



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

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Decision ID	DE-0300015
Case ID	HK-0300032
Disputed Domain Name	www.sinoland.com
Case Administrator	Iris Wong
Submitted By	Peter Bullock
Participated Panelist	Peter Bullock
Date of Decision	25-11-2003

The Parties Information

Claimant	SINO LAND CO LTD
Respondent	Suet Chung Tsang

Procedural History

Parties and Contested Domain Name

The Complainant is Sino Land Co. Ltd. with a registered address at 12/F., Tsim Sha Tsui Centre, Salisbury Road, Tsim Sha Tsui, Kowloon, Hong Kong. The Respondent is Mr Suet Chung Tsang who runs a business styled Enterprises Online Hong Kong. It does not appear from the evidence that Mr. Tsang's business is registered under the Business Registration Ordinance. The contested domain name is sinoland.com.

Procedural History

A Complaint in this matter was filed with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (ADNDRC) dated 22 September 2003. The Respondent actively engaged the ADNDRC office in e-mail communication proposing an alternative list of Panelists to that proposed by the ADNDRC office. Following concerns raised by the Complainant that the Respondent's proposed panelists lacked a connection with Hong Kong, the ADNDRC office made an appointment from within its own proposed list. The Respondent filed a Response dated 22 October 2003 substantively addressing all the points made in the Complaint.

Factual Background

For Claimant

The Complainant explains, and this is uncontested, that Sino Land Co. Ltd. was incorporated under the laws of Hong Kong in 1971 and listed on the Hong Kong Stock Exchange (0083) in 1981. It is one of the largest real estate developers in Hong Kong. Its website (branded "Sino Group" with its distinctive 'S' logo) states:
"Complementing the core business activities, the Group is engaged in a range of property development-related activities including:

- building construction
- property management
- car park operations and management
- cleaning services
- security and other customer services.

Through its technology arm Sino Technology Corporation Limited, the Sino Group is actively pursuing high-tech

initiatives, including:

broadband infrastructure installation and data centre establishment
community portals development.

The Sino Group is also engaged in hotel investment, hotel management and club management activities.”

The Complainant registered the domain sino-land.com on 10 June 1996. It is presumed that at that time sinoland.com was available (there is no evidence as to this). For whatever reason the Complainant chose sino-land.com over sinoland.com in 1996.

For Respondent

The Respondent registered sinoland.com on 7 January 2000. The Respondent appears to be something of a dabbler. He has made some legitimate use of his website since it was first hosted on freeservers.com on 25 September 2000. At various times the Respondent’s website has:

offered products and services related to Chinese paintings (which appears to have predated his change to a new web hosting company in February 2001);

offered for sale a paid e-mail service (more recently since 20 August 2003, shortly before the Complainant filed its Complaint).

What appears to have led to the institution of these proceedings by the Complainant is the fact that the Respondent used a ‘catch to address’ system to redirect e-mail from correspondents incorrectly sending e-mail to [name]@sinoland.com to [same name]@sino-land.com. The Respondent, as at 26 August 2003 claimed to have received over three thousand of such misdirected e-mails. The Respondent then planned, and appears to have started, to offer the intended Sino Land recipient the opportunity of subscribing for a ‘paid for’ e-mail account with the address

“your_name@sinoland.com”. The offer was made in the following terms:

“Over the past few years, we have received thousands of e-mails with misspelled e-mail addresses in the form of any_recipient@sinoland.com. We guess that you might be interested in the [sic] having an email account with address,

your_name@sinoland.com.

Before a public offer of our e-mail service, we are happy to reserve a special e-mail account for you to consider. To know more about the benefits of sinoland.com mail service, please visit sinoland.com.”

It is not hard to see that this type of approach would have irked the Complainant, although equally (albeit incidentally) it seems unlikely that during the period between 10 June 1996 (when the Complainant registered @sino-land.com) and 7 January 2000 (when the Respondent registered @sinoland.com) the Complainant would not have realised that people were mistakenly sending messages into the ether to [name]@sinoland.com. It would have been simple and cheap enough to register @sinoland.com in response to what should have been a transparently obvious problem.

Parties' Contentions

Claimant

The Complainant contends:

The domain “sinoland.com” is identical to and creates market confusion with “sino-land.com”.

The Respondent has no right or legitimate interests in respect of “sinoland.com” as he does not own a company named Sino Land or is trading in any land related business.

The “Sino Land” service mark is established and well-known locally (in Hong Kong) and internationally.

The Respondent used the domain in bad faith by (1) collecting all e-mails wrongly or accidentally sent to “sinoland.com” and (2) using them to solicit the sale of services associated with “sinoland.com”.

Respondent

The Respondent, whilst admitting that “sinoland.com” is identical or confusingly similar to the trade name of the Complainant, contends:

The Complainant has provided no evidence that his trade name is a registered or common law trademark, as required

by the UDRP.

If they exist, the Complainant's common law trademark rights in "SINOLAND" do not preclude a third party from establishing rights in "SINO LAND" at the same time, especially when the third party is engaged in bona fide non-competing business.

The Respondent has rights to and legitimate interests in the domain name by reason of (1) the history of his commercial use of the website relating to the services related to Chinese paintings (2) the fact that his move to launch a paid e-mail service predated the Complaint herein and (3) such activities constituted a bona fide offering of goods and services.

The Complainant is guilty of reverse hi-jacking the disputed domain.

Findings

Identical / Confusingly Similar

Both parties accept the disputed domain is identical/confusingly similar to sino-land.com.

Rights and Legitimate Interests

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". This Panel shall apply the rules and principles set out in decisions of the Courts of Hong Kong, the independent jurisdiction of the Hong Kong Office of ADNDRC through which this Complaint is being administered.

Paragraph 3(b)(ix) of the Rules directs that the Complainant must demonstrate each of the following:

(i) that the domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

(ii) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name that is the subject of the Complaint; and

(iii) why the domain name should be considered as having been registered and being used in bad faith.

(1) In relation to the issue of whether the Complainant has demonstrated that it has rights in a trademark or service mark:

Rule 3(b)(ix) of the Rules clearly states the obligation on the part of the Complainant to identify the trademark or service mark which the Complainant relies upon as being infringed by the Respondent's use of the disputed domain. Nevertheless, the Complainant apparently has no registered trademark and bases its claim on the fact of its longstanding incorporation in Hong Kong (which is irrelevant) and, presumably, common law rights in "Sino Land".

It is well established that Paragraph 4(a)(i) of the ICANN Policy does not require the Complainant to have registered trademark rights. A Complainant may rely on an unregistered word, phrase or string of characters, provided that the unregistered mark is and performs the function of a "trademark". The unregistered mark must perform the function of distinguishing the goods and services of one person in trade from the goods or services of any other person in trade. See *Sydney Markets Limited - v- Nick Ratis* D2001-0932; *Realmark Cape Harbour L.C.C v. Lawrence S. Lewis* WIPO Case No. D2000-1435; *Oshawa Centre Holdings Inc. v. M. Bharwani* eResolution Case No. AF-0820; *Web2You Inc. v. MyDotCom* eResolution Case No. AF-0268; *Daydream Island Resort Investments Pty Ltd v. Alessandro Sorbello* eResolution Case No. AF-0586. What is important is whether or not the Complainant had properly demonstrated that it had trademark rights.

In the instant case the Complainant makes no attempt to demonstrate it has trade mark rights. The question therefore remains to what extent the Panel should seek out such rights on its behalf. All the Panel has to go on is the existence of the Complainant's website, the Panel's 'local knowledge' of the Complainant's position in the market as a well-known developer (which perhaps explains the Respondent's concerns to see the appointment of a non-Hong Kong-based Panel) and the arguments of the Respondent to the effect that "Sino" and "Land" are generic terms and that the Complainant's website does not support the existence of a common law mark "Sino Land".

THE PANEL FINDS THAT the facts and matters submitted by the Complainant do not demonstrate that it has common

law trade mark rights in “SINO LAND” . Although the Complainant’ s website can sometimes be sufficient evidence of common law trade mark rights, in this case the Complainant’ s website may support the existence of common law trade mark rights in the ‘S’ logo and/or “SINO Group” , but it does not in the Panel’ s opinion support such rights in “SINO LAND” . Given the Panel’ s findings below, this point is, however not of pivotal significance.

(2) In relation to the issue of whether the Respondent has any rights to and legitimate interests in the disputed domain:

The Policy at Paragraph 4(c) enumerates several ways in which a respondent may demonstrate rights or legitimate interests:

“ 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 organisation) 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 noncommercial 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.” (Policy, para. 4(c)).

The Panel finds that the Respondent satisfies Paragraph 4(c)(i) by reason of the Respondent’ s preparations to launch its ‘paid for’ e-mail service, which is an offering of goods or services which is legal, not illusory and can potentially make money for the Respondent. Even if the Complainant were to establish common law rights to ‘Sinoland’ , these rights would not extend beyond the ability to safeguard its own legitimate business. The Complainant has no business in the provision of domain name services. It should perhaps be noted that, on the evidence presented, were the Respondent to be shown to be seeking to offer the disputed domain to the Complainant for sale, that would quite possibly taint this Panel’ s view of the bona fides required under Paragraph 4(c).

The Panel also finds, should that be necessary, that the Respondent satisfies Paragraph 4(c)(iii) on the grounds of fair use. The Respondent is not misleadingly diverting consumers (this is not, for example, typopiracy). The consumers in question (so far only employees and officers of the Complainant) are quite aware that the ‘paid for’ e-mail service is not provided by the Complainant. To the extent that offers may be made in the future by the Respondent to others unconnected with the Complainant, clearly the Respondent will have to tread carefully. Because of the legitimate nature of the business and the fact that it falls outside the scope of the Complainant’ s own business the Panel sees no issue of tarnishment.

Bad Faith

In relation to the issue of whether the domain name has been registered and is being used in bad faith

The only bad faith alleged by the Complainant is the Respondent “collecting all e-mails wrongly or accidentally sent to “sinoland.com” even though the Respondent do not have such recipients” . The Panel fails to find any bad faith in the collection of such e-mails. The reason that such e-mails were sent was that the Complainant had failed adequately to publicise its real e-mail addresses.

Whilst the Panel would tend to agree with the Complainant’ s comment that “The Respondent’ s intention of owning this domain name “sinoland.com” is in doubt,” bad faith has not been shown.

Status

www.sinoland.com

Complaint Rejected

Decision

For all the foregoing reasons, the Panel decides:

that the domain name sinoland.com registered by the Respondent is confusingly similar to the domain name sino-land.com previously registered by the Complainant

that the Complainant has failed to demonstrate that it has rights to any registered or unregistered trade or service mark in SINO LAND

that the Respondent has made demonstrable preparations to use the disputed domain in connection with a bona fide offering of goods or services and has not misled or diverted the Complainant' s customers

that there is no evidence before the Panel of registration and use by the Respondent of the disputed domain in bad faith

the Panel makes no finding of Reverse Domain name Hijacking on the part of the Complainant.

Accordingly, the Panel rejects the Complainant' s request for cancellation and/or removal of the Respondent' s registration of the disputed domain, or its transfer to the Complainant.

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