



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No. HK-2301746
Complainants: JOHN SWIRE & SONS LIMITED; SWIRE PACIFIC LTD
Respondent: li chao yue (李超月)
Disputed Domain Name(s): < swirelimited.site >

1. The Parties and Contested Domain Name

The Complainants are JOHN SWIRE & SONS LIMITED, of SWIRE HOUSE, 59 BUCKINGHAM GATE, LONDON SW1E 6AJ, UNITED KINGDOM; and SWIRE PACIFIC LTD, of 33rd Floor, One Pacific Place, 88 Queensway, the HKSAR, China.

The Respondent is li chao yue (李超月), of Jin Rong Jie, Qi Qi Ha Er Shi, Hei Long Jiang, 161000 China (中国黑龙江齐齐哈尔市金融街, 邮政编码: 161000).

The domain name at issue is swirelimited.site, registered by the Respondent with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn), of No.20, 13th Floor, Building No.1, No. 55, Xueyuannan Road, Haidian District, Beijing.

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the "Centre") on April 24, 2023 and the Complainants chose a sole panelist to review this case in accordance with the Uniform Domain Name Dispute Resolution Policy ("the Policy") which was adopted by the ICANN and came into effect on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") became effective on September 28, 2013 and the Supplemental Rules thereof which come into effective on July 31, 2015.

On April 24, 2023, the Centre confirmed the receipt of the Complaint and Annexures, and transmitted by email to Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the Registrar of the domain name) a request for registrar verification in connection with the domain name at issue.

On April 26, 2023, the said Registrar verified to the Centre that, the Policy is applicable to the domain name at issue, the Respondent is li chao yue (李超月), and the language used in the Registration Agreement is Chinese.

On April 27, 2023, the Centre sent a deficiency notice to the Complainants requesting them amend the Respondent information in the Complaint on or prior to May 2, 2023; and provide the Registration Agreement regarding the disputed domain name. On the same day, the Centre notified the Complainants that the language in these proceedings should be Chinese whereas their Complaint was filed in English, and requested the Complainants to reply regarding the language to be used in these proceedings, on or prior to May 2, 2023.

On April 28, 2023, the Complainants wrote to the Centre to seek an extension for deficiency rectification and response to the language of these proceedings. On the same day, the Centre notified the Complainants that the deadline regarding the deficiency amendment and language request were extended to May 5, 2023.

On May 2, 2023, the Centre confirmed the receipt of the case fee.

On May 4, 2023, the Complainants sent to the Centre, the amended Complaint and annexures, as well as submissions as to the language of the proceedings. On the same day, the Centre confirmed the receipt of the said documents.

On May 4, 2023, the Centre notified the Complainants as to issues associated with the Registration Agreement that had been provided. On the same day, the Complainants resubmitted the Registration Agreement and an amended language request submission to the Centre. On the same day, the Centre confirmed receipt of the said documents and that the Complaint was in compliance with the Policy and the Rules.

On May 4, 2023, the Centre sent the formal Complaint Notice to the Respondent and requested the Respondent to reply within 20 days (on or prior to May 24) in accordance with the Rules and Supplemental Rules, and forwarded the Complaint as well as all the Annexures thereto. The procedures for this case formally commenced on May 4, 2023. On the same day, the Centre notified the Respondent that the language for these proceedings ordinarily would be Chinese whereas the Complaint has been filed English, and requested the Respondent to reply regarding the language issue, on or prior to May 9, 2023.

On May 25, 2023, the Centre issued a notice which confirmed that the Respondent had not filed any formal reply with the Centre, within the required time limit.

On May 25, 2023, the Centre sent Mr. Matthew Murphy the Panel Appointment Notice. On the same day, Mr. Matthew Murphy submitted an acceptance notice as well as a statement of impartiality and independence.

On May 26, 2023, the Centre notified both parties and Mr. Matthew Murphy, by email that Mr. Matthew Murphy had been appointed the sole panelist for arbitrating this case. The Centre then formally transferred the case to the Panelist. The Panelist agreed to deliver his decision with respect to the disputed domain name on or prior to June 9, 2023.

3. Factual background

For the Complainants

The Complainants, JOHN SWIRE & SONS LIMITED and SWIRE PACIFIC LTD, claim that, JOHN SWIRE & SONS LIMITED is the ultimate parent company of the latter and its other group companies, as well as the owner of the relevant “SWIRE” trademarks; whereas

SWIRE PACIFIC LTD is a publicly listed company established in Hong Kong in 1940 and has been licensed by the former to use the relevant trademarks. The Complainants claim that they are a part of the well-known global conglomerate known as the “Swire Group” which has been operating for over 200 years, and their group has operations across a wide range of businesses including retail, marine services, aviation, property, beverages, hospitality, investment holdings, and trading and industrial areas. The Complainants claim that its group operates an extensive retail and wholesale network of a wide range of products, offers brand management, retail and distribution services for a range of renowned international brands such as Speedo and Columbia in Greater China, as well as engages in extensive advertising, marketing and promotion of its business, goods and services in Hong Kong and worldwide.

The Complainants claim that JOHN SWIRE & SONS LIMITED is the registered proprietor of multiple trademark registrations worldwide and in the Hong Kong SAR and Mainland China for various SWIRE trademarks. The Complainants claim that such trademarks have been registered and used for a wide range of services, including but not limited to “business research and information agency services” and “data processing; database management; updating and maintenance of data in computer databases” in Class 35, and “financial affairs; investment services; leasing of real estate; real estate agencies and brokers; real estate appraisal and management” in Class 36.

The Complainants claim that they have extensively used their trademarks in connection with their various fields of business, such as retail and wholesale services (including those online) of various types of goods, manufacturing, trading and industrial businesses and property interests in multiple ways. The Complainants claim that they have applied “SWIRE” in its own company name and through its international websites “www.swire.com” registered on 15 September 1995 and “www.swirepacific.com” registered on 19 June 1996. The Complainants further claim that, through extensive marketing efforts and use of the trademarks, they have built up and have at all material times enjoyed substantial reputation and goodwill in their business and goods/services provided and marketed under and by reference to the trademarks in the Hong Kong SAR, Mainland China and worldwide; and they have won numerous awards for its business and goods/services provided under the trademarks.

For the Respondent

The Respondent, li chao yue (李超月), is apparently located at Jin Rong Jie, Qi Qi Ha Er Shi, Hei Long Jiang, 161000 China (中国黑龙江齐齐哈尔市金融街, 邮政编码: 161000). The Respondent’s email is listed as zhanlu28950@163.com. The Respondent did not file any information with the Centre to reveal his/her identity and/or background information.

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

The Complainants claim that the gTLD “.site” in the disputed domain name and the term “limited” should be disregarded as they are wholly generic and have no distinctiveness, and the disputed domain name has wholly incorporated the word “swire” which is identical to their trademarks. The Complainants claim that they have established substantial business operations globally in 11 countries and regions, and the disputed domain name is highly confusingly similar to domain names owned by the Complainants including without limitation <swire.com>, and <swirepacific.com>. Thus, the Complainants submitted that the combination of the trademarks along with the generic term “limited” in the disputed domain name would confuse the public that the disputed domain name is related to, or associated with, the business and services of Swire.

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

The Complainants claim that the registration dates of their trademarks predate the registration date of the disputed domain name (December 28, 2022). The Complainants confirm that the Respondent is not affiliated or associated with or related to them or their business in any way, and the Complainants have not authorized, licensed, nor otherwise permitted the Respondent to register the disputed domain name or otherwise use their trademarks. The Complainants claim that since the name of the Respondent does not contain the word “SWIRE”, there would not be any evidence showing that it has been commonly known by the disputed domain name or that it has any rights in a trademark or service mark identical to the disputed domain name. The Complainants further claim that no evidence exists showing that the Respondent has any rights or legitimate interests in the disputed domain name; and the Respondent’s use of the disputed domain name which comprises of a word identical to their trademarks has confused and misled the public into believing that the Respondent has legitimate interests in the disputed domain name. The Complainants also claims that the disputed domain name has not been able to resolve to any active sites since at least around 19 January 2023, which means that the disputed domain has not, before notification of the dispute, used the disputed domain name in connection with the bona fide offering of goods or services.

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

The Complainants claim that they are a well-established conglomerate operating a wide field of business internationally, including without limitation in the Hong Kong SAR, and Mainland China (where the Respondent and the disputed domain name seems to be based). The Complainants claim that the name “Swire” has been used in its business since the 19th century, first in Liverpool, in the UK, where the business was first established by Mr. John Swire in 1816; and they have registered/used their trademarks in connection with their various fields of business, including but not limited to “business research and information agency services”, services relating to “data processing; database management; updating and maintenance of data in computer databases” and “financial affairs; investment services”, as well as various real estate-related services. The Complainants claim that they have also been achieving a strong reputation through use of their trademarks worldwide as it continues to expand and develop their operations in its international offices including in Mainland China, where the Respondent is located; and the public has come to recognize and associate the trademarks as originating from the Complainants.

The Complainants claim that, given their extensive reputation and global operations of various businesses, including in the Hong Kong SAR and Mainland China where the Respondent and the disputed domain name are based, as at the original date of registration, the Respondent must have been aware of the existence of the Complainants and the

trademarks, particularly when “Swire” is not a word commonly used in the English language as an everyday word. The Complainants claim that the word “limited” is a generic word for describing limited liability companies which here references Swire and carries no other plausible meanings. The Complainant claims that bad faith can be inferred from the Respondent’s current non-use and passive holding of the site, since the Complainants’ trademarks are with strong reputation and are widely known as evidenced by its substantial use in Mainland China and other countries/regions; and there is no reasonable justification for the Respondent to register the disputed domain name which wholly incorporates the word “Swire”. The Complainants also claim that although the infringing website is currently inactive, any realistic use of the disputed domain name must misrepresent an association with the Complainants and its goodwill, resulting in passing-off and trademark infringement, and therefore, the registration of the disputed domain name constitutes bad faith.

The Complainants claim that for an unknown period between the registration of the disputed domain name on 28 December 2022 and 19 January 2023, the disputed domain name appeared to resolve to a website as “National Business Solution Inc.” (“NBS”), which claimed to be able “to achieve perfection for customers” and “offer best services for the customers through the scientific theoretical basis and the rich professional experiences”. The Complainants claim that it has no connection with NBS and its company name does not contain the word “Swire”, and therefore there cannot be any plausible or legitimate explanation for the Respondent to use the disputed domain name for NBS. Upon carrying out various online/Internet searches, the Complainants claim, according to the website <https://nbslive.com/>, a company called “National Business Solution, Inc” is in the business of providing tax consulting, accounting, real estate, commercial lending, CPA services and financial advice, which is identical, or similar, to some of the designated services of the Complainants’ trademarks. The Complainants further claim that the Respondent has, without their authorization and/or consent, used the disputed domain name and the infringing website to purportedly advertise and/or provide services which are identical or similar to those of their trademarks; and the Respondent had used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating confusion with the Complainants’ trademarks as to the source and/or affiliation of their website. Thus, the Complainants have submitted that those acts of the Respondent clearly indicate its bad faith to impersonate the Complainants and/or to take a free ride on the Complainant’s goodwill and reputation, thus misleading members of the public. The Complainants also claim that the Respondent has breached Article 3.6.1-3.6.3 of the Registrar’s Registration Agreement which indicates the Respondent’s bad faith.

The Complainants claim that the partially concealing of the Respondent’s contact information from WHOIS searches made them unable to directly contact the Respondent. The Complainants claim that they had reported the disputed domain name to the Registrar on 9 March 2023 which was established upon an email notice dated 4 April 2023 and had been forwarded to the Respondent. The Complainants claim that the Registrar advised the Respondent “to make direct contact with [the Complainants] to resolve this matter”, but no contact took place, which indicates bad faith on the part of the Respondent.

B. Respondent

As far as the Respondent’s claims are concerned, it is noted that the Respondent has not submitted any Reply or other materials.

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.

Language of the Proceedings

The Complaint was filed with the Centre in English, whereas the Registrar of the disputed domain name confirmed to the Centre that the language used in the Registration Agreement is Chinese. When the Complainants were requested to make submissions regarding the language of these proceedings, the Complainants expressed to the Centre that the captioned proceedings should be conducted in English and that the Respondent should be familiar with English and be able to understand the main grounds of the Complaint as follows: 1) the Respondent registered the disputed domain name which contains the Latin alphabet characters of "swire"; 2) the Respondent's name and address provided to the Registrar are in English; 3) the past content of the site located at the address of the disputed domain name was in English; 4) the substantive evidence submitted by the Complainants was predominantly in English, the translation thereof would add unnecessary costs for the Complainants and undue delays to these proceedings.

As it is stated in a previous case (SWX Swiss Exchange v. SWX Financial LTD, D2008-0400, a decision by a WIPO panelist), when deciding "whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all 'the relevant circumstances'". And such circumstances include "whether the Respondent is able to understand and effectively communicate in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties".

Accordingly, the Panel notes circumstances that may affect the determination of the language of the proceedings in the current case as follows: 1) the disputed domain name has resolved to a website that displayed significant English content which indicates the Respondent is probably able to understand English; 2) upon given sufficient time and opportunity, the Respondent did not raise any objection with respect to the Complainants' language request, nor make any comments; and 3) significant time (and costs) would be involved in translating the materials provided by the Complainants from English to Chinese and therefore, a delay in the proceedings will be inevitable. Based on these issues, the Panel considers that it is appropriate to exercise his discretion and conduct the proceedings in English.

A) Identical / Confusingly Similar

The Complainants have submitted evidence to prove their entitlement to the ownership of the “SWIRE” trademarks, and use of the trademarks. Such evidence includes, but is not limited to, the “SWIRE” trademark information in countries and regions, such as Mainland China (e.g. No. 779387 for “SWIRE” in relation to “investment services; financial services; banking; trusts”, and so on, in Class 36 registered on March 14, 1995; No. 777528 for “SWIRE” in relation to “commercial information”, and so on, in Class 35 registered on February 14, 1995, and so on), as well as screenshots of the Complainants’ websites.

Obviously, the disputed domain name < swirelimited.site > completely incorporates the Complainants’ “SWIRE” trademark. “The first and immediately striking element in the domain name is the Complainants’ company/business name, which is also the trademark at issue in this case. Adoption of this trademark in the domain name is inherently likely to lead people to believe that the Complainants are connected with it” - see: *Dixons Group Plc v. Mr. Abu Abdullaah*, a decision by a WIPO Panelist, Case No. D2000-1406. Thus, the complete incorporation of “swire” in the beginning of the disputed domain name will be easy to lead people to consider that the disputed domain name could well be associated with the Complainants somehow.

The addition of the word “limited” does not alleviate confusion concerns, as the domain name “swirelimited” will generally be understood as referring to “swire limited” which looks like a company name and has an effect on implying the content of the website located at the address of the disputed is associated with “swire limited”. Given that both Complainants, JOHN SWIRE & SONS LIMITED and SWIRE PACIFIC LTD, contain “swire” and “limited/ltd” in their company names, the main part of the disputed domain name “swire limited” will easily mislead people to consider such website is associated or affiliated with the Complainants. In other words, the word “limited” added after the Complainants’ trademark in the disputed domain name, does not alleviate confusion concerns and does not distinguish the disputed domain name from the Complainants’ trademark.

As to the gTLD “.site” in the disputed domain name, it should be ignored when it comes to deciding issues of confusing similarity - see: *Rohde & Schwarz GmbH & Co. HG v. Pertshire Marketing, Ltd.*, a WIPO Panelist decision, Case No. D2006-0762, where it was stated that “it is well-established that the “.com” extension should be disregarded for determining confusing similarity.”.

In conclusion, the Panelist finds that the Complainants have satisfied Paragraph 4(a)(i) of the Policy.

B) Rights and Legitimate Interests

Upon comprehensively considering the circumstances of the case, the Panel considers that the Respondent does not have legal rights and interests in the disputed domain name on the grounds that:

(1) without submitting any evidence to prove that the Respondent has any legal rights and interests in the disputed domain name, the Respondent could not sufficiently prove that it “owns legal right and interest thereof” by the mere registration of the disputed domain name” - see: *Adobe Systems Incorporated v. Domain OZ*, a WIPO Panelist decision, Case No.: D2000-0057, where it was stated that if mere registration of the domain names were sufficient to establish rights or legitimate interests for the purposes of paragraph 4(a)(ii) of the Policy, then all registrants would have such rights or interests, and no complainant could

succeed on a claim of abusive registration. In this case, the Respondent could not prove its legal rights and interests in the disputed domain name, without submitting any evidence, merely based on its registration thereof.

(2) The Complainants have confirmed that they have no association with the Respondent, nor authorized, licensed, or otherwise permitted the Respondent to register the disputed domain name or otherwise use their trademarks.

(3) The Respondent has not provided any evidence, and there is no indication showing that, there is any connection or association between the Respondent and the “SWIRE” trademarks, nor any circumstances that it has legal rights and interest stated in the Paragraph 4(c) of the Policy, which provides as follows:

“(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 conclusion, the Panelist finds that the Complainants have satisfied Paragraph 4(a)(ii) of the Policy.

C) Bad Faith

The Complainants, by submitting evidence materials, (e.g. the Complainants’ “SWIRE” trademark registration information for various countries and regions, such as Mainland China, and so on, screenshots of various Swire websites run by the Complainants, awards won by the Complainants, etc.), have proved that they have used their “SWIRE” trademarks extensively and obtained reputation in their certain fields. Based on that, the Complainants further claimed that the Respondent ought to have been aware of the existence of the Complainants and their trademarks, particularly when “Swire” is not a commonly used English word.

Upon comprehensively considering the following circumstances, it is reasonable for the Panel to infer that the Respondent ought to have known of the Complainants, their company/business names and their SWIRE trademarks while registering the disputed domain name, and such registration was carried out in bad faith: 1) the operation and fame of the Complainants and their SWIRE trade marks in various fields, such as financial affairs, investment services, and so on; 2) the similarity between the disputed domain name and the Complainants’ trademark; 3) the similarity between the disputed domain name and the Complainants’ domain names, such as www.swire.com and www.swirepacific.com; 4) there being no legal or factual relationship or connection between the Respondent and the disputed domain name and/or the SWIRE trademarks, nor any other justification for the registration or use of the disputed domain name by the Respondent.

With respect to the use of the disputed domain name, it can be seen from the relevant evidence provided by the Complainants, that the Respondent had resolved the disputed domain name to an English website claiming to be “National Business Solution Inc.” shown in a screenshot thereof taken on January 9, 2023. According to the Complainants’ online research, such National Business Solution Inc. seems to be “in the business of providing tax consulting, accounting, real estate, commercial lending, CPA services and financial advice”,

which happen to be similar to designated services covered by some of the Complainants' SWIRE trademark registrations as submitted, such as China Registration No. 779387 for SWIRE in relation to "investment services; financial services; banking; trusts" in Class 36 (first registered on March 14, 1995).

As stated in a WIPO precedent, which is not legally binding of course, but worthy of reference, "Using the disputed domain name with intention of creating a likelihood of confusion with that of the Complainant's mark as to source, sponsorship, affiliation or endorsement of the Respondent's services by using an identical name or a close approximation for commercial gain from the goodwill and fame associated with the Complainant's mark indicates that the Respondent is deliberately trying to free ride on the Complainant's mark." - See WIPO Case Info Edge (India) Limited v. Abs, Abs IT Solution, D2014-1688.

In this case, it appears that the Respondent intended to create a false impression that the disputed domain name is associated with the Complainants, by 1) registering the disputed domain name that is confusingly similar to the Complainants' trademark, and 2) resolving the disputed domain name to a website that had the same or similar scope of business and services as those of some of the Complainants businesses/services, in order to attract the Internet users who intended to visit the Complainants' website or seek its services. When such users were visiting the Respondent's websites due to the false impression mentioned above, whether they had realized that there was no association between the Respondent and the Complainants or not, they may view, or even purchase, the services displayed thereon which could result in profit generation by the Respondent and/or the operator of the website located as the address of disputed domain name. Thus, such use of the disputed domain name by the Respondent could not only constitute a free ride of the Complainants' trademark, but also be suspicious of infringing the Complainants' trademark rights. Accordingly, it is reasonable for the Panel to infer that the Respondent had used the disputed domain name in bad faith.

It is worth noting that the disputed domain name is currently not resolving to any website. As it is expressed in previous decision, the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept. See: Telstra Corporation Limited v. International Electronic Communications Inc., WIPO Case No.: D2000-0003. Thus, given the circumstances in this dispute mentioned above, it is still reasonable for the Panel to infer that the Respondent has registered and used the disputed domain name in bad faith.

In conclusion, the Panelist finds that the Complainants have satisfied Paragraph 4(a)(iii) of the Policy.

6. Decision

Pursuant to Paragraph 4(a) of the Policy and Article 15 of the Rules, the Panelist orders that the disputed domain name < swirelimited.site > be transferred to the Complainant, SWIRE PACIFIC LTD.

Matthew Murphy

Matthew Murphy
Panelist

Dated: 5 June, 2023