



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (HONG KONG OFFICE)

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Decision Submission

English Print

Decision ID	DE-0700110
Case ID	HK-0700119
Disputed Domain Name	www.hkjcmarksix.com
Case Administrator	Dennis CAI
Submitted By	Arthur Chang
Participated Panelist	Arthur Chang
Date of Decision	04-06-2007

The Parties Information

Claimant	The Hong Kong Jockey Club
Respondent	xiaoyaohuiyantuku (小么会员图库)

Procedural History

The Complainant of this case is The Hong Kong Jockey Club Its address is at One Sports Road, Happy Valley, Hong Kong. Its authorized representative is Johnson Stokes & Master.

The Respondent of this case is xiaoyaohuiyantuku with addresses at changanjie 117 hao, Beijing, CHINA.

The domain name in dispute is hkjcmarksix.com. The Registrar of the dispute domain name is OnlineNIC, Inc..

On March 21, 2007, the Complainant has submitted Complaint to the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (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 26 August 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 has sought a one-person Panel.

On March 27, 2007, the Centre has forwarded a request to OnlineNIC, Inc. to verify the registration information of disputed domain name and on March 28, 2007, OnlineNIC, Inc. confirmed with registrant details as shown above.

On April 4, 2007, the Centre forwarded a copy to the Respondent by on-line notification. The 20 day deadline for the Respondent to respond calculated from April 4, 2007 expired and the Respondent did not file a Response with the Centre, as confirmed by the Centre.

On May 17, 2007, Arthur Chang has been appointed as the sole Panelist for this case and all parties have been informed by email.

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

Factual Background

For Claimant

The Complaint is based on the registration for the mark “HKJC” in Hong Kong (China) in Classes 16, 41, 42 and 43 in respect of various goods and services under the name of the Complainant's wholly owned subsidiary "HKJC (IP) Limited" and the registration for the mark "MARK SIX六合彩" in Hong Kong (China) in classes 16, 36 and 41 under the name of the Complainant's wholly owned subsidiary "HKJC Lotteries Limited" and the Complainant's common law rights in the marks "HKJC" and "MARK SIX". Copies of the registration certificates are provided as Annex B to this Complaint.

The HKJC (IP) Limited has also registered the composite marks "HKJC Football" and "HKJC Football and device" both containing the mark “HKJC” in Hong Kong in various classes in respect of a wide range of goods and services. A list of the registrations for the mark "HKJC Football" is provided as Annex C. All the aforesaid registered marks have all along been used by the Complainant and its wholly owned subsidiaries exclusively on their products and for their services.

This Complaint is based on the registration for the mark “HKJC” and the registration for the mark "MARK SIX" (collectively referred to as "Mark") registered in respect of a variety of goods and services in Hong Kong and the Complainant's common law rights generated as a result of use of the Mark by the Complainant.

The Complainant, the Hong Kong Jockey Club, commonly known as HKJC, is the only statutory body duly authorised by the Government for provision of horse racing, sporting and betting entertainment in Hong Kong. The Complainant is one of the largest racing organisations in the world.

The Complainant was founded in 1884 and became responsible for organising all horse racing and betting activities in Hong Kong since then. The Complainant built the first permanent viewing stand at Happy Valley and the Shatin Racecourse in 1931 and 1978 respectively, and was authorised to set up off course betting branches in 1973. Since 1988, the Complainant started organising international races and invited participants from various countries all over the world. The Hong Kong International Races have now grown to include the Hong Kong Cup, Hong Kong Mile and Hong Kong Vase, all international Group One races, as well as Hong Kong Sprint, an international Group Two race. Hong Kong horses now compete against runners from Europe, North America, Australia, New Zealand, the UAE and Japan.

Apart from horse racing, the Complainant also introduced the Mark Six lottery in 1975 and it is now conducted by HKJC Lotteries Limited, a wholly owned subsidiary of the Complainant using the facilities of the Complainant. The Mark Six lottery is held three times a week. The Mark Six Lottery draws are broadcast live by one of the two free-to-air television stations in Hong Kong. To ensure the fairness of the draws, outsiders are invited to supervise the draw. The Complainant usually invites 2-3 people of high social status e.g. Justices of the Peace to supervise the draw.

The Mark Six Lottery game is immensely popular in Hong Kong. When the prize jackpot is very high, it is not uncommon for a total in excess of HKD\$120 million to be spent on Mark Six. Over the past years, the total contribution to Government lottery duty has exceeded HK\$16.6 billion and over HK\$7.4 billion has been contributed to the Lotteries Fund.

The Complainant has also launched regulated football betting services since 2003 and accepts a range of varieties of football betting by Hong Kong citizens for major international matches and league matches of several European countries. The football betting service is conducted and administered by HKJC Football Betting Limited, a wholly owned subsidiary of the Complainant.

The Complainant is the largest single taxpayer in Hong Kong paying HK\$12.405 billion tax in 2005/06. The Complainant is also one of the largest employers in Hong Kong, with 4,400 full-time and 20,000 part-time staff. A unique feature of the Complainant is its not-for-profit business model whereby its surplus goes to charity.

The Complainant has registered 223 domain names as at the date of this Complaint and a list of its registered domain names is provided as Annex E. A number of domain names has been in active use for being the internet addresses of the Complainant's websites (or by way of redirection). Lists of the Complainant's registered domain names are provided as Annex F. Among all the domain names, "HKJOCKEYCLUB.COM" (registered on 22 March 1996) and "HKJC.COM" (registered on 29 September 2003), which are all pointed to the Complainant's official website, have been in active use since their respective dates of registration and are generally recognised by the public as the internet addresses of the Complainant's official website. Copies of the printouts of WHOIS search result conducted on 20 March 2007 in respect of "HKJOCKEYCLUB.COM" and "HKJC.COM" are provided as Annex G. A copy of the printout of the homepage of "HKJC.COM" together with a copy of the printout on the Mark Six Lottery are enclosed as Annex G1.

Nowadays, all Hong Kong citizens over the age of 18 can place the betting on horse racing, football or selections on Mark Six not only at the Racecourse and the off-course betting branches, but also at their fingertips by using telephone betting, mobile betting, Customer Input Terminal, online betting, etc.

Throughout the years, the Complaint has endeavoured to develop and promote its business. The Complainant has used and advertised its products and services extensively by putting up posters and banners and distributing different brochures and leaflets at over 120 off-course betting branches to promote its activities and events. Copies of the aforesaid

promotional materials are enclosed herewith as Annex H.

Apart from the provision of high quality betting entertainment, the Complainant has contributed substantial funds towards various charitable and worthy causes in Hong Kong since 1915. Each year, the Complainant allocates the surplus earnings from the racing season to the Hong Kong Jockey Club Charities Trust, which serves as the administrator for the Complainant's charitable donations. The Charities Trust donated a total of HK\$1,027 million to hundreds of charities and community projects in 2005-2006. The Trust has donated close to HK\$1 billion each year for more than a decade.

The Complainant serves four principal areas of civil and social need in its contributions, namely community services, education and training, medical and health, and sports, recreation and culture. The Complainant not only subsidizes various secondary schools and tertiary institutions, but also sets up "The Hong Kong Jockey Club Scholarship Fund" to provide thousands of precious studying opportunities to students. As seen from the press release of 29 May 2001 issued by the University Grants Committee (Please refer to Annex I), the Complainant is the largest supporter of higher education in Hong Kong and buildings donated by the Complainant can be found in all UGC-funded institutions, benefiting both teachers and students in their teaching and research and contributing significantly to the enrichment of campus life. Due to the abundance of the buildings named with the Complainant's name, it is not uncommon for both the teaching staff and students to be acquainted with the Complainant's name.

The Complainant is also a strong supporter of arts and culture in Hong Kong.

In addition to the above, there are a lot of public facilities named with the Complainant's English name "The Hong Kong Jockey Club" or its English abbreviation "Jockey Club" in Hong Kong, such as hospitals, schools, swimming pools, resorts, homes for the elders, stadiums, exhibition centers, research centers, etc. A copy of the Complainant's Annual Report 2005/2006 is provided as Annex J in which details of the Complainant's betting services, financial status and charitable activities are further illustrated. A list of the Complainant's subsidiaries using the HKJC as part of their names is enclosed as Annex K.

For Respondent

The Centre confirmed that documents have been sent to the Respondent's address as registered with the registrar OnlineNIC Inc., but it can't be delivered due to incorrect/incomplete address as indicated by the delivery service provider TNT. Subsequently, The Centre served the Respondent via email at the address shown in Whois database. Nothing has been received by the Centre regarding response of the Respondent related to this case. The disputed domain name was registered on 26 February 2005.

Parties' Contentions

Claimant

The Disputed Domain Name is identical and/or confusingly similar to trade marks or service marks in which the Complainant has rights

In view of the description in the "Factual background" section, it is clear that the Complainant has established a protectable reputation for its names "The Hong Kong Jockey Club" and its abbreviation "HKJC" and the mark "Mark Six". As such, the horse-racing audiences, gamblers, lottery buyers, charitable organisations, education institutions, the Complainant's members, the Government and the general public will associate the marks "HKJC" and "Mark Six" exclusively with the Complainant.

By comparing between the Disputed Domain Name and the Mark, it is clear that the Dispute Domain Name "hkjcmarsix.com" is merely a combination of the marks "HKJC" and "Mark Six".

The Respondent has no right or legitimate interest in respect of the Disputed Domain Name
As mentioned above, the Complainant has already registered and used a number of "HKJC" domain names. The Respondent obtains the Disputed Domain Name, which appears to be one of the varied forms of the Complainant's domain names, by way of pre-emptive registration in the absence of knowledge and consent of the Complainant.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because it is apparent from the ownership details of the Disputed Domain Name that the Disputed Domain Name is not the name of the Respondent. The Respondent is therefore not commonly known by the Disputed Domain Name and there is no reason why the Respondent might reasonably be said to have any rights or legitimate interests in registering or using the Disputed Domain Name.

The Disputed Domain Name has been registered by the Respondent in Bad Faith

The Complainant submits that the Respondent has registered and used the Disputed Domain Name in bad faith because:-

(a) "HKJCMARKSIX" is not a term commonly used in the daily English language. Given the fame of the Complainant, it cannot be a mere co-incidence that the Respondent has chosen the Disputed Domain Name as its domain name. It is obvious that the Respondent is riding on the reputation of the Complainant and uses the Disputed Domain Name, which is a combination of the Mark, deliberately in order to attract Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source of the Respondent's website.

(b) A cease and desist letter was sent to the Respondent by the Complainant on 5 March 2007 but the Respondent failed to respond to it. A copy of the said letter is provided as Annex L.

(c) The Respondent did not create any website of the Disputed Domain name. A copy of the printout dated 1 March 2007 is enclosed as Annex M showing that the Respondent did not put the Disputed Domain Name in active use. It was not until the Complainant via its legal advisor sent the aforesaid cease and desist letter to the Respondent that the Respondent attempted to make some use of the Disputed Domain Name. Even so, the Respondent has merely created a search page under the Disputed Domain Name. A copy of the printout of the said page dated 20 March 2007 is attached as Annex N. It is well-established in *Telstra Corp Ltd v Nuclear Marshmallows* WIPO Case NO D2000-0003 that bad faith use is not limited to positive action, inaction is within the concept.

Respondent

Save as outlined above, the Respondent did not respond to any of the claim as submitted by the Complainant.

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 trade mark 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;
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel is bound by the Policy to make a decision based on the information provided to the Panel during the course of the proceedings.

Identical / Confusingly Similar

The Complainant, the Hong Kong Jockey Club, commonly known as HKJC, is the only statutory body duly authorised by the Government for provision of horse racing, sporting and betting entertainment in Hong Kong. The Complainant is one of the largest racing organisations in the world.

The Complainant was founded in 1884 and became responsible for organising all horse racing and betting activities in Hong Kong since then. The Complainant built the first permanent viewing stand at Happy Valley and the Shatin Racecourse in 1931 and 1978 respectively, and was authorised to set up off course betting branches in 1973. Since 1988, the Complainant started organising international races and invited participants from various countries all over the world.

Apart from horse racing, the Complainant also introduced the Mark Six lottery in 1975 and it is now conducted by HKJC Lotteries Limited, a wholly owned subsidiary of the Complainant using the facilities of the Complainant. The Mark Six lottery is held three times a week and is immensely popular in Hong Kong.

The Complainant is the largest single taxpayer in Hong Kong paying HK\$12.405 billion tax in 2005/06. The Complainant is also one of the largest employers in Hong Kong, with 4,400 full-time and 20,000 part-time staff.

The Complaint is based on the registration for the mark "HKJC" in Hong Kong (China) in Classes 16, 41, 42 and 43 in respect of various goods and services under the name of the Complainant's wholly owned subsidiary "HKJC (IP) Limited" and the registration for the mark "MARK SIX六合彩" in Hong Kong (China) in classes 16, 36 and 41 under the name of the Complainant's wholly owned subsidiary "HKJC Lotteries Limited" and the Complainant's common law rights in the marks "HKJC" and "MARK SIX". Copies of the registration certificates are provided.

The HKJC (IP) Limited has also registered the composite marks "HKJC Football" and "HKJC Football and device" both containing the mark "HKJC" in Hong Kong in various classes in respect of a wide range of goods and services. A list of the registrations for the mark "HKJC Football" is provided. All the aforesaid registered marks have all along been

used by the Complainant and its wholly owned subsidiaries exclusively on their products and for their services.

In view of the Complainant's "HKJC" and MARK SIX" mark ownership, and the massive popularity of Complainant's Mark Six lottery service in Hong Kong, it is very likely users will be associated "HKJC" and "MARK SIX" as Hong Kong Jockey Club Mark Six service.

By comparing between the Disputed Domain Name and the Mark, it is clear that the Dispute Domain Name "hkjemarksix.com" is merely a combination of the marks "HKJC" and "Mark Six", and it is confusingly similar with the marks that the Complainant has rights with.

As such, The Panel is satisfied that the Complainant has met the requirements of paragraph 4(a)(i) and the disputed domain name is identical or confusingly similar to the trademark that the Complainant holds.

Rights and Legitimate Interests

The Panel is satisfied that the Complainant has met the requirements of Policy 4(a)(ii) regarding Respondent's rights and legitimate interests in the disputed domain name because:

- The Disputed Domain Name (or in any reasonable variation derived from the name) does not reflect the Respondent's name or the name of the Respondent's company;
- The Complainant has not authorized the Respondent to use the "HKJC" nor "MARK SIX" trademark for any form of use;
- No evidence that shows neither the Respondent nor the Respondent's Website has acquired any reputation in the Disputed Domain Name.

Moreover, The Complainant has registered more than 200 domain names as at the date of this Complainant and a number of domain names are combination of "HKJC", "MARKSIX" and its related services. Most of them have been in active use for being the internet addresses of the Complainant's websites (or by way of redirection). Among all the domain names, "HKJOCKEYCLUB.COM" (registered on 22 March 1996) and "HKJC.COM" (registered on 29 September 2003), which are all pointed to the Complainant's official website, have been in active use since their respective dates of registration and are generally recognised by the public as the internet addresses of the Complainant's official website. This further shows the Complainant has the legitimate rights unless the Respondent can show his/her legitimate interest and right.

As such, the Panel agrees the Respondent has no right or legitimate interests in respect of the disputed domain name.

Bad Faith

According to the Policy 4b, the following circumstances, in particular but without limitation, if found by an Arbitration Panel to be present, shall be evidence of the registration and use of a Domain Name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Domain Name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or

- (iii) you have registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

- (iv) by using the Domain Name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

When the Panelist attempted to access the web site of the disputed domain name on May 27, 2007, it was directed to a page that does not show any relationship with "HKJCMARKSIX". When Panelist further attempted to search from Google and check the cache page on February 26, 2007, it returns a null page with message "not found". This is rather consistent with the description of Complainant.

If we take a deeper look at the current web site of the Respondent, on the right hand side, it has listed some related categories. 9 out of 15 links are Lotteries of different countries. This demonstrates respondent's intention to draw lottery related traffic by leveraging on Complainant's users as a result of Complainant's well known reputation in this area.

Besides, "HKJCMARKSIX" is not a term commonly used in the daily English language. It is obvious that the Respondent is riding on the reputation of the Complainant and uses the Disputed Domain Name, which is a combination of the Complainant's Marks, in order to attract Internet users to the Respondent's website by creating a likelihood of

confusion with the Complainant's mark as to the source of the Respondent's website.

As such, The Panel is satisfied that the Complainant has met the requirements of paragraph 4(b)(iv) of the Policy in showing bad faith registration and use of the Disputed Domain Name.

Appropriate Remedy

The Complainant asks for the Panelist's decision to transfer of the disputed domain name. In view of the above reasoning, the Panelist decides that transfer of the disputed domain name to the complainant is an appropriate remedy.

Status

www.hkjcmarksix.com Domain Name Transfer

Decision

Based on the above analysis, the Panelist decides that: (1) the disputed domain name hkjcmarksix.com is confusingly similar to the Complainant's name or mark in which the complaint has civil rights or interests; (2) the Respondent has no right or legitimate interest in respect of the disputed domain names or major part of that domain name; (3) the Respondent has registered or is using the domain name in bad faith. Accordingly, the Panelist decides that the disputed domain name hkjcmarksix.com should be transferred to the Complainant.

Panelist :
Arthur Chang
30 May 2007
Hong Kong

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