



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

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| Case No. | HK-1500708 |
| Complainant: | KHL Printing Co Pte Ltd & Asian Geographic Magazine Pte Ltd |
| Respondent: | Chong Seat Au |
| Disputed Domain Name: | < asiadiveexpo.com > |

1. The Parties and Disputed Domain Name

The Complainant 1 is KHL Printing Co Pte Ltd, of 57, Loyang Drive, Singapore 508896 and Complainant 2 is Asian Geographic Magazine Pte Ltd, of 20, Bedok South Road, Singapore 469277. The Complainant 1 is the holding company of the Complainant 2.

The Respondent is Chong Seat Au, of 24, Jalan Tengah, Layang Layang, Johor, Malaysia 81850.

The disputed domain name is <asiadiveexpo.com>, registered by the Respondent with IP Mirror Pte Ltd, of 9, Hong Kong Street, #01-01, Singapore 059652.

2. Procedural History

On 9 February 2015, the Complainant submitted a Complaint in English to the Hong Kong Office of Asian Domain Name Dispute Resolution Center (the ADNDRC) and selected this case to be dealt by a one-person panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules).

On the same day, the ADNDRC sent to the Complainant by e-mail an acknowledgement of the receipt of the Complaint and a request for submitting the case filing fee on or before 19 February 2015.

On 9, 13 and 23 February 2015, the ADNDRC transmitted respectively by e-mail to ICANN and the Registrar, IP Mirror Pte Ltd, a request for registration verification of the disputed domain name and the information of the registrant.

On 24 February 2015, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 25 February 2015, the ADNDRC sent to the Complainant by e-mail an acknowledgement of the case filing fee for the Complaint.

On 26 February 2015, the ADNDRC transmitted by e-mail to ICANN and the Registrar a request for the true WHOIS information with the correct identity and contact information of the registrant of the disputed domain name. On the same day, the Registrar transmitted by email to the ADNDRC the true WHOIS information of the disputed domain name.

On 26 February 2015, the ADNDRC also transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a Complaint against the Respondent over the disputed domain name, and the ADNDRC had sent the Complaint and its attachments to the Respondent through email according to the Rules and the ADNDRC Supplemental Rules. The ADNDRC also notified the commencement of the proceedings and the Respondent shall submit a response on or before 18 March 2015.

On 16 March 2015, the Respondent sent to the Registrar by e-mail a request for a list of all the registrants of the disputed domain name from 31 July 2002 until to date.

On 17 March 2015, the Registrar responded to the Respondent that since the disputed domain name was under UDRP, the Respondent could raise its concerns to the ADNDRC and the Registrar would be guided by the requirements stated in the UDRP process.

On the same day, the Respondent transmitted by e-mail to the ADNDRC the Response to the Complaint.

On 18 March 2015, the ADNDRC notified the parties that a Response was received within the specified time period and it would appoint a one-person panel to proceed to render the decision.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. Jacob (Changjie) Chen on 20 March 2015, the ADNDRC notified the parties on the same date that the Panel in this case had been selected, with Mr. Jacob (Changjie) Chen acting as the sole panelist. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the ADNDRC Supplemental Rules.

On the same day, the Panel received the file from the ADNDRC and shall render the decision within 14 days, i.e., on or before 3 April 2015. On 3 April 2015, the Panel postponed the date for rendering the decision to 10 April 2015.

Pursuant to Paragraph 11 (a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English, and neither party had any special request regarding the language of the proceedings, thus the Panel determines English as the language of the proceedings.

3. Factual background

For the Complainant

The Complainant 1 is KHL Printing Co Pte Ltd with the registered address at 57, Loyang Drive, Singapore 508896; the Complainant 2 is Asian Geographic Magazine Pte Ltd with the registered address at 20, Bedok South Road, Singapore 469277. The authorized representative is Mr. Thomas Au Siu Yung (Ascentsia Law Corporation) of 10, Anson Road, #03-22, International Plaza, Singapore 469277.

For the Respondent

The Respondent is Chong Seat Au with the registered address at 24, Jalan Tengah, Layang Layang, Johor, Malaysia 81850. The Respondent is the current registrant of the disputed domain name <asiadiveexpo.com>, which was created on 31 July 2002. The Registrar of the disputed domain name is IP Mirror Pte Ltd of 9, Hong Kong Street, #01-01, Singapore 059652.

4. Preliminary Issue

Decision in the first Complaint

An earlier complaint was filed by the same Complainant against the same Respondent with ADNDRC in January 2014 in relation to the same disputed domain name. In the decision dated 5 April 2014, the prior panel denied the Complainant's request to transfer the disputed domain name on the ground that the Complainant had failed to demonstrate that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and that the Respondent registered and used the disputed domain name in bad faith. See *KHL Printing Co Pte. Ltd. & Asian Geographic Magazines Pte Ltd v. Chong Seat Au*, ADNDRC Case No. HK-1400569, "*In this case, the Disputed Domain Name has been obtained prior to the registration of the trade mark or evidencing the established interest in the Disputed Domain Name of the Complainant, it cannot be inferred that the respondent was not having 'rights or legitimate interests' at the time of registration of the Disputed Domain Name i.e. in the year 2002...The disputed domain name was registered by the Respondent in 2002, almost 4 years prior to the Complainant's trademark application and nearly 8 years prior to the trademark's first use by the Complainant. Hence, at the time of the registration of the disputed domain name, the Respondent could not have contemplated the Complainant's non-existing rights.*"

New Complaint

The Complainant claims that the new Complaint is being filed with new evidence that had not existed at the time of the last submission and thus is not a case of *res judicata*. The new evidence in reference is an e-mail dated 24 November 2014 from the Registrar to the Complainant confirming that the Respondent was not the creator of the disputed domain name and only assumed the ownership in October 2012. The Complainant argues that it was unable to obtain the evidence owing to restrictions of the Registrar's privacy policy, and the new fact clarifies and changes the fundamental facts of the case as the registration date of the disputed domain name changes the significance of events on the entire time line of the case.

Decision on admissibility of the re-filed Complaint

Several prior UDRP decisions have confirmed that submission of new evidence might justify reconsideration of the prior decision, provided that the evidence could not have been obtained with reasonable diligence at the time of the prior proceeding, would probably have an important influence on the result, and appeared to be credible. See *Grove Broadcasting Co. Ltd. v. Telesystems Communications Limited*, WIPO Case No. D2000-0703; *Creo Products, Inc. v. Website In Development*, WIPO Case No. D2000-1490 and *The Knot, Inc. v. Ali Aziz*, WIPO Case No. D2008-0033.

Paragraph 4.4 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") also makes it clear that "A *re-filed complaint would usually also be accepted if it includes newly presented evidence that was reasonably unavailable to the complainant during the original case.*"

The new-filed Complaint is based on new evidence regarding the time when the Respondent assumed ownership of the disputed domain name. According to the Complainant, the new evidence was previously unavailable due to the privacy policy of the Registrar, credibility of which was not challenged by the Respondent. The Panel views that the evidence is material and would possibly significantly influence the result as the earlier decision relies in general on the fact that Respondent assumed ownership of the disputed domain name prior to registration of the trademark "Asia Dive Expo" by the Complainant.

After reviewing the evidence, the Panel holds that the Complainant has discharged its duty of burden by showing the new evidence is credible with significance and was not available as of the date of the prior complaint. The panel therefore decides that the re-filed Complaint should be heard by the present Panel with a discovery of new evidence.

5. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The Complainant 1 owns the trademark "Asia Dive Expo" which was registered on 30 November 2006 in Singapore with Registration No. T0626264H in Class 35. Asia Dive Expo has been used for diving expo business since 1994 and gained considerable prominence and goodwill especially since 2010 when the Complainant took over organization of the expo.
- ii. The Respondent organizes a diving expo of identical offering called "Diving and Resort Travel Show" under the domain of <divingandresorttravelexpo.com>. The Respondent's use of the disputed domain name infringes the Complainant's exclusive rights to the trademark "Asia Dive Expo" by publishing material on the website of the disputed domain name, diluting the Complainant's brand, confusing the public, and meanwhile, defying the conditions set out in the UDRP.
- iii. The Complaint is made in complete fulfillment of the three factual and legal grounds that are required by the Policy.

(a) The disputed domain name is identical to the Complainant's trademark "Asia Dive Expo".

(b) The Respondent has no rights or legitimate interests in the disputed domain name. Before any notice of the dispute, the Respondent's use of the disputed domain name did not correspond to any *bona fide* offering of goods or services. The Respondent has never been commonly known by the disputed domain name.

(c) The Respondent has been making use of the disputed domain name primarily for the purpose of disrupting the Complainant's business. The Respondent uses the disputed domain name to impersonate the Complainant's "Asia Dive Expo", thereby causing confusion and directing consumers away from the real "Asia Dive Expo" website. The Respondent has used the disputed domain name to publish false information, thereby damaging the goodwill and reputation associated with the true "Asia Dive Expo" and other dive shows in Asia. The Respondent became aware of the Complainant's grievances but refused to remedy the situation.

B. Respondent

The Respondent argues that he is the rightful owner of the disputed domain name and denies all the claims in the Complaint. The Respondent's contentions may be summarized as follows:

- i. The disputed domain name does not infringe the Complainant's trademark, nor is it used to reap any profit. The Complaint is filed aiming to hijack the disputed domain name from the Respondent, as such, the Complainant sent defamation e-mails to the Respondent's clients and friends.
- ii. The website of the disputed domain name reports real information regarding diving activities and diving agencies in Asia.
- iii. The Complainant fails to prove its rights to the disputed domain name. The Complainant enjoyed no rights to the disputed domain name before 2010 because it did not operate the Asia Dive Expo until then. After 2010, however, the Complainant has been using www.auw3some.com to promote its business instead of the disputed domain name.
- iv. The trademark "Asia Dive Expo" was not originally registered by the Complainant but assigned to it in 2010. The materials submitted by the Complainant are misleading and even false.

6. Findings

To succeed in the Complaint, the Complainant must, in accordance with paragraph 4(a) of the Policy, satisfy the Panel of the following three elements:

- 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 Complainant claims that "Asia Dive Expo" was registered as a trademark by the Complainant 1 on 30 November 2006, while the Respondent argues that the trademark was not originally registered by the Complainant but assigned to it in 2010.

To clarify this, the Panel visited the official website of the Intellectual Property Office of Singapore and found that the trademark "Asia Dive Expo" was initially registered by SUNTEC SINGAPORE INT'L CONVENTION & EXHIBITION CENTRE in Class 35 on 24 May 2007 with Registration No. T0626264H. The trademark was assigned to TMX Show Productions Pte Ltd on 9 September 2010 and later transferred to the Complainant 1 on 6 October 2010.

The Panel thus acknowledges that the Complainant has rights in respect of the trademark "Asia Dive Expo". The disputed domain name apart from the suffix ".com" is identical to the Complainant's trademark "Asia Dive Expo", accordingly, the Panel holds that the disputed domain name is identical to the Complainant's trademark.

B) Rights and Legitimate Interests

The Panel is, after examining the Complainant's evidence, satisfied that the Complainant has made *prima facie* case with respect to the Respondent's lack of rights or legitimate interests in the disputed domain name, consequently, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy sets out that a Respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name was in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent has been commonly known by the disputed domain name, even if it has acquired no trade mark or service mark rights; or
- (iii) the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Complainant claims that the website of the disputed domain name contains no content related to any *bona fide* offering of goods or services, and that the Respondent never conducted any activities under the disputed domain name prior to existence of the Complainant's trademark "Asia Dive Expo". In support, the Complainant provides history screenshots of the website of the disputed domain name indicating that the Respondent published information of dive events in Asia, including a chart titled "Top 10 Diving Expo in Asia Pacific" and other Asia-dive-event-related information. The Respondent insists no infringement upon the Complainant's trademark but failed to provide solid evidence with

regard to its *bona fide* offering and prior use of the disputed domain name. In line with the "balance of probabilities" standard of proof set out in WIPO Overview 2.0, Section 4.7, "*The general standard of proof under the UDRP is 'on balance' - often expressed as the 'balance of probabilities' or 'preponderance of the evidence' standard. Under this standard, an asserting party would typically need to establish that it is more likely than not that the claimed fact is true. Conclusory statements unsupported by evidence which merely repeat or paraphrase the criteria or scenarios under paragraphs 4(a), (b), or (c) of the UDRP would typically be insufficient*", the Panel is of the view that the Respondent did not establish rights or legitimate interests in the disputed domain name under paragraph 4(c)(i) and 4(c)(ii). The Panel comes to this conclusion also by referring to analysis of the Respondent's bad faith in the third element of this Decision.

The Panel meanwhile considers the circumstance of "a legitimate non-commercial or fair use of the disputed domain name" under paragraph 4(c)(iii). The Respondent argues that he is using the website of the disputed domain name to report real information of diving activities and diving agencies in Asia, which might constitute non-commercial or fair use. The Panel however finds no evidence on the side of the Respondent. On the contrary, the offer of advertisement on the website suggests that the Respondent is using the dispute domain name to reap commercial gains and misleadingly divert consumers. The Panel thus believes the non-commercial and fair use statement of the Respondent is primarily a pretext for commercial advantage. See *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, WIPO Case No. D2000-0477; *Rolex Watch U.S.A., Inc. v. Spider Webs, Ltd.*, WIPO Case No. D2001-0398.

The Panel finds, on the facts of this case, giving particular weight to the new evidence and history screenshots of the website of the disputed domain name, coupled with insufficiency of response from the Respondent to the Complaint, that the Respondent has no rights or legitimate interests in the disputed domain name.

C) Bad Faith

Paragraph 4(b) of the Policy sets out the following circumstances which, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its website or other on-line

location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

The Panel has difficulties in concluding that the Respondent is, being a competitor, using the disputed domain name primarily for the purpose of disrupting the Complainant's business as contended by the Complainant due to insufficiency on the part of the Complainant in providing evidence that the Respondent is engaged in a competitive diving expo business. Neither could the Panel make any assessment of the Respondent's bad faith out of the unfavorable criticism and erroneous statement shown on the history screenshots of the website of the disputed domain name because very limited materials are put forth by the Complainant.

In despite of the above, the Panel holds that this case falls within the circumstances referred to in paragraph 4(b)(iv) of the Policy for the following reasons:

The Respondent, who is from Malaysia and has published dive expo information on the website of the disputed domain name, should have fair knowledge of diving expo business in Asian area and know the trademark "Asia Dive Expo". See *Becton, Dickinson and Company v. Garry Harper*, WIPO Case No. D2001-1058; *SportSoft Golf, Inc. v. Hale Irwin's Golfers' Passport*, WIPO Case No. FA94956; *Marriot International, Inc. v. John Marriot*, WIPO Case No. FA94737. The new evidence with which the Complaint is re-filed shows that the Respondent acquired the disputed domain name in October 2012 by transfer. As each transfer of a domain name constitutes a new registration (See *Dreamgirls, Inc. v. Dreamgirls Entertainment*, WIPO Case No. D2006-0609), it is fair to conclude that the Respondent registered the disputed domain name in October 2012. Meanwhile, the Complainant has provided evidence pertinent to the historical development and media promotion of the "Asia Dive Expo", evidencing that the trademark "Asia Dive Expo" has gained fame in Asia dive events business area through continuous use by the Complainant prior to the time when the Respondent obtained the disputed domain name in 2012. For the reasons above, it is also fair for the Panel to find that the disputed domain name has been registered by the Respondent in bad faith.

The disputed domain name resolves to a website with misleading information. As demonstrated in the new evidence, the Respondent explicitly headlined the home page of the website as "ADEX", which is the publicized abbreviation of "Asia Dive Expo". The Panel, while preparing the decision, visited the website of the disputed domain name and noticed the website incorporated the Complainant's trademark "Asia Dive Expo" in its headline - Top 10 Diving Expo in Asia Pacific! Asia Dive Expo Records! At the bottom of the website, there was a line saying "For advertising, please contact: info@asiadiveexpo.com". With all these factors, the Panel has no hesitation to hold that the Respondent is attempting to make commercial gains through misleadingly attracting Internet users to visit the website of the disputed domain name by taking advantage of the fame of Complainant's trademark "Asia Dive Expo". Moreover, the Respondent makes no effort to differentiate the disputed domain name from the Complainant's business, which strengthens the possibility to cause confusion among visitors to the website of the disputed domain name by leading the visitors to mistake the website as the official site of the Complainant's Asia Dive Expo business, out of which, the Panel finds that the disputed domain name is being used by the Respondent in bad faith.

This Panel hence concludes that the disputed domain name has been registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <asiadiveexpo.com> be transferred to the Complainant 2, Asian Geographic Magazine Pte Ltd.

Jacob (Changjie) Chen
Sole Panelist

Dated: 10 April 2015