



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.:	HK-1901232
Complainant:	Guang Yi Company Limited (光義有限公司)
Respondent:	John Weng
Disputed Domain Names:	<gyhk.com> <gytelecom.com>

1. The Parties and Contested Domain Name

The Complainant is Guang Yi Company Limited (光義有限公司), of Unit 1501-10, 12-23, 15th floor, 1 Hung To Road, Kwun Tong, Kowloon, Hong Kong.

The Respondent is John Weng, of Level 7-1, Wisma Genting, Jalan Sultan Ismail, Kuala Lumpur, 50250, Malaysia.

The domain names at issue are <gyhk.com> <gytelecom.com>, registered by Respondent with Wild West Domains, LLC, of abuse@wildwestdomains.com.

2. Procedural History

On 11 March 2019, the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“ADNDRC-HK”). On the same day, the ADNDRC-HK confirmed receipt of the Complaint and requested the Complainant to submit the case filing fee.

On the same day, the ADNDRC-HK notified Wild West Domains, LLC (“Registrar”) of the Disputed Domain Name of the proceedings by email.

On 23 March 2019, the Registrar acknowledged the email of ADNDRC-HK confirming that the Disputed Domain Name is registered with the Registrar, that John Weng is the holder of the Disputed Domain Name, that the Internet Corporation for Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy (“the Policy”) is applicable to the Disputed Domain Name, the language of the Disputed Domain Name is English as provided by the WHOIS information in relation to the Disputed Domain Name and confirmed that the Disputed Domain Name is under Registrar lock status.


On 17 April 2019, the ADNDRC-HK sent a Written Notice of Complaint (“Notification”), together with the Complaint, to the email address of the Respondent’s nominated registrant contact for the Disputed Domain Name (as recorded in the WHOIS database). The

Notification gave the respondent twenty (20) calendar days to file a Response (i.e. on or before 7 May 2019).

The Panel comprising of Dr. Shahla F. Ali as a single panelist was appointed by the ADRDRC-HK on 29 May 2019. The papers pertaining to the case were delivered to the Panel by email on the same day.

3. Factual background

According to information submitted by the Complainant, the complaint is based on GY's

trade marks and trade names "GY" and/or "" logo ("Trade Marks") in Hong Kong. "GY" represents the abbreviation of GY's company name "Guang Yi", which has been used by GY since its foundation in 1992 in connection with its international distribution, wholesale and retail services (whether online or via physical retail points) regarding electronic devices, including with not limited to second-hand/nearly new mobile phones, tablets, laptops, desktop computers and their accessories, network cards and routers.

Since 1992, GY has continuously and extensively sold, supplied, distributed, marketed and promoted GY's above services and business worldwide, in particular in Hong Kong under and by reference to the Trade Marks.

Particulars of GY's annual turnover in Hong Kong

Year	Annual Turnover (HK\$)
Financial Year ended 31 March 2003	Over 159 million
Financial Year ended 31 March 2004	Over 319 million
Financial Year ended 31 March 2005	Over 583 million
Financial Year ended 31 March 2006	Over 879 million
Financial Year ended 31 March 2007	Over 1,219 million
Financial Year ended 31 March 2008	Over 1,115 million
Financial Year ended 31 March 2009	Over 1,165 million
Financial Year ended 31 March 2010	Over 1,293 million
Financial Year ended 31 March 2011	Over 1,661 million
Financial Year ended 31 March 2012	Over 1,399 million
Financial Year ended 31 March 2013	Over 1,612 million
Financial Year ended 31 March 2014	Over 1,736 million
Financial Year ended 31 March 2015	Over 1,162 million

The Complainant contends that as a result of the long history, high quality and standards, substantial sales and marketing efforts, GY has built up and has at all material times enjoyed substantial reputation and goodwill in its business or services provided/marketed under or by reference to the Trade Marks. GY therefore has prior rights in the Trade Marks since 1992.

Parallel Proceedings

According to submissions by the Complainant, legal proceedings have been commenced in connection with the 2 Domain Names. The high court action was commenced against the

1st defendant, “CHAN SIU KI (陳兆麒)” also known as “KINUS CHAN” and trading as “COMPTECH SOLUTION (甘迪科技)” (“KC”) and JW as the 2nd defendant.

The Complainant has submitted that KC was the former IT service provider of the Complainant, Guang Yi Company Limited (“GY”), since 2009 until on or around 20 January 2016 pursuant to a series of IT service contracts evidenced by invoices, emails, conducts and oral communications between GY and KC (“Service Agreements”), under which KC shall provide administration and maintenance services to GY for GY’s various domain names and email accounts, including without limitation the 2 Domain Names.

The Complainant contends that GY does not know JW and has no connection with JW. An internet search on JW and its Malaysian address “Level 7-1, Wisma Genting, Jalan Sultan Ismail, Kuala Lumpur, 50250, Malaysia”, finds that the address is a service office location of Virtual Office Malaysia: <https://www.voffice.com.my/centers/voffice-wisma-genting.php#centerdetails>, and this company is not related to JW/KC. Complainant’s search of JW’s telephone number “03 27247164” registered with WHOIS reveals that it is the telephone number of another company, namely the Malaysian corporate office of Adam Information Technologies (“AIT”), which is an American company. AIT’s Malaysian address is “Level 9, Unit 3, Wisma UOA Damansara II, Damansara Heights, 50490 Kuala Lumpur, Malaysia”. AIT provides data management and information access services only: <https://www.adaminfotech.com/contact.html>, and is not related to JW/KC either.

Therefore, Complainant submits that GY believes that JW is an unknown individual and is likely to be a fake identity created by KC to cover KC’s illegal transfer of the 2 Domain Names from GY (which will be explained below) to KC/JW, particularly because the WHOIS registrant address and the telephone number registered by JW do not match with each other. GY believes that the respondent, JW, is KC’s servants, agents, nominees, representatives, subsidiaries, associated or related parties/entities and/or a fake identity under the control of KC.

Complainant makes reference to a number of documents including: -

- (i) KC’s business registration certificate;
- (ii) the email correspondence between KC and GY in January 2016;
- (iii) KC’s invoice no. C0743 dated 11 September 2009 in relation to the renewal and maintenance of, amongst others, the 2 Domain Names;
- (iv) KC’s various invoices issued to GY between June 2009 to November 2014 and GY’s various payment records, evidencing the existence of the Service Agreements between GY and KC;
- (v) KC’s invoice no. C5122 dated 10 September 2015 relating to the renewal and maintenance of, amongst others, the 2 Domain Names, and GY’s cheque in the sum of HK\$7,250 on 25 September 2015, evidencing that GY had instructed KC to renew and maintain, amongst others, the 2 Domain Names for and on behalf of GY from 1 October 2015 to 30 September 2016; and
- (vi) GY’s internal payment records to KC in relation to the various IT and domain name maintenance services offered by KC from August 2013 to 21 January 2016;

The Complainant contends that GY is and was at all material times, the legal and beneficial owner of the 2 Domain Names, which were respectively created and registered on 19 October 2005 and 23 December 2007 by GY directly. Before the unauthorised transfer of the 2 Domain Names by KC and/or JW on or around 20 January 2016, the 2 Domain Names had been registered in the name of GY. As part of KC's IT services to the complainant, KC became the "administrator" and "technical contact" of GY's various domain name registrations, and KC created respective usernames and passwords which are necessary to administer and make any changes to the corresponding domain name registrations / domain name accounts of GYs. Nonetheless, in breach / repudiation of the Service Agreements, KC wrongfully transferred and assigned all the Domain Names to KC and/or JW by using the account usernames and passwords of GY's domain name registrations which KC created and held for GY without GY's authorisation after GY decided to engage another IT service provider in around late 2015.

Complainant submits that despite repeated demands, KC refused to transfer, return or cause JW to transfer or return the 2 Domain Names back to GY. GY had no alternative but to commence legal action against KC and JW. However, KC evaded service of legal proceeding and claimed in social media that he went to Taiwan for good. GY appointed investigator to look for KC in KC's Taiwan office (which is also KC's last known address in Taiwan) at "臺北市中山區新生北路 3 段 82 之 5 號" recently in but were given to understand by an office lady working there that KC was not in Taiwan anymore. GY was informed that KC didn't appear in his office or home in Taiwan by GY's private detective called "國華徵信有限公司", a leading detective agency in Taiwan on 10th July 2018, 6th August 2018, 5th September 2018 respectively. According to the records of the CCTV cameras installed by the said private detective during the period between mid-June 2018 to early September 2018, which monitored the gates of KC's office and the building where he lived in Taiwan, there was only an office lady went to KC's office to open and close the gate every day, and there was a courier visiting the office address for delivery sometimes, but KC could not be seen.

Finally, Complainant submits that given that KC has been evasive and has absconded to Taiwan and/or other unknown countries, despite numerous service attempts for around 2 years, the complainant had not been able to serve the Writ on KC in Hong Kong nor Taiwan since issuance on 13 January 2017. It is also impossible for GY to find out the whereabouts of KC given his evasive attitude and repeated escapes to other countries. As a result, GY cannot proceed with the high court action.

The Respondent, John Weng of Malaysia updated the disputed domain names on 10 July 2018. The Respondent did not file a Reply with the Centre.

4. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

According to the documents submitted by the Complainant, the 2 Domain Names

(namely, www.gyhk.com and www.gytelecom.com) consist of GY's trade name/ Trade Marks "gy" with the generic and descriptive words "hk" (which is a geographic denotation of "Hong Kong", where GY carries on businesses), and/or "telecom" (which is a business qualifier and is the same / highly similar field as the services that GY engages in). Therefore, the 2 Domain Names consists of dominant / distinctive element "gy" which is identical to GY's Trade Marks in which GY has prior rights. As a result, the 2 Domain Names are almost identical and/or confusingly similar to GY's Trade Marks.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name(s):

According to documents submitted by the Complainant, GY is and was at all material times, the legal and beneficial owner of the 2 Domain Names, which were respectively created and registered on 19 October 2005 and 23 December 2007 by GY directly. Before the unauthorised transfer or assignment of the 2 Domain Names by KC and/or JW on or around 20 January 2016, the 2 Domain Names had been registered in the name of GY.

KC was GY's former IT service provider. JW is an unknown individual and the Complainant contends that this is likely to be a fake identity created by KC to cover KC's illegal transfer of the 2 Domain Names from GY. Therefore, the Complainant believes that the respondent, JW, is KC's servants, agents, nominees, representatives, subsidiaries, associated or related parties/entities and/or a fake identity under the control of KC.

a) Domain name www.gyhk.com ("DN1")

When DN1 was created on 19 October 2005, this domain name was originally and has been registered in the name of GY. On or around 20 January 2016 and unbeknownst to GY, KC, with clear and actual knowledge that GY was and is the legal and beneficial owner of the 2 Domain Names, unlawfully transferred, assigned and/or procured the unlawful transfer of DN1 to KC under the trading name "Comptech Solutions" in the absence of GY's authorisation.

Thereafter, on a date unbeknownst to GY and/or around 7 July 2016, KC further transferred or assigned DN1 to JW in the absence of GY's authorisation.

(b) Domain name www.gytelecom.com ("DN2")

DN2 was created on 23 December 2007 originally registered in the name of GY at least until around 20 January 2016. In or around January 2016, the admin and technical contact of DN2 with WHOIS remained as KC trading as "Comptech Solutions" of Room 1A, 10/F., Charmay Centre, 12 Ka Hing Road, Kwai Chung, Hong Kong (which was the same as KC's previous Hong Kong address registered on its business registration certificate prior to 8 April 2010).

However, thereafter on a date unbeknownst in the absence of GY's authorisation, DN2 has been transferred or assigned to JW, who was also recorded as the contact of the admin and technical support of the domain name www.gytelecom.com.

- iii. The disputed domain name(s) has/have registered and is/are being used in bad faith:

The Claimant submits that the time of determining whether a domain name was registered in bad faith in the present case should be the date of the wrongful transfer of the 2 Domain Names to JW, i.e. on or around 7 July 2016, or alternatively, the date when KC misappropriated the 2 Domain Names on or around 20 January 2016.

Bad faith may also be inferred although JW passively holding the 2 Domain Names currently. According to WIPO's decision *Telstra Corporation Limited v. Nuclear Marshmallows*, while the panel will look at the totality of the circumstances in each case, the panel would consider amongst others, the following factors:

- (i) the degree of distinctiveness or reputation of the complainant's mark,
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use,
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and
- (iv) the implausibility of any good faith use to which the domain name may be put.

The Trade Marks are very distinctive due to GY's extensive use since 1992. JW has tried to conceal its identity and submitted false contact details to WHOIS. Clearly, factors (i), (iii) and (iv) in *Telstra* case could also be found in the present case. In particular, GY verily believe that after taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the 2 Domain Names by KC/JW that would be legitimate given that GY should be the original owner and KC/JW actually knew/know about GY's interest in the 2 Domain Names due to their previous business relationship.

In addition, Claimant argues that fraudulent transfers or acquiring a domain name through hacking is conclusive of bad faith. Losing domain names by hacking occurs when a domain name formerly registered in the complainant's name is later found to be in another's hands: *Teenee Media Company Limited v. Linda C. Austin* (ADNDRC Case No. HK-1300566).

Furthermore, in the present case, on 2 June 2016, KC refused to transfer back the 2 Domain Names to GY unless GY would agree to pay KC an exorbitant amount for "consultancy fees" at the rate of HK\$10,000 per hour. Claimant claims this is clear evidence of bad faith on the part of KC. Since JW is likely to be a fake identity created by / under the control of KC, JW was also acting in bad faith.

Claimant argues that similar to the *Teenee* case, KC/JW in this present case have fraudulently transferred the 2 Domain Names to themselves which they do not have any rights or legitimate interests in. After the transfer took place, KC/JW tried to blackmail GY to have the 2 Domain Names transferred back to GY. In *Teenee*, the Panel agreed with the observations of *Titi Tudorancea v. Patrick Larouche* (ADNDRC Case No. CN 1300669) on a very similar situation to that in

the present case, also involving an illegal transfer of a domain name followed by attempted blackmail and decided that “this situation constitutes exactly the type of bad faith use of the disputed domain name as identified in the Policy”.

KC/JW, with actual knowledge that GY is the true owner, are depriving GY of its legitimate rights to use the 2 Domain Names through the illegal transfers. Claimant argues these are clearly bad faith conducts on the part of KC/JW.

B. Respondent

The Respondent’s contentions may be summarized as follows:

The Respondent did not submit a reply.

5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent’s domain name is 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 has submitted evidence of its use of the “GY” trademark through prior use since 1992, copies of its website which prominently displays the GY logo and sales volume under the “GY” trademark in Hong Kong. While no evidence showing registration of the “GY” trademark has been provided, the Panel is satisfied that GY is the business name utilized by the Complainant and that it has had long use of this name. The Panel finds that the use of the ‘GY” trade name is known in the markets in which the Complainant operates – primarily Hong Kong. Its name is recognizable to its customers, suppliers and other business partners. The name is prominently used and displayed on its web-site and the Panelist concludes that it is highly probable that the name “GY” is and has been used extensively in the Complainant’s marketing material, calling cards, brochures, etc. On this basis, the Panel concludes that the Complainant has a common law trade mark right in the words “GY”. The letters GY are the textual component of the stylized mark.

Domain Name 1: The disputed domain name <gyhk.com> contains three elements: "gy", the place name “hk” and the top-level domain ".com". The addition of a place name generally does not alter the underlying mark to which it is added. Numerous UDRP precedents have established that the top-level domain does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. The only distinctive part of the disputed domain should be "GY", which is identical to the Complainant's "GY" stylized mark and trade name in Hong Kong.

The Disputed Domain Name < gykh.com > incorporates the Complainant’s “GY” mark which is the distinctive part of the Disputed Domain Name in its entirety, and such

incorporation makes the Disputed Domain Name confusingly similar with the Complainant's trademark.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(i).

Domain Name 2: The disputed domain name <gytelecom.com> contains three elements: "gy", the descriptive word "telecom" and the top-level domain ".com". The addition of a descriptive word "telecom" generally does not alter the underlying mark to which it is added. Numerous UDRP precedents have established that the top-level domain does not have trademark significance, conferring no distinctiveness to the domain name sufficient to avoid user confusion. The only distinctive part of the disputed domain should be "GY", which is identical to the Complainant's "GY" stylized mark and trade name in Hong Kong.

The Disputed Domain Name < gytelecom.com > incorporates the Complainant's "GY" mark which is the distinctive part of the Disputed Domain Name in its entirety, and such incorporation makes the Disputed Domain Name confusingly similar with the Complainant's trademark.

In conclusion, the Panel finds that the Complainant has satisfied the Paragraph 4(a)(i).

B) Rights and Legitimate Interests

The Complainant has alleged that the Respondent has no rights or legitimate interests in respect of domain name and, given the failure of the Respondent to properly respond, as referred to in this Award, there is no contest to that allegation. Further, given the use by the Respondent of the domain name to date as established by the Complainant, the Panel cannot discern any legitimate interest held by the Respondent in respect of the disputed domain name.

C) Bad Faith

In determining whether the Respondent has registered or used the Disputed Domain Name in bad faith, paragraph 4(b) of the Policy sets down four (4) factors which the Panel will need to examine. The four (4) factors are as follows:

“Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the 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.”

In this case, the Respondent, domiciled in Asia, must have been aware of the Complainant's prior use of the Disputed Domain Name given the Complainant's use of mark “GY” within Hong Kong as of the date that the Respondent registered the Disputed Domain Name. Further, the registration of “gyhk” and “gytelecom” suggests knowledge of the nature, industry and geographic scope of the “GY” mark.

No evidence has been provided showing that the Respondent sought the permission of the Claimant to use its mark, nor any evidence showing that the Claimant gave such permission to the respondent.

Given the above findings, the Panel is of the view that the Respondent registered and used the contested domain name in bad faith.

6. Decision

Pursuant to Paragraph 4(i) of the Policy and Article 15 of the Rules, the Panel orders that the disputed domain names < gyhk.com > and <gytelecom.com> be transferred to the Complainant.



Dr. Shahla F. Ali
Panelist

Dated: 6 June 2019