



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No:	HK-2001404
Complainant:	Television Broadcasts Limited
Respondent:	Tran Le Tuan
Disputed Domain Name:	<xemphimtvb.com>

1. The Parties and Contested Domain Name

The Complainant is Television Broadcasts Limited (“**Complainant**”) of Legal and Regulatory Department, 10/F, Main Block, TVB City, 77 Chun Choi Street, Tseung Kwan O Industrial Estate, Kowloon, Hong Kong.

The Respondent is Tran Le Tuan (“**Respondent**”), of 314 au dong lan, tphcm. Tphcm/P Vietnam Postal Code 700000.

The domain name at issue is <xemphimtvb.com> (“**Domain Name**”) registered by Respondent with NameCheap, Inc of Namecheap Legal Department, 4600 East Washington Street, Suite 305, Phoenix, AZ 85034, USA (“**Registrar**”).

2. Procedural History

On 17 November 2020, the Complainant filed a Complaint with the Hong Kong Office of Asian Domain Name Dispute Resolution Centre (“**ADNDRC**”), pursuant to the Uniform Domain Name Dispute Resolution Policy (“**Policy**”) approved by the Internet Corporation for Assigned Names and Numbers (“**ICANN**”) on 24 October 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (“**Rules**”), approved by ICANN Board of Directors on 28 September 2013 and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (“**Supplemental Rules**”) effective from 31 July 2015. The Complainant chose to have a sole panelist to handle the dispute.

On 17 November 2020, the ADNDRC transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same day, the Registrar transmitted by email to the ADNDRC its verification response confirming that the Respondent is listed as the registrant and providing the contact details. On 24 November 2020, the ADNDRC notified the Complainant of the deficiencies in the Complaint. On 25 November 2020, the Complainant filed a rectified Complaint. The ADNDRC formally notified the Respondent of the Complaint and the proceedings commenced on 25 November 2020. The ADNDRC did not receive any formal response from the Respondent

within 20 calendar days as required under paragraph 5 of the Rules. Accordingly, on 21 December 2020, the ADNDRC informed the parties that no response has been received and it would shortly appoint a single panelist.

On 30 December 2020, the ADNDRC appointed Ms. Karen Fong as sole Panelist in this matter. The Panelist accepted the appointment and has submitted a statement to the ADNDRC that she is able to act independently and impartially between the parties.

3. Factual background

The Complainant, commonly known as TVB, is the first wireless commercial television station in Hong Kong. It was first established in 1967 with only about 200 staff. The Complainant has now grown to a size of over 3,600 staff and artistes worldwide. Shares of the Complainant have been publicly listed on the Hong Kong Stock Exchange since 1988. The principal activities of Complainant are television broadcasting, programme production and other broadcasting related activities such as programme and Video-On-Demand (“VOD”), licensing, digital media business, audio and video products selling and distribution, etc. It is one of the largest producers of Chinese language programmes in the world. Its Chinese programmes are internationally acclaimed and are dubbed into other languages and are distributed to more than 200 countries and regions. The Complainant provides its services all over the world including Vietnam under its TVB brand name.

The Complainant has trade mark registrations for TVB all over the world including Hong Kong and Vietnam. The earliest TVB trade mark registration submitted in evidence is Hong Kong Trade Mark Registration Number 1996088232 which has a registration date of 8 June 1992. The TVB trade mark registration in Vietnam under Trade Mark registration Number 252566 was registered on 3 May 2014 (individually and collectively the “**Trade Mark**”).

The Complainant launched its website at <http://www.tvb.com> in 1999. The website provides worldwide viewers the latest information on the Complainant’s programmes and artistes as well as video clips, live streaming and VOD of its programmes. The Complainant’s programmes and content are also licensed and distributed through the different websites it controls as well as the websites of its partners and licensed distributors. Besides the domain name <tvb.com>, the Complainant and its subsidiaries own and operate over 170 domain names which include the Trade Mark.

The Respondent who is based in Vietnam registered the Domain Name on 28 October 2019. The Domain Name was connected to a website which allowed visitors to view the Complainant’s programmes, without the Complainant’s authorization (the “**Website**”). The Website appears to be targeting a Vietnamese audience. The Domain Name came to the Complainant’s attention in July 2020. Prior to the filing of the Complaint, the Complainant sent cease and desist letters to the Respondent, the Registrar including and prior registrars as well as the Website’s various internet service providers (the “**ISPs**”). The Website is not active at the time of the writing of this decision.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

The Domain Name is identical or confusingly similar to the Trade Mark, that the Respondent has no rights or legitimate interests with respect to the Domain Name, and that the Domain Name has been registered and is being used in bad faith. The Complainant requests transfer of the Domain Name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

5. Findings

A. General

The 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.

B. Identical / Confusingly Similar

The Panel is satisfied that the Complainant has established that it has rights to the Trade Mark.

The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the trade mark and the domain name to determine whether the domain name is confusingly similar to the trade mark. The test involves a side-by-side comparison of the domain name and the textual components of the relevant trade mark to assess whether the mark is recognizable within the domain name.

In this case the Domain Name consists of the Trade Mark in its entirety and the prefix "xem phim" which is Vietnamese for "watch movies" or "watch a film". The addition of these descriptive words before the Trade Mark does not negate the confusing similarity encouraged by the Respondent's complete integration of the Trade Mark in the Domain Name. *E.g., N.V. Organon Corp. v. Vitalline Trading Ltd., Dragic Veselin / PrivacyProtect.org*, WIPO Case No. D2011-0260; *Oakley, Inc. v. wu bingjie aka bingjie wu/Whois Privacy Protection Service*, WIPO Case No. D2010-0093; *X-ONE B.V. v. Robert Modic*, WIPO Case No. D2010-0207. In fact taken together, the Domain Name means "watch TVB movies" or "watch a TVB film" which adds to the confusion. For the purposes of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy, it is permissible for the Panel to ignore the generic Top-Level Domain ("gTLD") which in this case is ".com". It is viewed as a standard registration requirement.

The Panel finds that the Domain Name is confusingly similar to trade marks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

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

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“**WIPO Overview 3.0**”) that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent does come forward with some allegations of evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

The Complainant contends that there is no evidence that the Respondent is commonly known by the Domain Name nor has any trade mark rights to the Trade Mark. Further, it has not authorised, licensed, sponsored or otherwise permitted the Respondent to use the Trade Mark in the Domain Name or for any other purpose. The unauthorised use of the Complainant's content infringes its copyright and other intellectual property rights and therefore does not constitute a bona fide offering of goods or services or legitimate non-commercial or fair use of the Domain Name.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent's has not filed a response. The Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the Domain Name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

D. Registered and Used in Bad Faith

To succeed under the Policy, the Complainant must show that the Domain Name has been registered and is being used in bad faith.

The Panel is satisfied that the Respondent must have been aware of the Trade Mark when it registered the Domain Name given that the Trade Mark is well known and the fact that the Complainant's copyright content is being distributed on the Website.

In the WIPO Overview 3.0, section 3.2.2 states as follows:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

The fact that there is a clear absence of rights or legitimate interests coupled with the Respondent’s choice of the Domain Name is also a significant factor to consider (as stated in section 3.2.1 of the WIPO Overview 3.0). The Domain Name falls into the category stated above and the Panel finds that registration is in bad faith.

The Domain Name is also being used in bad faith. The Website which was set up for users to view the Complainant’s content online was set up for the commercial benefit of the Respondent and in direct competition with the Complainant’s business. It is highly likely that Internet users when typing the Domain Name into their browser, or finding it through a search engine would have been looking for a site operated by the Complainant rather than the Respondent. The Domain Name is likely to confuse Internet users trying to find the Complainant’s website. Such confusion will inevitably result due to the fact that Complainant’s content is on the Website. Such confusion is detrimental to the Complainant’s business of content licensing and distribution given that the Respondent was deliberately misleading users that it is associated with the Complainant by using the Trade Mark in the Domain Name.

The Respondent employs the fame of the Trade Mark to mislead users into visiting the Website instead of the Complainant’s. From the above, the Panel concludes that the Respondent intentionally attempted to attract for commercial gain, by misleading Internet users into believing that the Website is authorised or endorsed by the Complainant. The Panel therefore concludes that the Domain Name has been registered and are being used in bad faith under paragraph 4(b)(iv) of the Policy.

6. Decision

For the foregoing reasons, and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <xemphimtvb.com> be transferred to the Complainant.



Karen Fong
Panelist

Dated: 19 January 2021