respond to either.

In its supplemental submission concerning bad faith, the Complainant submits that the Respondent is owned, operated or controlled by Mr. Thomas Tse or by Messrs Yip Tse & Tang.

The Respondent's two directors and shareholders are: Topart International Limited and Topart Secretarial Limited. The domain name "thomastse.com" incorporates the name of Thomas Tse. A whois search reveals the particulars of the registrant of "thomastse.com" as:

Topart International Limited
Thomas Tse
Unit C, 20/F China Overseas Building
139 Hennessy Road, Wanchai, HK
Phone: 2866 8080

The web address to which thomastse.com resolves is directed to a website called "Solicitor Online" operated by Thomas Tse and Messrs Yip Tse & Tang.

The Complainant provided examples illustrating that Mr. Thomas Tse and Messrs. Yip, Tse & Tang are active on the internet concerning legal matters.

The Respondent is using the web site to which the subject domain name resolves for financial gain as is shown by the inclusion on the site of a banners relating to advertising on the internet.

In addition, at the web site there are links to other activities including “online casino”, “cellular.com”, “homes for sale”, “health”, “cars”, “printers”, “doctors”, “marketing”, “loans”, “tickets” and “music”.

Commercial ventures also are displayed. For example, there is a link to Applied Semantics, a company that offers a service called “DomainPark”, which “...delivers targeted, conceptually related keywords and advertisements to parked domain name pages by ‘understanding’ the intent/purpose of each domain name. Powered by Applied Semantics’ CIRCA Technology”.

Thomas Tse and Messrs Yip, Tse & Tang are competitors of the Firm. Apart from practising personal insolvency and personal injuries law as stated by the Respondent in the Response, Thomas Tse and Messrs Yip, Tse & Tang also offer legal services in other areas such as information technology, building management and other general areas of practice.

For Respondent

The following information derives from the Response.

The Complainant is not a law firm and its offering of legal consultancy services in Hong Kong is illegal because it is not a law firm registered with the Law Society of Hong Kong. The Complainant is a limited company registered in the British Virgin Island. The Respondent reserves its right to report the matter by complaint to the Law Society of Hong Kong and the Department of Justice for investigation.

The Complainant does not offer any legal consultation services. Alternatively, the Complainant’s offering of any legal consultation services in Hong Kong would be illegal because the Complainant is not a law firm.

The subject domain name was registered by the Respondent’s predecessor-in-title on September 23, 1998.

The Mark was filed for registration on September 10, 1999. The actual date of registration was December 21, 2000. The Mark was registered by the Firm. The Mark was assigned by the Firm to the Complainant on March 25, 2003.

The website to which the subject domain name resolves operates as a mini search engine and provides hyperlinks to other websites.

The firm assigned on the same date of the reminder letter the Mark to the Complainant, which then initiated the present proceedings.

The Respondent is using the subject domain name for free search service on the internet. JSM is a simple three-letter word easy to remember and quick to type. It enables users quick access to the website.

The subject domain name was registered by the Respondent’s predecessor-in-title W. Royal and not by the Respondent. W. Royal resides in the United States and when it was registered, “W. Royal should have never heard of the Complainant or the Mark”. The subject domain name was purchased by the Respondent with consideration.

The trademark search result at the Trademark Electronic Search System (TESS) in the United States yielded 3 records (one live and two dead) bearing JSM, but also having no affiliation with the Complainant.

The three-letter term JSM is in common use by many people with no affiliation with the Complainant. A google.com search on "JSM" yielded over 155,000 results having no affiliation with the Complainant.

The Respondent never intends to sell the subject domain name to the Complainant and has not approached the Complainant or any competitor of the Complainant to sell the subject domain name.

The Complainant does not own a domain name except the Mark. The Complainant has no presence on the internet.

There is no evidence that the Firm's business has been disrupted. The Firm has been using jsm.com.hk and jsm-law.com on the internet. There is no evidence that because the subject domain name does not lead to the Firm's web-site, the Complainant or the Firm has lost any business.

The Firm has been content to use jsm.com.hk and jsm-law.com, despite the fact that it has known that the Respondent's predecessor-in-title had registered the subject domain name.

Thomas Tse is a partner of Yip, Tse & Tang. The Respondent is a client of Thomas Tse. The administrative contact is purely an administrative contact.

Yip, Tse & Tang provides legal services. It is not a competitor of the Firm. Internet users are not attracted or diverted for Yip, Tse & Tang's benefits. Yip, Tse & Tang is not interested in getting the Firm's clients. Yip, Tse & Tang's core practice, as shown on its web-sites are personal insolvency (acting for debtors only) and personal injuries (acting for claimants only).

In its supplemental submission concerning bad faith, the Respondent admitted the domain name and web site information provided by the Complainant, but says that Mt. Thomas Tse is merely the administrative contact for the subject domain name and that it is not used by him of Yip, Tse & Yang in the context of legal practice.

The Respondent denies bad faith. And says that since the acquisition of the subject domain name by purchase, the Respondent has received no money or any other commercial gain out of the ownership. The advertising banners, the links and any other advertising materials do not benefit the Respondent whether in terms of monetary or non-monetary return. The Respondent does not contemplate or intend to get any return out of it whether by revenue or otherwise. The search service is free because the users are not required to pay anything to the Respondent.

The Respondent asserts that the subject domain name is owned by a separate legal entity and not by Mr. Thomas Tse or Yip, Tse & Yang.

The Respondent denies that Yip, Tse & Yang is a competitor of the Firm stating that other large legal practices likely would be.

Parties' Contentions

Claimant

The Complainant is the assignee from the Firm of the Mark “JSM”. It relies on this right and on the long-standing use of SJM by the firm. The Complainant contends that the subject domain name is identical to the Mark.

The Complainant contends that the Respondent does not have a legitimate interest in the subject domain name and points to the Complainant’s position in the legal community, the use of the subject domain name in a legal context and the possible link between another law firm and the Respondent.

Bad faith is said to derive from many of the same facts. It is asserted that users of the internet will be confused and the reputation and business of the Firm damaged.

Respondent

The Respondent asserts that the Complainant is guilty of reverse domain name hijacking because the subject domain name was registered before the Complainant acquired an interest in the Mark.

The subject domain name is suffixed by .com which is conventionally considered to be an international domain name. The Complainant only owns the Mark, but the Mark is not used by it but by the Firm, which is not the Complainant. The use of the Mark is not international in character. The Firm is a regional law firm and not an international law firm. It grew up in Hong Kong and started as a local law firm.

The Respondent notes that it uses the subject domain name. It denies any inappropriate connection between it and a law firm in Hong Kong.

Bad faith is denied. The Respondent says that the entity that registered the subject domain name is in the United States and suggests that it did not know the Firm or Complainant at the time of registration. Use of subject domain name to harm the Complainant is denied

Bad faith and reverse hijacking are alleged against the Complainant.

Discussion and Findings

The Policy requires a complainant to establish that:

- (i) the domain name which is the subject of the dispute is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the registered holder of the disputed domain name has no rights or legitimate interests in respect of the domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Complainant refers to previous domain name dispute decisions. While these are neither controlling nor binding of the Administrative Panel, reference to them can be of assistance.

This dispute must be resolved in the context of the Policy based on the information provided to the Administrative Panel.

Identical / Confusingly Similar

The Respondent contends that the Complainant has no rights because it does not practise law in Hong Kong or if it were to do so, it would violate Hong Kong law. The contention has no relevance to the resolution of this dispute.

The assignment of the Mark and goodwill of the Firm to the Complainant gave standing to the Complainant to maintain this proceeding. The inquiry is whether the subject domain name is identical to the Mark. Clearly it is.

The subject domain name differs from the Mark only by the addition of .com, which is of no consequence.

The Administrative Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(i).

Rights and Legitimate Interests

The Respondent states that it is using the subject domain name through the website to which it resolves. The difficulty is that some of the use appears to be in the context of the provision of legal services. There are references to hyperlinks dealing with “real estate”, “home loans” and “home buying”. The Complainant asserts that these refer to legal consulting services. The Respondent counters saying, “because the complainant is not a law firm, those categories of the hyperlinks cannot create the alleged impression”.

The Respondent notes its size relative to the position of the Firm in the marketplace and contends that it is not a competitor of the Complainant. Size is merely one factor in competition. The legal marketplace is not large. All law firms that provide a broadly based legal service compete, more or less, with each other.

Competition as such does not lead to the lack of a legitimate interest in a domain name, but the use of the Mark of another without qualification militates against legitimacy.

The Respondent notes that the subject domain name was registered before the Mark was registered, but the Firm had long used JSM and was well established in the regional legal community.

The assertion that the use of .com, which often is found internationally in contra-distinction to the Firm as a regional presence, is without merit. The designation .com is not limited to international undertakings and the use of the subject domain name is within the normal operating sphere of the Complainant.

It is clear that there is a direct link between the Respondent and Mr. Thomas Tse, if not the firm of Yip, Tse & Yang. There can be no doubt that when it acquired the subject domain name, the Respondent was aware of the Firm. It offers no explanation why it acquired the subject domain name which is identical to the Complainant’s mark.

The Respondent notes that there are many other examples of the use of “jsm” and that the Complainant is attempting a reverse hijacking and seeking a monopoly on the use of “jsm”.

The Complainant has rights to the mark. Whether some uses of the mark and some combinations of words incorporating “jsm” would be legitimate are considerations for other circumstances. In this case, the use of “jsm” is unqualified. It is in the locale and marketplace in which the Complainant principally uses its mark.

The Administrative Tribunal is satisfied that the Complainant has met the requirements of paragraph 4(a)(ii).

Bad Faith

The Respondent's contention that the Complainant is attempting a reverse hijacking is without foundation. It is anchored, in part, on the fact that the Complainant does not practise law, a factor which the Administrative Panel considers to be irrelevant. The historical presence of the Firm and the identification of the subject domain name with the Mark, obviate bad faith by the Complainant. The fact that "jsm" is used in other contexts by others has been addressed.

The circumstances surrounding the initial registration of the subject domain name are not known by the Administrative Panel. It must take the facts as they are presented to it.

For the purpose of considering bad faith, acquisition and registration are equated. See: *Madonna Ciccone p/k/a Madonna v. Parisi*, D2000 - 0847 (October 12, 2000); *Plaza Operating Partners Ltd. v. Pop Data Technologies Inc.*, D2000 0166 (June 1, 2000).

It is clear that when the Respondent acquired the subject domain name, the Firm was a well established and well known presence in the Hong Kong legal community. The Respondent is linked directly and indirectly to Mr. Thomas Tse and perhaps his law firm. The Respondent offers no explanation for the acquisition of a domain name which is identical to the mark of the Firm. The Respondent used the subject domain name for activity associated with the provision of legal services. In this context, confusion by internet users would be likely.

While the conclusion that a respondent does not have a legitimate interest in a domain name that is identical to the rights of another does not lead automatically to a finding of bad faith, but the facts that support the conclusion are relevant to a consideration of bad faith.

In this case, the Respondent must have known about the Firm and its interests and must have known that using the initials of the Firm either would cause confusion or would attract users to the Respondent by reason of the Complainant's reputation.

Acquiring the subject domain name blocks the Complainant from doing so. This also is evidence of bad faith. The fact that use of the subject domain may not have attracted revenue directly to Mr. Thomas Tse or his firm ignores the fact of exposure, which for a law firm competing in a local market can be of significance.

The Administrative Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(iii).

Decision

Based on the information provided to it and on its findings of fact the Administrative Panel concludes that the Complainant has established its case.

The Complainant requests transfer of the subject domain name to it. The Administrative Panel so orders.

Made November 20, 2003.

Edward C. Chiasson, Q.C.
Presiding Panelist

David Sandborg
Panelist

Arthur Chang
Panelist