



# ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

## ADMINISTRATIVE PANEL DECISION

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<b>Case No.</b>	HK-1000284
<b>Complainant:</b>	Jacky's Friend Club
<b>Respondent :</b>	Leonard Meng Lee aka Leonard M Lee

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### 1. The Parties

The Complainant is Jacky's Friend Club, of Wong Chuck Hang, Hong Kong (the "Complainant").

The Respondent is Leonard Meng Lee (aka Leonard M Lee), of Union City, California, the United States of America (the "Respondent").

### 2. The Domain Name

The disputed domain name <jackycheung.com> (the "Domain Name") is registered by the Respondent with REBEL.COM CORP (the "Registrar"), of Ottawa, Canada.

### 3. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Centre ("ADNDRC Hong Kong") on February 10, 2010, pursuant to the Uniform Domain Name Dispute Resolution Policy ("the Policy"), the Rules of the Uniform Domain Name Dispute Resolution Policy ("the Rules") and the Asian Domain Name Dispute Resolution Centre Supplemental Rules (the "ADNDRC Supplemental Rules"). On March 8, 2010 ADNDRC Hong Kong transmitted by email to the Registrar a request for registrar verification in relation to the Domain Name. On March 9, 2010, the Registrar transmitted by email to ADNDRC Hong Kong its response, confirming that it was the Registrar of the Domain Name, that the Respondent was the registrant of the Domain Name, and providing the contact details for the Respondent.

On March 11, 2010 ADNDRC Hong Kong formally notified the Respondent of the Complaint, and the proceedings formally commenced. In accordance with paragraph 5(a) of the Rules, the due date for the Respondent's Response was March 31, 2010. The Respondent's formal Response was filed with ADNDRC Hong Kong on March 18, 2010. On the same date, the Respondent indicated to ADNDRC Hong Kong his acceptance of the appointment of a single panelist.

On March 24, 2010, ADNDRC Hong Kong formally appointed Gabriela Kennedy as the sole panelist in this matter. The Panel finds that it was properly constituted in accordance with paragraph 6 of the Rules and Article 8 of the ADNDRC Supplemental Rules. The Panel has declared in writing that there are no circumstances that would affect the Panel's impartiality and independence, as required to ensure compliance with the paragraph 7 of the Rules and Article 9 of the ADNDRC Supplemental Rules.

### 4. Factual Background

Jacky Cheung is a well-known Hong Kong singer and actor who has had extensive commercial success both in Hong Kong and mainland China. He has been active in the entertainment industry since the mid-

1980s, and has released over 50 music albums and 50 feature films. Over his 20 year career, his name has become a household name in connection with Hong Kong films and Cantonese pop music.

The Complainant, Jacky's Friend Club, asserts in its Complaint that it is the "*Official Fan Club of Jacky Cheung*" and claims to have been authorised by Jacky Cheung to manage his official web site and obtain the relevant domain names on his behalf. In the correspondence between the parties prior to the Complaint being filed (submitted as evidence by the Respondent), the Respondent queried the authority of Mr. Stephen Wang, who appears to run Jacky's Friend Club, and communicated with Jacky Cheung's management. Mr. Cheung's management appears to have confirmed that the Complainant was authorised by Mr. Cheung, and such confirmation appears to have satisfied the Respondent, though no evidence of those communications was submitted to the Panel.

The Respondent registered the Domain Name on April 12, 2002. At the time of the Panel's decision, the Domain Name resolved to a website containing sponsored links to other websites with no connection to the Complainant. The Respondent owns a number of domain names incorporating the words "JACKY CHEUNG", including <jackycheung.net> and <jackycheung.info>. These domain names are not the subject of these complaint proceedings.

## **5. Parties' Contentions**

### **A. Complainant**

The Complaint refers to Jacky Cheung and Jacky's Friend Club interchangeably as the "Complainant". The contentions made in the Complaint may be summarized as follows:

- (a) Jacky Cheung (represented by the Complainant) has, by virtue of his extensive commercial use of his name in entertainment, acquired common law trademark rights in the name "JACKY CHEUNG";
- (b) the Domain Name <jackycheung.com> is identical to the Complainant's common law trademark;
- (c) the Respondent has no registered trademark rights in the words "JACKY CHEUNG" and has never been commonly known by any designation similar or identical to that name;
- (d) the Complainant has never authorised the Respondent to use the name "JACKY CHEUNG", and the Respondent has no legitimate licensing or business relationship with the Complainant; and
- (e) the Respondent is using the Domain Name to intentionally attract, for commercial gain, Internet users to the website associated with the Domain Name by creating a likelihood of confusion with the Complainant as to source, sponsorship or affiliation.

### **B. Respondent**

The Response contains a number of allegations and provides information that is not directly relevant to the present proceedings. The Response also does not specifically refer to all of the statements and allegations contained in the Complaint, so that the Respondent's contentions are somewhat difficult to comprehend, but the following relevant arguments can be surmised from the Response:

- (a) the Respondent denies that the Complainant should have exclusive use of the name "JACKY CHEUNG", so that the Domain Name should be transferred to the Complainant;
- (b) the Respondent contends that he has registered and used domain names owned by him (it is unclear whether the Respondent is referring to the Domain Name in dispute) in good faith, to operate a fan website for Jacky Cheung; and
- (c) the Complainant and Respondent have been negotiating for the purchase of some of the Respondent's domain names containing the words "JACKY CHEUNG", including the Domain Name, and this process

has been unfairly interrupted by the Complainant's filing of the Complaint.

## 6. Findings

Paragraph 4(a) of the Policy provides that each of three findings must be made in order for a Complainant to prevail:

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

### A) Identical or Confusingly Similar

The Complainant must first establish that there is a relevant trademark or service mark in which it has rights.

It is well established that the Policy protects rights in unregistered marks: *SeekAmerica Networks Inc. v. Tariq Masood*, WIPO Case No. D2000-0131, *Imperial College v. Christopher Dessimoz*, WIPO Case No. D2004-0322. Further, it is possible for a complainant to establish common law rights in a personal name, where the unregistered personal name is being used in trade or commerce (i.e. so that the personal name acts as a mark associated with the product being, in the case of a performer, the performer themselves): see *Julia Fiona Roberts v. Russell Boyd*, WIPO Case No. D2000-0210 and *Jeanette Winterson v. Mark Hogarth*, WIPO Case No. D2000-0235.

Having considered the evidence submitted by the Complainant, the Panel accepts that Jacky Cheung may claim rights in his personal name as an unregistered common law trademark. The Panel notes that Mr. Cheung has been active in the entertainment industry for over 20 years, acting and performing under the name "JACKY CHEUNG" and has achieved significant fame in the Hong Kong and Chinese entertainment industry, such that the name "JACKY CHEUNG" is immediately and distinctively recognisable as being associated with Mr. Cheung as an entertainer.

The Complaint is confusing in that it identifies the Complainant as both Jacky Cheung and Jacky's Friend Club, and refers to them interchangeably throughout the Complaint. However, the Complaint is filed in the name of Jacky's Friend Club, and not by the individual Jacky Cheung. As the rights relied on arise by virtue of Mr. Cheung's use of his own name in the entertainment industry since around 1984, any rights that exist belong to Mr. Cheung himself. Conversely, under paragraph 4 of the Policy any transfer of a domain name as a result of the decision of a Panel can only be made to a party to a proceeding, which in the present case would be the Complainant, Jacky's Friend Club.

No evidence has been produced to show that Jacky's Friend Club owns any rights to the claimed mark, nor that Mr. Cheung has licensed Jacky's Friend Club to use his marks and obtain domain names incorporating his name. Jacky's Friend Club asserted in its correspondence with the Respondent that it was authorised by Mr. Cheung, a fact that the Respondent has apparently verified for himself, by contacting Mr. Cheung's management. This evidence was not submitted to the Panel. The Panel is therefore dealing with a Complainant who has not discharged the burden of demonstrating its rights in the marks.

Furthermore, the Complainant, Jacky's Friend Club, has given no indication nor produced any evidence as to its legal identity, so that the Panel is unaware of who would be the registrant of the Domain Name in the event of a transfer.

It therefore appears that the Complainant as listed on the Complaint, Jacky's Friend Club, lacks the standing to bring this complaint. Under Clause 15(a) of the Rules, the Panel is required to 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. Previous panels have expressed the view that it is for the Complainant to discharge its burden under paragraph 4(a) of the Policy, and a Complainant should be expected to 'get it right' the first time: *Grove Broadcasting Co. Ltd v Telesystems Communications Ltd*, WIPO Case No. 2000-0703.

It is for the Panel in its sole discretion to decide whether, under paragraph 12 of the Rules, further statements and documents should be requested from the parties. This is not a case where there is ambiguity or uncertainty in the evidence, but a case where there is doubt as to the *locus standi* of the party who has brought the Complaint.

The Panel therefore finds that the Complainant has not satisfied the first element of paragraph 4(a) of the Policy. Given this conclusion, it is unnecessary to consider the remaining elements of the Policy.

## **7. Decision**

For all the foregoing reasons, the Complaint is denied.

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Gabriela Kennedy  
Sole Panelist  
Dated: 7 April 2010