



Asian Domain Name Dispute Resolution Centre

hongkong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1701052
Complainants:	Tencent Technology (Shenzhen) <u>and</u> Tencent Holdings Limited
Respondents:	Paul deng <u>and</u> stone stone
Disputed Domain Name(s):	<tencent.org > <u>and</u> <tencent.biz>

1. The Parties and Contested Domain Names

The Complainants are:

- (1) Tencent Technology (Shenzhen) Company Limited of Tencent Building, Kejizhongyi Avenue, Hi-tech Park, Nanshan District, Shenzhen. (First Complainant)
- (2) Tencent Holdings Limited of 29/F, Three Pacific Place, No 1, Queens's Road East, Wanchai, Hong Kong (Second Complainant) (hereinafter known as the "*Complainants*").

The Respondents are:

- (1) Paul deng of 33 Glenvale Crescent, Mulgrave, AP, 3170, Australia. (First Respondent)
- (2) stone stone of 33 Glenvale Crescent, Mulgrave, AP, 3170, Australia (Second Respondent) (hereinafter known as the "*Respondents*").

The Complainants and the Respondents are collectively known hereinafter as “*the Parties*”.

The domain names at issue are <tencent.org> (“*Disputed Domain Name 1*”) and <tencent.biz> (“*Disputed Domain Name 2*”), registered by the Respondents with Moniker Online Services LLC of 13727 SW, 152nd Street, #513 Miami, FL 33177, United States of America (“*the Registrar*”).

Disputed Domain Name 1 and *Disputed Domain Name 2* are collectively known hereinafter as the “*Disputed Domain Names*”.

2. Procedural History

On 12 December 2017, pursuant to the Internet Corporation For Assigned Names And Numbers (ICANN) Uniform Domain Name Policy (“*the Policy*”), the Rules of Uniform Domain Name Dispute Resolution Policy (“*the Rules*”) and the Asian Domain Name Dispute Resolution Centre Supplementary Rules to the ICANN Uniform Domain Name Dispute Resolution Policy and the Rules For the Uniform Domain Name Dispute Resolution Policy (“*the Supplemental Rules*”), the Complainants (through their legal representatives Jacob Chen and Lillian Lian of Messrs. Beijing Lusheng (Shanghai) Law Firm) filed a Complaint in the English language with the Hong Kong Office of the Asian Domain Name Dispute Resolution Centre (“*ADNDRC-HK*”) and elected to have the case in question be dealt with by a single member panel.

On 12 December 2017, the *ADNDRC-HK* notified *the Registrar* of the *Disputed Domain Names* proceedings by email. In which, the *ADNDRC-HK* requested *the Registrar* to provide the following information, namely:-

- “1. Whether the above domain names <tencent.org> & <tencent.biz> are registered with “**Moniker Online Services LLC**”;
2. Whether the Respondent “**Paul deng and stone stone**” are the Registrant or holder of the disputed domain names <tencent.org> & <tencent.biz>;
3. Whether the ICANN Uniform Domain Name Dispute Resolution Policy is applicable to the current dispute;
4. The language of the Registration Agreement of the disputed domain name(s). In accordance with the UDRP, the language of the proceedings shall be the language of the Registration Agreement, unless otherwise agreed by the parties or decided by the Panelist;
5. Please provide us with the registration date and expiration date of the disputed domain name(s);
6. Please confirm with us that the disputed domain name(s) has/have been locked and would not be transferred to another holder or registrar during the current administrative proceeding or for a period of 15 business days after the proceeding is concluded in accordance with Paragraph 8 of the Policy;
7. Please provide us with the Whois information regarding the disputed domain name(s);”

In the meantime, the *ADNDRC-HK* reminded *the Registrar* to take appropriate action towards the *Disputed Domain Names* as stipulated by *the Policy*, such as prohibiting the *Disputed Domain Names* from being transferred to a third party.

On 12 December 2017, the *ADNDRC-HK* notified the Complainants by email that they received the Complaint concerning the *Disputed Domain Names* and that “*Upon receipt of the Registrar’s confirmation on the WHOIS information, we shall proceed to review your Complaint and let you know whether it is administrative compliance...If it is in compliance, we shall forward your complaint to the Respondent and formally commence the proceedings...*”.

On 15 December 2017, *the Registrar* acknowledged the email of the *ADNDRC-HK* (dated 12 December 2017) confirming that the *Disputed Domain Names* are registered with *the Registrar*, that “stone stone” (<tencent.org) and “Paul deng” (<tencent.biz>) are holders of the *Disputed Domain Names*, that *the Policy* is applicable to the *Disputed Domain Names*, the language of the Registration Agreement of the *Disputed Domain Names* is English, the registration dates are 29 August 2015 and the expiration dates are 26 August 2018 (<tencent.org>) and 27 November 2018 (<tencent.biz>) respectively and confirmed that the *Disputed Domain Names* are under Registrar lock status. Further, *the Registrar* notified the *ADNDRC-HK* of the contact information of the Respondents including their postal and email addresses (the *Disputed Domain Names* have the same postal address and email contacts).

On 20 December 2017, the *ADNDRC-HK* wrote to the Complainants notifying them that their Complaint “*is in administrative compliance with the Uniform Domain Name Dispute Resolution Policy (the “Policy”)* and its Rules, we shall forward your complaint to the

Respondent and formally commence the proceedings in accordance with the Policy and Rules”.

On 22 December 2017, the **ADNDRC-HK** sent a Written Notice of Complaint in the English language (“the Notice”), together with the Complaint Form C enclosed with annexures to the email address of the Respondents (as recorded in the WHOIS database, the Respondents email address is *helenrock@europe.com* as well as *postmaster@tencent.org* and *postmaster@tencent.biz*). The Notice gave the Respondents twenty (20) calendar days to file a Response (i.e. on or before 11 January 2018).

On 26 December 2017, the Respondents (through their legal representative Zhijun Fang/Zuo Pan of Messrs. Squire Patton Boggs) wrote to the **ADNDRC-HK** in the Chinese language requesting for copies of certain pages of the annexes of the Complaint as well as requesting that the proceedings be held in the Chinese language.

On 27 December 2017, the **ADNDRC-HK** wrote to the Respondents (copying the Complainants) seeking whether the Respondents wished to file a request (by 11 January 2018) for the proceedings to be held in the Chinese language in order that the Panelist (once appointed) can make a determination as to the language of the proceedings.

On 29 December 2017, the Complainants wrote to the **ADNDRC-HK** (copying the Respondents) stating that they would “*request English be used as the proceeding language in this Complaint*” and cited four reasons for such, namely (1) paragraph 11 of the Rules – unless otherwise agreed by the Parties, the default language of the proceeding is the language of the Registration Agreement; (2) Respondents reside in Australia; (3) website of the **Disputed Domain Name 1** displays English contents; and (4) “*From the respondent or his*

representative's response, it is obvious the respondent or his representative understands the proceeding well even though the language is English. Thus, using English will not affect the respondent's engagement in the proceedings".

On 8 January 2018, the **ADNDRC-HK** sent an email to Dr. Christopher To enquiring from him whether he can act and if so whether he can act independently and impartially in the matter in question. The **ADNDRC-HK** also stated in the email that it had not received a response to the Complaint from the Respondents.

On 9 January 2018, Dr. Christopher To sent an email to the **ADNDRC-HK**, confirming that he is able to take on the reference and the he does not have a conflict of interest in the matter on hand.

On 9 January 2018, the **ADNDRC-HK** sent a Notice of Appointment to Dr. Christopher To and the parties by email confirming Dr. Christopher To's (hereinafter referred to as the "**Panel**") appointment in this matter. The Panel finds that it was properly constituted.

In accordance with Rule 15(a) of the **Rules** of the Uniform Domain Name Dispute resolution Policy, the Panel shall decide the Complaint on the basis of the statements and documents submitted.

Also, according to Rule 15(d) of the **Rules** of the Uniform Domain Name Dispute Resolution Policy this Panel shall issue a reasoned decision.

On 11 January 2018, the **ADNDRC-HK** wrote to the Parties requesting them "*to submit their reasoning as to the language requirement (English/Chinese) ...on or before close of business*

(Hong Kong time 5.00pm) 15 January 2018, otherwise, the Panel shall proceed according to that of the registration agreement as per annex 15 of the Complainant's attachments".

On 11 January 2018, the Respondents filed its Response to the Complaint in the Chinese language with the **ADNDRC-HK** and the Panel (copying the Complainants).

On 12 January 2018, the **ADNDRC-HK** wrote to the Complainants (copying the Respondents) seeking their views on the language of the proceedings.

On 12 January 2018, the Complainants wrote to the **ADNDRC-HK** (copying the Respondents) stating that (a) *"Pursuant to paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement"*, which is English; (b) *"In the email of the respondent's representative dated 11 January 2018, the representative clearly stated that the respondent could not read Chinese"*; (c) *"From the representative of the respondent's response and the representative's official website in English, it is obvious that their representative of the respondent could understand English and they understand the proceeding well enough to file a response"*; (d) *"the resolved websites of the domain names displays contents in English, especially www.tencent.org, evidencing the respondent's ability in understanding and using English"*.

The Complainants further stated that *"it will be fair and equitable to both parties using English as the proceeding language. In light of above, the Complainants request English be used as the proceeding language"*. In the same correspondence the Complainants submitted *"supplementary evidence [an email dated 3 January 2018] evidencing the respondent's bad faith of registering and using the domain name as the respondent aims to sell the domain names to the Complainants"*. A copy of the email (in the Chinese language) by the Respondents representative to the Complainants representative of 3 January 2018 [1.09pm]

was provided to the *ADNDRC-HK*, who forwarded such to the Panel. The email contents indicate some form of initial contact to “*communicate and negotiate*”, also indicated in the said email, the Respondents representative did not provide a copy to the *ADNDRC-HK* and the Panel.

On 15 January 2018, the Panel determined the language of the proceeding and requested the Respondents to translate their submissions into the English language by 17 January 2018.

On 17 January 2018, the *ADNDRC-HK* informed the Parties and the Panel that the Respondents submitted their response in the English language and the Respondents provided information pertaining to the Complainants “*supplemental evidence*” as filed on 12 January 2018.

On 23 January 2018, the Complainants wrote to the *ADNDRC-HK* and the Panel stating that “*After the respondent filed the response together with its supplementary filing, the Complainants conducted further search and found more evidence essential to the case*” and as such submitted additional information to the Panel for consideration.

On 25 January 2018, the *ADNDRC-HK* wrote to the Parties stating that “*The Panelist would like the Respondent to comment on the Complainant’s submissions of 23 January 2018 on or before 30 January 2018*”.

On 31 January 2018, the *ADNDRC-HK* wrote to the Parties and the Panel stating that “*We received no comments from the Respondent on the Complainant’s submissions of 23 January 2018 within the stipulated timeframe. Since there is no response from the Respondent, the Panelist will proceed to draft the decision...*”.

On 31 January 2018, after the *ADNDRC-HK* correspondence, the Respondents wrote to *ADNDRC-HK* and the Panel (copying the Complainants) (in both Chinese and English) commenting on the Complainants supplementary information filed on 23 January 2018.

On 31 January 2018, the *ADNDRC-HK* wrote to the Panel copying the Parties by stating that “...once the Respondent has commented on the matter, unless the Complainant has further matters they would like to raise, the Panel will close proceedings on 4 February 2018 and proceed to draft the decision...”

On 4 February 2018, the *ADNDRC-HK* did not receive any further comments from the Parties and as such the Panel closed the proceedings and proceeded to draft the decision.

3. **Factual background**

For the Complainants

Tencent Technology (Shenzhen) Company Limited was established in November 1998 as a limited company in Shenzhen, Mainland of China and is one of the largest internet service providers in the Mainland of China, whereas Tencent Holdings Limited is an affiliated company of Tencent Technology (Shenzhen) Company Limited and has been listed in the Hong Kong Stock Exchange (SEHK 700) since 2004, both companies are members of the Tencent Group (hereinafter known as the “*Complainants*”).

The Complainants provide internet, mobile as well as telecommunication services and online advertising. The Complainants operate internet platforms such as QQ (QQ Instant Messenger), WeChat (a social media application with instant messaging, commerce and

payment services), Tencent Games, Tencent Comic, Tencent Pictures, Tencent News, Tencent Video.

The Complainants states that its services are widely recognized both inside the Mainland of China and internationally including Australia as evident by the various submissions provided by the Complainants in their Complaint. In particular the Complainants stated that *“the Complainants enjoy huge fame and reputation worldwide, including in Australia. The panel holds in Tencent Technology (Shenzhen) Limited v. Asia-Pacific Technology Group Co. Limited, ADNDRC Case No. HK-1300520, that ‘the Complainant has a widespread reputation in Internet, media and telecommunication industry in the world.’ The panel in Tencent Holdings Limited v. Ning Yang, WIPO Case No. D2012-2330, finds the trademark of Tencent has a strong reputation and is widely known... Complainants have obtained extremely high reputation over the mark TENCENT through continuously use and widespread advertisement, thus ...has civil rights over the mark... since 1998”*.

According to the Complainants, they have been *“using TENCENT as trademark around the world since 1998 and the mark has become a distinctive identifier which consumers associate with the Complainants’ goods and services”*. The Complainants further state that they were *“awarded the Trademark Innovation Award by the World Intellectual Property Organization and the China State Administration for Industry and Commerce ...to commend the novelty, distinctiveness and reputation of the Complainant’s trademarks”*.

The Complainants official website is www.tencent.com of which the Complainants have been advertising their goods and services through this site since 1998.

The Complainants stated that their domain name <terncent.com> (14 September 1998) predates the registration dates of the *Disputed Domain Names* <tencent.biz> (28 November 2001) and <tencent.org> (26 August 2015) and that Complainants enjoy civil rights over the domain name <tencent.com>.

The Complainant is and was at all material times the registered proprietor of the trademark “*Tencent*”; “*TENCENT*” and “*Tencent 腾讯*” in Mainland of China, Hong Kong, Australia, Singapore, European Union as shown below:-

Mark	Registration No.	Country	Application Date	Valid Period
Tencent	1752676	China	2001.04.13	2002.04.21- 2022.04.20
Tencent	1962826	China	2001.08.31	2003.02.28- 2023.02.27
TENCENT	300169506AA	Hong Kong	2004.06.07	2004.03.02-2024.03.01
TENCENT	301038889	Hong Kong	2008.01.24	2008.01.24-2017.01.23
Tencent 腾讯	1414636	Australia	2011.03.16	2011. 03.16-2021. 03.16
Tencent 腾讯	T1310689C	Singapore	2013.07.04	2013.07.04-2023.07.04
TENCENT	006033773	EUIPO	2007.06.15	2007.06.15-2027.06.15

For the Respondents

The Respondents, “stone stone” and “Paul deng” are individuals presuming to be residing at 33 Glenvale Crescent, Mulgrave, AP, 3170, Australia.

The *Disputed Domain Names* were registered [<tencent.biz> (28 November 2001) <tencent.org> (26 August 2015)] by the *Registrar* in the name of “Paul deng” and “stone stone”.

The <tencent.org> *Disputed Domain Name 1* resolves to a website that displays items such as “*Payroll System Software, Tencent qq, Apps for Business, Payroll Software Free Download, Scheduling Software*” whereas the <tencent.biz> *Disputed Domain Name 2* does not resolve to any active website.

On 17 January 2018, the Respondents filed their Response to the Complaint in the English language using “Form R” to the *ADNDRC-HK*.

4. Parties’ Contentions

A. Complainants

The Complainants contentions may be summarized as follows:

Consolidations

The Complainants are of the view that although “*the Domain Name <tencent.biz>’s registrant is Paul deng, while <tencent.org>’s registrant is stone stone, the Complainants believe that the registrant Paul deng is associated with stone stone and that the Domain Names are subject to their joint control*” on the basis that the information contained in the whois in the context of email address “*helenrock@europe.com*” and postal addresses “*33 Glenvale Crescent, Mulgrave, AP, 3170, Australia*” are the same. The Complainants further states that “*According to 4.11.2 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions 3.0, ‘Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants’ identity(ies) including pseudonyms, (ii) the registrants’ contact information including email address(es), postal address(es), or*

phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s)', in this Complaint, both the registrant emails is helenrock@europe.com, and contact address "33 Glenvale Crescent, Mulgrave, AP, 3170, AU", proving the respondents' common control over the Domain Names".

The Complainant advocates that consolidation "*avoids unnecessary multiplication of time, effort and expense. The consolidation is fair and equitable to both parties*" and requests the consolidation of the ***Disputed Domain Names*** to be determined at the same time by the Panel.

(i) **Disputed Domain Names are confusingly similar to the Complainants marks**

The Complainants contend that, the registration date of the ***Disputed Domain Names*** is later than the usage of the "TENCENT" mark (since 1998). The Complainants advocate that the mark "TENCENT" "*has acquired distinctiveness through continuously use and become an identifier which consumers associate with the Complainants' good and services...enjoy rights over the unregistered mark TENCENT since 1998, far predating the registration dates of*" the ***Disputed Domain Names***.

The Complainants further contends "*that unregistered trademark constitutes civil rights for UDRP proceeding and that the secondary meaning of the unregistered trademark may only exist in particular geographical area does not preclude the Complainants from establishing trademark rights, see 1.3 WIPO Overview 3.0, and also see Uitgeverij Crux v. W. Frederic Isler, WIPO Case No. D2000-0575*". The Complainants supports such a stance by quoting "*Paragraph 1.1, WIPO Overview 3.0,*

‘The term ‘trademark or service mark’ as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks’.

The Complainants states that *“the generic top-level domain suffixes including ‘.org’ and ‘.biz’ would be disregarded in assessing the similarity between a disputed domain name and a mark in which a complainant have rights. See Pfizer Inc v. Michel Merts, WIPO Case No. D2005-0150; Telstra Corporation Limited v. Ozurts, WIPO Case No. D2001-0046... Hence, the dominant components of the Domain Names are ‘tencent’, wholly incorporating the Complainants’ well-known trademark TENCENT in their entirety”.*

The Complainants further states that *“Reproduction of the Complainant’ TENCENT trademark in entirety in the Domain Names in itself establishes that the Domain Names are confusingly similar to the Complainant’ trademark. See EAUTO, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc., WIPO Case No. D2000-0047, ‘When a domain name incorporates, in its entirety, a distinctive mark, that creates sufficient similarity between the mark and the domain name to render it confusingly similar’. See Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903, ‘The fact that a domain name wholly incorporates a complainant’s trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks’.*

The Complainants draw to the Panel’s attention *“Paragraph 2.10, WIPO Overview 3.0, ‘Panels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate*

interests on the respondent; panels have held that mere arguments that a domain name corresponds to a dictionary term/phrase will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights”.

(ii) **The Respondents have no rights or legitimate interests in respect of the Disputed Domain Names**

The Complainants contend that, there is no evidence to prove that the Respondents have any prior rights relating to “TENCENT” or similar marks, nor did the Respondents claimed any civil rights in relation to them, nor did the Respondents obtain authorization from the Complainants to register the *Disputed Domain Names*. The Respondents are not affiliated in any way with the Complainants.

The Complainants advocates that “*mere registration of a domain name is insufficient for establishing rights or legitimate interests so as to avoid the application of paragraph 4(a)(ii) of the Policy. See Potomac Mills Limited Partnership v. Gambit Capital Management, WIPO Case No. D2000-0062*”.

The Complainants state that “*There is no indication that the Respondents demonstrated, before notice of the dispute, use of or demonstrable preparations to use the Domain Names in connection with a bona fide offering of goods or services, or that the Respondents are making legitimate noncommercial or fair use of the Domain Names. The Respondents are passively holding the Domain Names... There is no*

evidence indicating that the Respondents have been commonly known by the Domain Names, nor any plausible explanation exists to suggest the possibility of any circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances giving rise to a right to or legitimate interest of the Respondents in the Domain Names”.

The burden of proof shifts to the Respondent once the Complainant provides prima facie evidence showing that the Respondent lacks legitimate rights or interests.

(iii) The Respondents have shown bad faith in registering and using the Disputed Domain Names

The Complainants contend that there is already evidence of bad faith since the Respondents have no rights or legitimate interests in the *Disputed Domain Names*.

The Complainants state that “*widely known trademark in a domain name is a clear indication of bad faith in itself, even without consideration of other elements. See Reuters Limited v. Global Net 2000, Inc., WIPO Case No. D2000-0441*”.

The Complainants further state that “*There is no plausible explanation as to why the Respondents selected the marks TENCENT as the dominant part of the Domain Names other than to exploit the goodwill of the Complainants and the TENCENT trademark to make illegitimate interests. See Alstom v. Yulei, WIPO Case No. D2007-0424, [T]he Panel finds that it is not conceivable that the Respondent would not have had actual notice of the Complainant’s trademark rights at the time of the registration of the domain name. Consequently, in the absence of contrary evidence from the*

Respondent, the Panel finds that the ALSTOM trademarks are not those that traders could legitimately adopt other than for the purpose of creating an impression of an association with the Complainant'".

The Complainants advocate that the Respondents are merely passively holding onto the **Disputed Domain Names** and quotes the cases of "*Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; McDonald's Corporation v. Easy Property, WIPO Case No. D2006-1142*" as evidence of such bad faith usage.

The Complainants state that Respondents are "*selling the Domain Name <tencent.biz> on Sedo.com ... at which the price is in excess of his out-of-pocket cost directly to the Domain Names, and therefore it is clear that the Respondents registered the Domain Name primarily for the purpose of selling the Domain Name for valuable consideration in excess of his documented out-of-pocket costs directly related to the Domain Name*".

The Complainants state that the **Disputed Domain Name 1** <tencent.org> has a variety of advertising links associated with the site thus "*severely disrupting the Complainant's business*".

The Complainants state that the Respondents "*acquired the Domain Name <tencent.biz> from the previous registrant 'huangshilei' around February 2013*" thus "*domain name transfer constitutes new registration, which means the respondent registered the Domain Name <tencent.biz> in 2013, at which time Complainants and TENCENT mark have become well-known around the world*".

The Complainants also state that “*Complainants believe that the respondent knew or should have known Tencent Group and TENCENT mark at the time of registering the Domain Names. The respondent’s family name “deng”, indicated that he is possibly a Chinese resident. In 2001, Complainants’ group Tencent Group has been well-known through media exposure and the respondent should have known Tencent Group and its TENCENT mark when registering <tencent.biz>. Moreover, the resolved website of <tencent.org> clearly bears the Complainants’ TENCENT and QQ trademarks, evidencing the respondent’s knowledge of Complainants and TENCENT mark. However, the respondent turned his blind eye on the Complainants’ well-known trademark TENCENT and registered the Domain Names. Thus, it could be easily concluded that the respondent registered the Domain Names in bad faith*”.

The Complainant raised the issue of the Respondents email of 3 January 2018 [1.09pm] in which the Respondents attempted to “*communicate and negotiate*” with the Complainants about the ***Disputed Domain Names*** (without copying the Panel and the ***ADNDRC-HK***) which the Complainants believe is clear evidence of bad faith.

For the foregoing reasons, the Complainants submit that there is a prima facie case that the Respondents have shown bad faith in registering and using the ***Disputed Domain Names***.

In gist, the Complainants asserted that all of the 3 elements as aforementioned have been satisfied in this case, the Complainants seeks to ask the Panel to make an order that the ***Disputed Domain Names*** be transferred to the Complainant.

B. Respondents

The Respondents contentions may be summarized as follows:

When the Respondents registered the *Disputed Domain Name 1* “tencent.org” on 26 August 2015, it had already registered the *Disputed Domain Name 2* “tencent.biz” for a period of fourteen years.

The Respondents are aware of the fact that the *Disputed Domain Names* “are the same as or similar to the trademark TENCENT owned by the complainant”. The Respondents had no intentions to infringe the Complainants prior rights.

The Respondents registered the *Disputed Domain Names* because of the “ten cent” term, which is a commonly used term in the English-speaking countries and quotes to the Panel extracts of Wikipedia, “*The Australian ten-cent coin is a coin of the Australian dollar*”; *in the U.S. dollar currency system, “The dime, in US usage, is ten-cent coin ...It is not the originality of the complainant, let alone the exclusive use of the complainant”*.

The Respondents advocate that they “*did not have any intentions and behaviors of clinging to the complainant’s goodwill, damaging or exploiting the complainant’s business after registration*”, as the Complainants business is mainly focused within the Mainland of China whereas the Respondents are located in Australia.

The Respondents state that they have not had a history of infringing other people’s legal rights and that the sole purpose of registering the *Disputed Domain Names* was

to enjoy the legal right arising from the phrase “*ten cent*”. There were no malicious intentions whatsoever.

The Respondents advocate that they registered the *Disputed Domain Name 2* “tencent.biz” on 28 November 2001, whereas the Complainants earliest registration of a trade mark was on 21 April 2002 in the Mainland of China, which “*was significantly later than the domain name tencent.biz*”.

The Respondents claim that they were not aware of the Complainants nor the “TENCENT” trademark when they registered the *Disputed Domain Name 2* “tencent.biz” (some 17 years ago) as the internet business at that time was not that vibrant within the community.

The Respondents drew to the Panel’s attention “3.8.1 of *WIPO Jurisprudential Overview 3.0* it is clearly stated that ‘where a respondent registers a domain name before the complainant’s trademark rights accrue, panels will not be found for bad faith on the part of the respondent’”.

The Respondents believe that “*the reason for registering the domain name (ten cent is the commonly used phrase), the registration time of the domain name tencent.biz, the complainant’s country and language, the complainant’s trademark registration time and other factors, it can be fully proved The respondent registered the domain name tencent.biz without any malice on the complainant*”.

The Respondents did not sell, lease or transfer the *Disputed Domain Names* nor to attract for profit internet users to visit the *Disputed Domain Names*. The Respondents simply likes to hold onto the *Disputed Domain Names*.

The Respondents were surprised when the Complainants raised the issue of SEDO.com as the Respondents had no intentions of selling the *Disputed Domain Names* and immediately contacted SEDO.com to ask them to remove the information.

The Respondents confirm that the *Disputed Domain Names* are not actually used, and the Respondents did not maliciously use the *Disputed Domain Names*, even though the <tencent.org> points to a parking page with multiple links to other websites, the Respondents believe that without operational log records, it would be difficult for the Complainants to proof that the Respondents were benefiting from advertising revenue. The Respondents further state that the alleged “*parking page*” as advocated by the Complainants is simply “*an ordinary third-party connection*” and is associated with business users, which the Respondents state that “*Although the complainant has a wide range of businesses in Mainland China, most of them are concentrated in individual users and do not involve business users...Therefore, the content of the parking page did not make any use of the influence of the goodwill of the complainant or infringe upon any of the complainant’s rights and interests*”.

The Respondents wrote to the domain name registrar of the parking page to clarify and “*Domain name register replied to the message that the domain name resolution does not point to the third-party parking page...the respondent believed that when the user accessed the domain name through the Internet, the middle of the domain name*

resolution path was maliciously hijacked by a third party, and the possibility of profiting through advertising is very high”.

Although the Respondents ***Disputed Domain Name 2*** <tencent.biz> was transferred in 2013, the Respondents state that *“the transfer was not a ‘attorn’ but merely change of domain name registrar. The domain name was still held by the respondent”.*

The Respondents raised questions on the Complainant’s supplementary material in particular the case of D2000-2003 in which the Respondents state that the case was written 17 years ago, *“the UDRP and its rules have changed several times...there is no requirement that registered domain names must be put into use or simply be considered as ‘maliciously used’ only because they are not used specifically”.*

As to the Respondents email of 3 January 2018 [1.09pm] the Respondents stated that *“the respondent and the complainant contact for negotiation and do not have any intentions to transfer the complainant at a high price to seek improper benefits. If the respondent has the above intent, he will not hold the domain name for more than 10 years and should contact the complainant long ago”.*

For the foregoing reasons, the Respondents submit that there is a prima facie case that the Complainants have not established bad faith of the Respondents in registering and using the ***Disputed Domain Names***.

In gist, the Respondents asserted that all of the 3 elements in paragraph 4(a) of the Uniform Domain Name Dispute Resolution Policy have not been satisfied by the Complainants.

5. Findings

A. The Language of the Proceedings

The Internet Corporation For Assigned Names and Numbers Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) Paragraph 11 (a) provides that:

“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.”

In the present case the Parties had not agreed to use a particular language for these proceedings. As the Registration Agreement is in the English language as confirmed by the **Registrar** in its email of 15 December 2017 then in accordance with Article 11(a) of the Rules for Uniform Domain Name Dispute Resolution Policy the language of the administrative proceedings shall be in the English language.

Paragraph 11(a) of the Rules allows the Panel to determine the language of the proceeding having regard to all the circumstances. In particular, it is established practice to take paragraphs 10(b) and (c) of the Rules into consideration for the purpose of determining the language of the proceeding, in order to ensure fairness to the Parties and the maintenance of an inexpensive and expeditious avenue for resolving domain name disputes. Language requirements should not lead to undue burdens being placed on the Parties and undue delay to the proceeding.

In exercising its discretion to use a language other than that of the Registration Agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time and costs.

In these circumstances given that the Complaint is drafted in the English language which is in line with the Registration Agreement and that the Respondents have not put forward convincing arguments to the contrary to advocate the use of the Chinese language for the administrative proceedings, whereas the Complainants have put forward four convincing arguments as per its email correspondence of 12 January 2018 [16:13], the Panel considers that it would be appropriate (and without prejudice to any of the Parties) for the present proceedings to be conducted in the English language.

The Panel through the *ADNDRC-HK* informed the Parties of such a decision on 15 January 2018, in which the Respondents filed its Response to the Complaint in the English language on 17 January 2018.

B. Consolidations

In terms of consolidations, the *ADNDRC-HK* determined this matter and consolidated the *Disputed Domain Names* to be heard by the same Panel. The Respondents throughout the proceedings did not raise any concerns about the consolidation of the *Disputed Domain Names* to be heard by the same Panel.

C. Discussions and Findings

Having considered all the documentary evidence before me, the Panel is of the view that it should proceed to decide on the *Disputed Domain Names*, namely <tencent.org> and <tencent.biz> based upon the evidence adduced by the Parties.

The Complainant must prove each of the three elements in paragraph 4(a) of the Policy in order to prevail, namely:

- i. The domain names registered by the Respondents are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- ii. The Respondents have no rights or legitimate interests in respect of the domain names; and
- iii. The domain names registered by the Respondents have been registered and are being used in bad faith.

i. **Identical / Confusingly Similar**

Paragraph 4(a)(i) of the *Policy* requires the Complainants to prove that the *Disputed Domain Names* are identical or confusingly similar to a trademark or service mark in which the Complainants have rights.

The Complainants provided sufficient information to the Panel to establish that it had built up considerable good will around the “TENCENT” mark and that it had acquired distinctiveness through extensive use by the Complainants in commerce in various jurisdictions around the world and through its domain name <tencent.com> (which was registered on 13 September 1998) usage as a website since 1998, thereby establishing secondary meaning in the mark. The Panel agrees with the Complainants contentions and finds that continuous use since 1998, holding an identical domain name, and media recognition all serve to establish secondary meaning. As such the Complainants have developed sufficient goodwill in their “TENCENT” mark to give rise to common law trademarks rights.

Although the “TENCENT” mark was first registered as a Trademark in the Mainland of China on 21 April 2002 which is later than the registration of the *Disputed Domain Name 2* <tencent.biz> on 28 November 2001 by the Respondents, nevertheless the Panel is of the belief that given the Complainants have been in business since 1998 and that the Complainants have provided the Panel with sufficient evidence that it existed prior to the *Disputed Domain Name 2* <tencent.biz> registration on 28 November 2001, the Panel believes that it is not relevant to the assessment of rights in a trademark under paragraph 4(a)(i) of the Policy, nevertheless it may however be relevant to the assessment of registration in bad faith under paragraph 4(a)(iii) of the Policy [*Reference paragraphs 1.3 and 3.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”)*].

The *Disputed Domain Names* <tencent.org> and <tencent.biz> reproduces the Complainants mark in its entirety, with no alteration and no adjunction other than the extensions “.org” and “.biz”, which should be ignored for the purposes of assessing the confusing similarity. The Panel accordingly finds that the *Disputed Domain Names* are identical to a mark/trademark in which the Complainants have rights.

The Complainants have satisfied the condition set forth in paragraph 4(a)(i) of the Policy.

ii. Rights and Legitimate Interests

While the overall burden of proof in Uniform Domain Name Proceedings (“UDRP”) is on the Complainants, panels in other cases have recognized that proving Respondents lack rights of legitimate interests in a domain name may result in the often impossible task of “*proving a negative*”, requiring information that is often primarily within the knowledge or control of the Respondents. As such, where Complainants make out a *prima facie* case that the Respondents lack rights or legitimate interests, the burden of production on this element shifts to the Respondents to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the Respondents fail to come forward with such relevant evidence, the Complainants are

deemed to have satisfied the second element [*Reference paragraphs 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”)*].

Paragraph 4(c) of the *Policy* provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate the Respondents have rights or legitimate interest in the *Disputed Domain Names* :

- “(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 organization) 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.”*

In this case, the Complainants make the following allegations:

- There is no relationship between the Parties that would give rise to any license, permission or authorization for the Respondents to use or register the *Disputed Domain Names*.
- The Respondents do not appear to have used the *Disputed Domain Names* in connection with an active website, this was confirmed by the Respondents in their email to the Panel on 31 January 2018 [4.50pm].

- There is no evidence of *bona fide* use by the Respondents of the *Disputed Domain Names* this too was confirmed by the Respondents in their submissions.
- There is no evidence that the Respondents have been commonly known by the *Disputed Domain Names* nor evidence of legitimate use, this too was confirmed by the Respondents in their submissions.

The Complainants have not authorized, licensed, or permitted the Respondents to register or use the *Disputed Domain Names* or to use the marks/trade marks. The Panel finds on the record that there is therefore a *prima facie* case that the Respondents have no rights or legitimate interests in the *Disputed Domain Names*, and the burden is thus on the Respondents to procedure evidence to rebut this presumption.

The Respondents have failed to show that the Respondents have acquired any trade mark rights in respect of the *Disputed Domain Names* or that the *Disputed Domain Names* have been used in connection with a bona fide offering of goods or services. The Respondents registered the *Disputed Domain Names* because of the “common phrase ‘ten cent’”, a mere interest in the phrase ‘ten cent’ shows a lack of rights or legitimate interests in the *Disputed Domain Names*.

There has been no evidence adduced to show that the Respondents have been commonly known by the *Disputed Domain Names*, and there has been no evidence adduced to show that the Respondents are making a legitimate non-commercial or fair use of *the Disputed Domain Names*.

The Panel finds that the Respondents have failed to produce any evidence to rebut the Complainants *prima facie* case that the Respondents lack rights or legitimate interest in

the *Disputed Domain Names*, and therefore finds that the Complainants have satisfied the condition set forth in paragraph 4(a)(ii) of the Policy.

iii. Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, 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.*

On this aspect, the Complainants must prove the conjunctive requirement that the *Disputed Domain Names* have been registered and is being used in bad faith. Failure to prove either would be detrimental to the Complainants case.

With regard to registration in bad faith, the Complainants face the hurdle that its earliest registered trademark post-dates the creation date of the *Disputed Domain Name 2* <tencent.biz> by less than five months. However from the Complainants submissions and the reasoning stated below, the Panel is able to determine that the Respondents are unfairly capitalizing on the Complainants nascent trademark rights (as yet unregistered at that time) and on this basis is of the view that the Respondents did register the *Disputed Domain Names* in bad faith.

Given that “TENCENT” is not a dictionary word, that the *Disputed Domain Names* are strictly identical to the Complainants mark and that the Complainants registered the domain name <tencent.com> in 1998 and that the Respondents surname is Chinese “deng”, the Panel accepts that the Respondents probably knew of the Complainants mark when they registered the *Disputed Domain Names*. In such circumstances, the integral reproduction of the “TENCENT” mark within the *Disputed Domain Names* and that the Respondents registered the *Disputed Domain Names* simply because of the phrase “ten cent” can hardly be the result of a mere coincidence, and as such the Panel is of the belief that the Respondents were aware of the Complainants rights and activities.

The website of *Disputed Domain Name 1* <tencent.org> contains the words “Tencent qq” which is identical to the instant messaging service provided by the Complainants and this service has been in place since 1999. The Panel is of the view that the Respondents must have known about the Complainants instant message service “QQ” when they registered the *Disputed Domain Names* and as such with the intention of either “*disrupting*” or

“attracting for commercial gain” some of the Complainants business. The Panel believes that this falls within the parameters of 4(b) of the Policy.

The Respondents have not made any active use of the *Disputed Domain Names* and this was confirmed by the Respondents in their submissions and their email of 31 January 2018 [4.50pm].

From the inception of the UDRP, panels in other cases have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of “*passive holding*”.

“From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (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.” [Reference paragraphs 3.0 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) and Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003].

Given the exact identity between the mark “TENCENT” and the *Disputed Domain Names*, and the absence of any relationship between the Respondents and the Complainants, it is difficult to imagine what legitimate use the Respondents could make

of the *Disputed Domain Names*. On the other hand, the Respondents did not seek to conceal its identity, but attempted to “*communicate and negotiate*” with the Complainants by email (3 January 2018 [1.09pm]) but provided no convincing reasons to the Panel as to why issue the email in the first place when the Parties were within the ambit of the UDRP administrative proceedings. The Panel is more convinced of the arguments put forward by the Complainants that the Respondents are attempting to transfer the *Disputed Domain Names* to the Complainants for some consideration.

In a well-reasoned decision concerning the passive holding of the domain names <aventisdirect.net> and <aventisdirect.org>, the panel made a finding of bad faith use even though the respondent had not taken steps to conceal its identity (*Aventis and Aventis Pharma SA. v. Bug Software/Paulo Andrade, WIPO Case No. D2004-0878*):

“It is less clear whether it can be established that the disputed domain names were also used in bad faith. The panel agrees with the prevailing opinion of numerous WIPO panels- that in some circumstances so-called ‘passive holding’ of a domain name can be treated as using it in bad faith. The leading case in this regard is Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, which was also cited by the Complainants. In this respect it is necessary to note that not every kind of passive holding may be found to be ‘use in bad faith’ of the domain name. Otherwise, the necessity to prove that a domain name was actually used would be illusory.

The most obvious examples of passive holding which fall within “bad faith use” of a domain name are cited in Paragraph 4(b)(i-iii) of the Policy. However, circumstances of the present case are apparently different.

In Telstra it was stated that it is not possible to determine in abstract what circumstances of passive holding other than those identified in the Policy can constitute bad faith use, and in considering whether the passive holding of a domain name following its bad faith registration satisfies the requirements of Paragraph 4(a)(iii), the Administrative Panel must give close attention to all the circumstances of the Respondent's behavior. In opinion of this Panel a failure to determine in abstract what circumstances of passive holding constitutes 'bad faith use' does involve a risk that a decision in this matter may seem arbitrary. However, the Panel must take into account that the opinion of the learned Panelist in Telstra was followed by numerous subsequent panelists and that the need for consistency plays a significant role in domain name dispute 'jurisprudence'.

In the Telstra case, the panelist identified five circumstances that persuaded it to conclude that the respondent's passive holding of a domain name could be regarded as "*bad faith use*" of it.

These five circumstances are as follows:

- “(i) the Complainant's trademark has a strong reputation and is widely known, as evidenced by its substantial use in Australia and in other countries,*
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name,*
- (iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name,*

- (iv) *the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement, and*
- (v) *taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law."*

The present matter is somewhat similar to those aspects of the Telstra case (the Complainants cited the case in their submissions) but there are also differences. In the present case it has not been established that the Respondents took any steps to conceal their true identity or provided false contact details. However, it seems that not all the five circumstances mentioned above are of the same significance. In particular it seems that the fifth element (i.e., impossibility to conceive of any plausible active use) is actually a conclusion of the preceding four elements and that this fifth element plays a decisive role in determining whether any particular passive holding can be regarded as a “*bad faith*” use of a domain name in dispute.

As the *Disputed Domain Names* are strictly identical to the Complainants distinctive mark, consumers would certainly mistakenly assume that an active website connected to the *Disputed Domain Names* is operated or endorsed by the Complainants, when such is not the case.

The Panel accordingly reaches the conclusion that the passive holding of the *Disputed Domain Names* amounts to use in bad faith given the circumstances of the case.

For the reasons set out above, the Panel finds that the Respondents have registered and used the *Disputed Domain Names* in bad faith, and that the Complainants have satisfied the condition set forth in paragraph 4(a)(iii) of the Policy.

6. Decision

For the foregoing reasons, in accordance with paragraph 4(i) of the Policy and paragraph 15 of the Rules, The Panel orders that the *Disputed Domain Names* <tencent.org> and <tencent.biz> be transferred to the Second Complainant, Tencent Holdings Limited.

A handwritten signature in black ink, appearing to read 'Christopher To', with a large, stylized flourish extending upwards and to the right.

Dr. Christopher To
Sole Panelist

Dated: 20th February 2018