



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE

— A charitable institution limited by guarantee registered in Hong Kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1000318
Complainants:	(1) Convoy (Trademarks) Limited (2) Convoy Financial Services Limited
Respondent:	Rainforest Consulting

1. The Parties and Contested Domain Name

The Complainants are (1) Convoy (Trademarks) Limited, a company incorporated in the British Virgin Islands, and (2) Convoy Financial Services Limited, a company incorporated in Hong Kong (together, “the Complainants”), represented by Woo, Kwan, Lee & Lo, Solicitors, Hong Kong.

The Respondent is Rainforest Consulting of Orlinda, Tennessee, USA, represented by Dr. John Berryhill, attorney.

The contested domain name is <convoy.com>, registered by Respondent with Moniker Online Services Inc., of 20 SW 27th Avenue, Suite 201, Pompano Beach, Florida, USA.

2. Procedural History

The Complaint was filed with the Hong Kong office of the Asian Domain Name Dispute Resolution Center (the “Center”) on October 27, 2010. On November 2, 2010, the Center transmitted by email to Moniker Online Services Inc. a request for registrar verification in connection with the domain name at issue. On November 3, 2010, Moniker Online Services Inc. transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules of Procedure under the Policy (the “Rules”), and the Center’s Supplemental Rules.

In accordance with the Rules, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 8, 2010. In accordance with the Rules, the due date for Response was November 28, 2010. A Response was submitted on November 29, 2010 which conformed with the Rules.

The Center appointed William Law, the Hon. Neil Brown QC and Debrett G. Lyons (chair) as panelists in this matter on December 17, 2010. The Panel finds that it was properly constituted and has acted impartially in reaching its conclusion.

3. Factual background

A. For Complainants

1. The Complainants are part of a company group engaged primarily in the provision of financial advice and other financial services.
2. The Complainants hold or have held trademark registrations for CONVOY which, it is alleged, has been used in relation to those services since 1995.
3. The Complainants have not licensed or otherwise permitted the Respondent to use the trademark or to register or use any domain name incorporating the trademark.
4. The Complainants petition the Panel to order transfer of the contested domain name from the Respondent to one or other of the Complainants.

B. For Respondent

1. The Respondent registered the contested domain name on October 31, 2000.
2. A portal website corresponding with the domain name carries links to numerous businesses and services.

4. Parties' Contentions

A. Complainants

The Complainants:

- (a) assert rights in the trademark CONVOY and state that the contested domain name is identical or confusingly similar to the trademark.
- (b) allege that the Respondent has no rights or legitimate interests in the contested domain name.
- (c) allege that the Respondent registered and used the contested domain name in bad faith.

B. Respondent

The Respondent denied the Complainants' contentions on the grounds that:

- (a) the Complainants do not have a trade or service mark that they can rely on that pre-dates the registration of the domain name;
- (b) the domain name consists of a common English word that gives rise to a right or legitimate interest; and
- (c) there is no evidence that the domain name was registered or used in bad faith, particularly as it was registered several years before the trade mark relied on by the Complainants.

5. Findings

Paragraph 4(a) of the Policy states that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name must be identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

A) Identical / Confusingly Similar

For reason given under 5(C), the Panel is not required to make any findings (see, for example, *Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (Nat. Arb. Forum Sept. 20, 2002) finding that because the complainant must prove all three elements under the Policy, the complainant's failure to prove one of the elements makes further inquiry into the remaining element unnecessary); see also *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (Nat. Arb. Forum Dec. 28, 2006)).

B) Rights and Legitimate Interests

For reason given under 5(C), the Panel is not required to make any findings.

C) Bad Faith

Paragraph 4(a) of the Policy requires both registration and use in bad faith. Nonetheless, paragraph 4(b) sets out particular scenarios which, if shown to apply, shall be evidence of the registration and use of a domain name in bad faith. They are:

- (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 website 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 website or location or of a product or service on your website or location.

The Complainants do not provide a convincing case for any of those sets of circumstances. There is no proven pattern of abusive conduct so as to engage paragraph 4(b)(ii) and the parties could not sensibly be regarded as competitors for the purpose of paragraph 4(b)(iii).

In broad terms, paragraphs 4(b)(i) and (iv) require a respondent to have a complainant's trademark or business in mind and then to have certain intentions. For reasons to which the Panel now turns, that state of mind has not been shown by the facts in this case.

So far as paragraph 4(a)(i) of the Policy is concerned, trademark rights can be established either by proof of registration or reputation. Had it been necessary for the Panel to formally analyze paragraph 4(a)(i), it might have found trademark rights in CONVOY dating from 2004 by virtue of Hong Kong Trademark Registration No. 300064458. The consensus of opinion of former panelists applying the Policy is that the relative timing of those trademark rights when compared with the date of establishment of a respondent's rights is irrelevant for the purposes of paragraph 4(a)(i). On the other hand, that timing might be very relevant to the issue of bad faith.

In this case, the Respondent registered the contested domain name in October 2000, well before the rights created by trademark registration. It would for that reason alone be difficult to ascribe bad faith intentions to the Respondent at the time of registration of the domain name.

Nevertheless, the Complainants allege continuous use of the CONVOY trademark since 1995 and, with the right evidence, it might have shown common law rights in the trademark by October 2000 such that a rebuttable inference could have been drawn that the Respondent knew the Complainants or the trademark at the time of registration of the contested domain name.

The Complaint carries no evidence of that kind. There is nothing on record which could allow this Panel to conclude there was a pre-existing reputation in the trademark before October 2000 and nothing to encourage this Panel to find that the Respondent in any way targeted the Complainants' trademark.

The Complainants submit some evidence showing company registration records which pre-date October 2000 but since "convoy" is an ordinary word in English, without showing extensive use and other common law rights in the word, it would be difficult to satisfy paragraph 4(a)(iii).

The Panel does not find that the Respondent registered the contested domain name in bad faith and so finds that the Complainant has not satisfied paragraph 4(a)(iii) of the Policy.

6. Decision

Having failed to establish at least one of the elements required under the Policy, the Panel decides that relief shall be **DENIED**.

Debrett G. Lyons (chair)

William Law

The Hon. Neil Brown QC

Panelists

Dated: 23 December 2010