

Online Infringement & Protection of Domain Names

Dr. Lewis Luk, JP
Senior Associate
P. C. Woo & Co



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

Dr. Lewis Luk, JP, Solicitor

- ◉ Founding President, Hong Kong Brands Protection Alliance Ltd.
- ◉ President, Hong Kong Institute of Patent Attorneys Ltd.
- ◉ Panelist, Domain Name Dispute Resolution, HK International Arbitration Centre
- ◉ Industrial Fellow, University of Warwick
- ◉ Adjunct Professor, The Hong Kong Polytechnic University
- ◉ Companion, Hong Kong Institution of Engineers



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Outline of today's talk

Part 1 - Online Infringement

1. Types of Online Infringement and the Law
2. Case study 1 - Infringement in Social Networking Website
3. Case study 2 - infringement in Online Shopping Platform

Part 2 - Domain Names

1. Categories of Domain Names
2. Registration of Domain Names
3. Protection of Domain Names
4. Case Study - dispute resolution of Mainland domain



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Part 1

I. Types of Online Infringement & The Governing Law



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

i. Trade Mark TM Infringement

⊙ Governing law: Section 18 Trade Marks Ordinance

⊙ Elements:

⊙ *If one uses in the course of trade or business a sign which is:-*

	Trade Marks	Goods/ Services Registered
1.	Identical	Identical
2.	Identical	Similar
3.	Similar	Identical/Similar
4.	Identical/Similar	NOT identical/Similar

⊙ *The use of it is likely to cause confusion on the part of the public*



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

ii. Copyright Infringement

◎ Governing law: Sections 23-29 (primary) & Sections 30-34 (secondary) Copyright Ordinance

◎ Elements:

i. Primary infringement

- e.g. issuing/ making available copies of copyrighted works to the public

ii. Secondary infringement

- e.g. importing/ exporting/ possessing/ distributing/ selling/ offering to sell infringing copies

iii. Affect the copyright owner prejudicially



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

iii. Registered Design Infringement

- ◎ Governing law: Section 31 Registered Designs Ordinance
- ◎ Elements:
 - i. Without the consent of the registered owner
 - ii. To make or import into HK for sale or use or to sell, hire or offer or expose for sale in HK

Notes: includes any article and/or a kit (配套元件)



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

iv. Passing off

◉ Governing law: common law

◉ 5 Characteristics

- 1) A misrepresentation;
- 2) Made by a trader in the course of his/her trade;
- 3) To the trader's prospective customers or the ultimate consumers of goods or services supplied by the trader;
- 4) That is calculated to injure the business or goodwill of another trader (reasonably foreseeable)
- 5) Causes actual damage to a business or goodwill of the trader by whom the action is brought or will probably do so.



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979]

v. Trade Descriptions Offences

- ◉ Governing law: Section 12(1) Trade Descriptions Ordinance
- ◉ Elements:
 - ◉ Importing/ exporting any goods to which a forged trade mark is applied
 - ◉ What is a forged trade mark? [see Section 9(3)(a)]
 - a mark made without consent of TM owner that is calculated to deceive
 - falsify genuine TM by alteration/ addition/ effacement



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

v. Trade Descriptions Offences

- Recent trend of selling infringing products online via websites outside HK e.g. Taobao, Tmall...
- Once the goods are couriered i.e. imported into HK, Customs can take actions pursuant to Section 12 Trade Descriptions Ordinance
- Unless the person importing the goods can prove:
 1. he did not know/ had no reason to suspect/ could not with reasonable diligence found out a forged trade mark has been applied
 2. the goods are not intended for trade or business



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Part 1

II. Case Study 1 - Infringement in Social Networking Website



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

II. Case Study 1 - Scenario

- Sell and promote personal care and beauty products covered by a registered TM on Facebook page
- Pictures of the products bearing the registered TM are displayed on Facebook page
- Selling parallel imports not counterfeits
 - i.e. lawfully made outside HK but imported into HK without express consent of owner
- Disclaimer: We are not an authorized dealer in HK for the brand but merely imported the products directly from the US!!



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

II. Case Study 1 - Consequences

- ◉ Despite the disclaimer, TM owner issued a demand letter for trade mark infringement
- ◉ Online shop owner had to:
 - (i) remove the mark shown on the parallel imports from the Facebook page
 - (ii) undertake to cease using the mark



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

II. Case Study 1 - Implications

- Online sale of parallel imports, even not being counterfeits, can be captured by:
- Laws against trade mark infringement
- Laws against copyright infringement unless
 - (i) copyright owner has not appointed any exclusive licensee to make the goods in HK nor in the place where the parallel imports are made; or
 - (ii) copyright owner appointed the same exclusive licensee to make the goods in HK and in the place where the parallel imports are actually made



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Part 1

III. Case Study 2 - Infringement in Online Shopping Platform



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

III. Case Study 2 - Scenario

- ◉ Offer on an online shopping platform a wide range of electronic products including but not limited to a brand specializing in acoustic equipment
- ◉ Transactions are not confined to HK
- ◉ Online shop did not portray itself as an authorized dealer of the brand
- ◉ Displayed on the online shop website:
 - (i) Photographic images of the branded acoustic products
 - (ii) Artistic works of the branded device
 - (iii) Literary works e.g. overview/ specifications of the branded products prepared by the brand



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

III. Case Study 2 - Consequences

- ◉ Acoustic brand issued demand letter to online shop, alleging copyright infringement + trade mark infringement + passing off
- ◉ On the ground that absence of professional services after purchase, e.g. repair and replacement with genuine parts, tarnish the image of the brand and amount to passing off
- ◉ Online shop had to:
 - (i) remove from its website alleged copyrighted materials and trade mark
 - (ii) undertake to cease using the above

III. Case Study 2 - Implications

- ◉ If an online shop is not an authorized dealer/ exclusive licensee of a brand
- ◉ Even the branded products sold are not counterfeits
- ◉ Display of images and reproduction of descriptions of branded products can potentially amount to Copyright and Trade Mark Infringement
- ◉ Online sale outside HK can be captured as well
- ◉ Copyright is universal, unlike TM, not subject to territoriality



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Part 2

I. Categories of Domain Names



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

Categories of Domain Names

- ◎ “.香港 & .hk” → for local and overseas individuals or entities
- ◎ “.公司.香港 & .com.hk” → for commercial entities registered in HKSAR
- ◎ “.組織.香港 & .org.hk” → for registered or approved not-for-profit organizations in HKSARG
- ◎ “.教育.香港 & .edu.hk” → for registered schools, tertiary institutions and other approved education institutions in HK
- ◎ “.網絡.香港 & .net.hk” → for entities managing network infrastructure, machines and services with a license from the Office of Telecommunications Authority of the HKSARG
- ◎ “.政府.香港 & .gov.hk” → for bureau and departments of HKSARG
- ◎ “.個人.香港 & .idv.hk” → for residents of HKSAR

P. C. WOO & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Part 2

II. Registration of Domain Names



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

Registration of Domain Names

- ◉ Can register a domain name at Hong Kong Domain Name Registration Company Limited
- ◉ Can enquire information of registration record of domain names registered by Hong Kong Internet Registration Corporation Limited via WHOIS



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Part 2

III. Protection of Domain Names



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

i. Need for Protection of Domain Names

- A misleading domain name can free-ride on your goodwill and threaten the distinctiveness of your trade mark
- E.g. “www.hklawsoc.org” was registered in 2002 by a registrant, the domain name would redirect the users to a pornographic website
- Given its striking similarity with the marks of Law Society of Hong Kong, there was a risk that the reputation of Law Society might be denigrated or subject to public ridicule



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

ii. How to protect a domain name?

- Can dispute a domain name by way of arbitration proceedings?
- Hong Kong International Arbitration Centre (HKIAC) is currently the only dispute resolution service provider for domain names ended with “.香港 & .hk”
- Arbitration is governed by Domain Name Dispute Resolution Policy, Rules of Procedure, Supplemental Rules of the Provider administering the proceedings and the Arbitration Ordinance



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

iii. Basic Rules used in Dispute Resolution

- ⊙ Complainant must establish the following 3 criteria:
 1. Registrant's domain name is identical or confusingly similar to a trade or service mark in which the Complainant has rights
 2. Registrant has no rights or legitimate interests in respect of the subject domain name
 3. Registrant's domain name has been registered and is being used in bad faith



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

iv. What amounts to “bad faith”?

- ◉ When the domain name is registered and used by the registrant primarily for the purpose of:
 1. Selling or transferring the domain name to the Complainant who is the TM owner, or to a competitor of that Complainant, for valuable consideration in excess of out-of-pocket costs for registration; or
 2. Preventing TM owner from reflecting the mark in a corresponding domain name; or
 3. Disrupting the business of a competitor ; or
 4. Creating a likelihood of confusion with the Complainant’s mark as regards the source, sponsorship, affiliation, or endorsement of its web site, so as to attract Internet users to its web site or other on-line location for commercial gain



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Part 2

IV. Case Study - Dispute Resolution of a Mainland Domain Name



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

i. Principles

- ◉ Disputes over Mainland domains can be submitted for arbitration to dispute resolution service provider e.g. Asian Domain Name Dispute Resolution Centre (“ADNDRC”)
- ◉ Guiding principles are embedded in the Internet Corporation for Assigned Names and Numbers (“ICANN”) Uniform Domain Name Dispute Resolution Policy (the “Policy”)
- ◉ Contains the same 3 criteria as its HK counterpart



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

ii. Scenario

- ◉ Guinness World Records Limited has registered the TM “Guinness” (“吉尼斯”) and “Guinness World Records” (“吉尼斯世界紀錄”) in China in 1990s
- ◉ A man with no association or authorization from Guinness registered a domain name “吉尼斯紀錄.net” in 2009 in Xiamen, China
- ◉ Guinness disputed such a registration and commenced arbitration proceedings at ADNDRC



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

iii. Ruling

- ADNDRC examined the case in accordance with the 3 criteria laid down in the Policy
- **Criteria 1: Domain name at issue is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights**
- “Guinness” (“吉尼斯”) and “Guinness World Records” (“吉尼斯世界紀錄”) are already highly reputable TM in China
- Identifiable part of the disputed domain name “吉尼斯紀錄”, is very similar to “吉尼斯” and “吉尼斯世界紀錄” where confusions may arise



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

iii. Ruling

- Criteria 2: domain name holder has no rights or legitimate interests in respect of the domain name
- No legitimate rights or interests enjoyed by the disputed domain name holder can be discovered after making reasonable and diligent inquiries
- Guinness proved that the disputed domain name holder had not registered any TM in China which correspond with the disputed domain name
- He should enjoy no legitimate interests in “吉尼斯紀錄.net”



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

iii. Ruling

- ◉ Criteria 3: domain name has been registered and is being used in bad faith
- ◉ Presumption of bad faith if domain name holder proceeded to register domain name after knowing that Complainant possesses TM similar to such domain name
- ◉ “Guinness” (“吉尼斯”), “Guinness World Records” (“吉尼斯世界紀錄”) are well-known TM that constantly appear in news articles and search engines’ results
- ◉ Disputed domain name holder should have knowledge of those TM registered by Guinness but still proceeded to register “吉尼斯紀錄.net” with no evidence of a genuine intention to use such domains
- ◉ All these point towards bad faith



P. C. Woo & Co.

胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

iv. Outcome

- ⦿ ADNDRC considered that Guinness has satisfied the 3 criteria laid down in the Policy
- ⦿ Ordered the disputed domain name “吉尼斯紀錄.net” to be transferred to Guinness



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

In an MOJ approved Association with Zhonglun W&D Law Firm
與北京中倫文德律師事務所聯營

Questions and Answers Session



P. C. Woo & Co.
胡百全律師事務所

SOLICITORS & NOTARIES, AGENTS FOR TRADEMARKS & PATENTS

P. C. Woo & Co.

Room 1505 Metroplaza Tower 2

223 Hong Fong Road,

Kwai Chung, New Territories

Tel: 2429 6326

Fax: 2422 0732

Email: ltl@pcwoo.com.hk

Web site: www.pcwoo.com