

Domains & Domain Names

In 10 jurisdictions worldwide

Contributing editor
Flip Petillion



2015

GETTING THE
DEAL THROUGH 

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Domains & Domain Names 2015

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Registration and use of domain names at ccTLD registry

1 Which entity is responsible for registration of domain names in the country code top-level domain (ccTLD)?

The Hong Kong Internet Registration Corporation Limited (HKIRC) is the registry responsible for the administration of the registration of .hk and .香港 ccTLDs (.hk ccTLDs). The HKIRC is a not-for-profit and non-statutory corporation designated by the Hong Kong Special Administrative Region (HKSAR) government to administer .hk ccTLDs.

The HKIRC has a list of accredited registrars that provide various registrar services including registration, renewal, transfer and modification of .hk ccTLDs. One of the main accredited registrars is the Hong Kong Domain Name Registration Company Limited (HKDNR), a wholly-owned subsidiary of the HKIRC.

2 How are domain names registered?

.hk ccTLDs can be registered through any accredited registrar of the HKIRC. The administrative procedures for registration vary among registrars. Registration of .hk ccTLDs through the HKDNR can be completed online.

Both registrars and registrants have to comply with the Registration Policies, Procedures and Guidelines of the HKIRC (the Registration Policies). Mandatory terms and conditions prescribed by the Registration Policies must be included in any registrant agreement entered into between a registrant and a registrar (the Registration Agreement). A registrant has to agree to be bound by the Registration Agreement in respect of any .hk ccTLD registration.

3 For how long is registration effective?

A registrant can typically choose a registration period of between one and five years.

4 What is the cost of registration?

The cost of registration varies according to the registrar and the registration period of the domain name. The HKDNR's fee schedule for registering one .hk ccTLD (the fee covers the registration of one .hk ccTLD and one .香港 ccTLD as a bundle) is as follows:

- for a one-year contract – HK\$200;
- for a two-year contract – HK\$400;
- for a three-year contract – HK\$500; and
- for a five-year contract – HK\$800.

5 Are registered domain names transferable? If so, how? Can the use of a domain name be licensed?

Yes, .hk ccTLDs are transferable and their use can be licensed. The procedures and conditions for the transfer as set out in the Registration Policies provide that the transferor and the transferee must mutually consent to the transfer and jointly execute a transfer form and transfer procedure as prescribed by the registrar.

The transferee must:

- comply with the eligibility requirements applicable to the .hk ccTLD that is being transferred;
- be bound by the terms and conditions of the Registration Policies; and
- pay the prescribed fees as set out by the registrar.

The registrar of the transferor or the transferee has to pay any fees that are owing and due to the HKIRC before the application for the transfer; and the domain name registration cannot be subject to a challenge by a third party or to any pending dispute resolution in accordance with the .hk ccTLD Domain Name Dispute Resolution Policies (HKDRPs).

Once the transfer is completed, the transferor's rights and obligations associated with the domain name registration will be transferred to the transferee.

There are no procedural formalities for the use of a domain name to be licensed. Such a licence will be subject to a private commercial agreement between the registrant and the licensee.

6 What are the differences, if any, with registration in the ccTLD as compared with a generic top-level domain (gTLD)?

As compared with the registration of a gTLD, which is mostly open to all, .hk ccTLDs are closed domains. There are eligibility requirements that apply to the registration of most categories of .hk ccTLDs:

- residents of the HKSAR are eligible to register '.idv.hk' and its Chinese equivalent;
- commercial entities registered in the HKSAR are eligible to register '.com.hk' and its Chinese equivalent – they must provide either a copy of the business registration certificate issued by the Inland Revenue Department of the HKSAR or a copy of the certificate of incorporation or the certificate of registration of an overseas company issued by the company registry of the HKSAR;
- registered or approved not-for-profit organisations in the HKSAR are eligible to register '.org.hk' and its Chinese equivalent;
- entities managing network infrastructure, machines and services with a licence from the Office of the Communications Authority of the government of the HKSAR are eligible to apply for '.net.hk' and its Chinese equivalent;
- bureaux and departments of the HKSAR government are eligible to register '.gov.hk' and its Chinese equivalent; and
- registered schools, tertiary institutions and other approved educational institutions in the HKSAR are eligible to register '.edu.hk' and its Chinese equivalent.

Chinese .hk ccTLDs must consist of at least one Chinese character.

The only exception is '.hk' (and its Chinese equivalent), which is open to all local and overseas individuals and entities.

Pre-litigation actions

7 Are third parties notified of a domain name registration or attempt to register a domain name? If so, how? If not, how can third parties receive notice?

No. Third parties will not be notified by the HKIRC or its accredited registrars of a .hk ccTLD registration or an attempt to register a .hk ccTLD. Third parties who want to keep track of what .hk ccTLDs have been registered must conduct their own searches or engage service providers who offer domain name monitoring services.

8 Is there a need to notify the domain name registrant before launching a complaint or initiating court proceedings?

No, there is no obligation to notify the domain name registrant of any intention to initiate a complaint or proceedings against it, before the complaint

is actually filed pursuant to the HKDRP proceedings or prior to initiating court proceedings.

Transfer or cancellation

9 What is the typical format for a cancellation or transfer action in court litigation and through ADR?

Cancellation or transfer of .hk ccTLDs can be achieved by arbitration proceedings under the HKDRPs (modelled on the ICANN Uniform Domain Name Dispute Resolution Policy (UDRP)) or by civil litigation in the HKSAR courts. In practice, arbitration proceedings under the HKDRPs is the more popular means of achieving cancellation or transfer of .hk ccTLDs.

An overview of the arbitration proceedings under the HKDRP and of litigation in the HKSAR courts is set out below.

Arbitration proceedings under the HKDRPs

Currently, the Hong Kong International Arbitration Centre (HKIAC) is the only approved HKDRP service provider for .hk ccTLDs. These arbitration proceedings are governed by the HKDRPs as well as the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure and the HKIAC's Supplemental Rules.

All registrants of .hk ccTLDs are required to submit to mandatory arbitration proceedings in the event that a complainant submits a complaint under the HKDRPs to the HKIAC. To succeed, the complainant must establish the following elements:

- the registrant's domain name is identical or confusingly similar to a trademark or service mark in Hong Kong in which the complainant has rights;
- the registrant has no rights or legitimate interests in respect of the domain name;
- the registrant's domain name has been registered and is being used in bad faith; and
- if the domain name is registered by an individual person, the registrant does not meet the registration requirements for that individual category of domain name.

Circumstances showing bad faith include (these examples are not exhaustive and other circumstances may also establish bad faith):

- the registrant has registered or has acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant, or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name;
- the registrant has registered the domain name to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
- the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; and
- by using the domain name, the registrant has intentionally attempted to attract internet users, for commercial gain, to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the registrant's website or location, or of a product or service on the registrant's website or location.

In terms of procedure, after confirming that the complaint complies with the administrative requirements under the HKDRPs and the receipt of the requisite fees, the HKIAC will forward the complaint to the registrant who will be given 15 business days from the date of commencement of the arbitration proceedings to submit a response. Failure to submit a response will entitle the arbitration panel to determine the dispute based upon the complaint and evidence submitted by the complainant. After the prescribed period for the registrant to respond, the HKIAC will appoint one or three (if elected by either party) panellists to the arbitration panel. The arbitration panel is required to deliver its decision within 15 business days of appointment. Unless otherwise agreed by the parties, the language of the arbitration proceedings shall be English for English .hk domain names, and Chinese for Chinese .hk domain names or .香港 domain names, subject always to the authority of the arbitration panel to determine otherwise.

Generally speaking, the arbitration panel has power to extend time limits and determine the admissibility, relevance, materiality and weight of the evidence presented to it. The arbitration panel may also request, at its sole discretion, further statements or documents from either or both of the parties.

There shall be no in-person hearings (including hearings by teleconference, video conference, and web conference), unless an arbitration panel determines, in its sole discretion and as an exceptional matter, that such a hearing is necessary.

A complaint under the HKDRPs must relate to only one .hk ccTLD. Unlike the UDRP, no consolidation of multiple .hk ccTLDs is possible under the HKDRPs.

Civil litigation in the HKSAR courts

Disputes regarding unauthorised registration and use of a .hk ccTLD can be litigated in Hong Kong on the grounds of trademark infringement or passing off. Typically, depending on how the domain name is actually used (if at all) and the existence of other evidence of infringement, such litigation can be based on the grounds that the registration or use of the domain name has infringed the claimant's registered trademark in Hong Kong or that the registrant has committed an act of passing off by misrepresenting that the domain name (including the underlying website and the goods and services on offer) is somehow connected to the claimant. Such litigation can be commenced in the High Court of the HKSAR. The claimant may seek an order from the court directing the defendant to take steps to transfer or cancel the domain name (or domain names if more than one domain name is found to have been infringed). Generally speaking, civil litigation in the HKSAR courts will involve the following procedures:

- filing of a writ of summons with the statement of claim with the court and service on the defendant;
- the defendant's acknowledgement of receipt of the writ and filing of its intention to defend to the court within 14 days of service of the writ. Failure to do so will entitle the claimant to enter a default judgment against the defendant;
- filing of a defence within 28 days of the expiry of the time limit for acknowledgement of service;
- filing of a reply to the defence within 28 days after service of the defence;
- mutual discovery of documents;
- filing and serving of a timetabling questionnaire by each party within 28 days after the pleadings stage is complete. It should be noted that parties are required to indicate whether they intend to use mediation to resolve their disputes and if not, to explain the reasons why when they file the timetabling questionnaire;
- issuance of a case management summons by the plaintiff for the court to give directions relating to the management of the case within 14 days after receiving the timetabling questionnaire from the other party or within 14 days upon expiry of the period for filing and serving a timetabling questionnaire;
- listing for trial (assuming mediation is not successful or not attempted); and
- a trial hearing.

If the facts of the dispute are straightforward and there is no arguable defence, the claimant may, after a statement of claim has been served on the defendant and the defendant has given notice of an intention to defend the action, apply for a summary judgment.

10 What are the pros and cons of litigation and ADR in domain name disputes? What are the pros and cons of choosing a local forum to litigate a gTLD dispute compared with the ICANN ADR format for the gTLD?

Compared with litigation, the main advantages of arbitration proceedings under the HKDRPs are that the process is relatively quick (the process usually takes about two months from the filing of the complaint to the rendering of the decision provided that there are no interlocutory applications or requests from the parties (eg, requests to file supplemental evidence) and that it is inexpensive (the official fee charged by HKIAC for a single-member panel is HK\$10,000). In addition, the majority of HKDRP proceedings have been decided in the complainant's favour (which is the same as with the UDRP process).

However, a major drawback of HKDRP proceedings is that the remedies available are limited to the transfer or cancellation of the domain

name. No damages or costs will be awarded to a prevailing complainant. The arbitration panel also has no power to make findings of infringement.

In addition, unlike UDRP and most other dispute resolution mechanisms for .ccTLDs, which are administrative in nature and do not bar either party from resorting to litigation if dissatisfied with the UDRP award, HKDRP proceedings are arbitration proceedings. This means that an arbitral decision under the HKDRPs is final and binding for all practical purposes. A losing party under the HKDRPs cannot commence litigation or appeal the arbitration panel's decision to the HKSAR courts – the HKSAR courts will not intervene or overrule an arbitral award, except in very limited and exceptional cases (eg, there were serious irregularities or fraud in the arbitration proceedings).

By contrast, litigation has the advantage of having a wide range of available remedies such as injunctive relief (interim injunction and permanent injunction), award of damages and costs, delivery-up and discovery. Litigation can be a suitable option if the dispute is complex or if the dispute involves a significant number of .hk ccTLDs (multiple domain names cannot be consolidated into one complaint under the HKDRP), or where the domain name is part of a large-scale infringement against which the claimant may prefer a verdict of infringement and substantive remedies to transfer or cancellation of the domain name. The major downside of litigation in the HKSAR is that the process can be very long and expensive (unless the defendant does not file a defence, in which case the claimant can obtain a default judgment, or if the case involves no arguable defence that would allow the claimant to apply for a summary judgment).

11 What avenues of appeal are available?

For court proceedings, a losing party has the right to appeal to the Court of Appeal. Further appeal from the Court of Appeal to the Court of Final Appeal lies as a matter of right where the dispute on appeal amounts to HK\$1 million or more, or if the matter involves an issue of great general or public importance in the opinion of the Court of Appeal or the Court of Final Appeal, as the case may be.

There are no appeal mechanisms for HKDRP arbitration proceedings. The arbitral award is final and binding. A losing party also cannot appeal an arbitration panel's decision to the court unless in exceptional circumstances.

12 Who is entitled to seek a remedy and under what conditions?

The owner of the trademark or the goodwill in the trademark has standing to bring an action for trademark infringement or passing off. An exclusive licensee of the right owner may also bring an action in its own name. A non-exclusive licensee cannot commence litigation in its own name unless the right to initiate court proceedings has been expressly provided for in the licence; the licensee may call on the rights holder to commence proceedings and if the owner refuses to do so, the licensee may commence action by joining the owner as a defendant to the proceedings.

In the case of HKDRP proceedings, the complainant must be able to establish rights in a trademark or service mark in Hong Kong, otherwise the complaint will fail. In most circumstances, a licensee of a trademark is considered to have rights in a trademark under the HKDRP, provided that credible evidence of such licence or authorisation of the owner of the mark is submitted to the arbitration panel.

13 Who may act as defendant in an action to cancel or transfer a gTLD in local courts?

Typically only the registrant will be named as the defendant in a court action seeking transfer or cancellation of domain names. Under normal circumstances, neither the HKIRC nor its accredited registrars would or could be named as co-defendants (under the Registration Policies and the registration agreements, they are supposed to perform a neutral role and do not assume any liabilities). There have been no reported court cases in Hong Kong in which the HKIRC or its registrars have been named as defendants in relation to domain name disputes. A court order mandating the transfer or cancellation of a .hk ccTLD can be enforced by serving the order on the HKIRC or its registrars. However, there may be exceptional circumstances under which the HKIRC or its registrars can be joined as parties to the proceedings (eg, if the registrar has actively participated in some fraudulent activities conducted through the domain name or where it has been put on notice of such fraudulent use but refuses or fails to take action to suspend the domain name).

14 What is the burden of proof to establish infringement and obtain a remedy?

In a civil court action, the onus falls on the claimant to prove liability on the balance of probabilities.

The same burden of proof applies to HKDRP proceedings. The onus to prove the requisite elements falls on the complainant except that for the second element, namely that the registrant has no rights or legitimate interests in the domain name, the onus of proof falls on the registrant once the complainant has established a prima facie case that the registrant has no such rights or legitimate interests. The reason for this is that it is usually difficult or impracticable for the claimant to prove a negative.

15 What remedies are available to a successful party in an infringement action?

With respect to court litigation, common remedies include damages or account of profits, injunctions, delivery-up and discovery.

With respect to HKDRP arbitration proceedings, the remedies available to a complainant are limited to transfer or cancellation of the domain name.

16 Is injunctive relief available, preliminarily or permanently, and in what circumstances and under what conditions?

In court action in the HKSAR, both preliminary (interim) injunctions and permanent injunctions are available.

The principles for the grant of preliminary or interlocutory injunctions are set out in the English leading case of *American Cyanamid Co v Ethicon Ltd* [1975] AC 396. In summary, the following requirements must be satisfied:

- there is a serious question to be tried;
- damages will not be an adequate remedy; and
- if there is doubt as to the adequacy of damages as a remedy, the balance of convenience lies in favour of granting an injunction (ie, the claimant will suffer more than the defendant if the interim injunction is refused).

An order for an interim injunction may be granted unconditionally or on such terms as the court thinks just (eg, on condition that the claimant gives an undertaking to pay damages to the defendant for any loss sustained by reason of the injunction if it subsequently transpires that it ought not to have been granted). As an extra condition, the claimant may be required to fortify the undertaking by giving security.

On the other hand, permanent injunctions are usually sought by and granted to a winning claimant who can establish infringement after determination of the case on the merits.

17 How is monetary relief calculated?

Monetary relief for trademark infringement or passing-off cases typically involves an award of damages. Damages are calculated on a compensatory basis to compensate the loss suffered by the claimant because of the infringement (eg, loss of sales, profits or goodwill). Procedurally, assessment of damages is usually conducted after liability is found.

As an alternative to an award of damages, the claimant may opt for an account of the defendant's profits made out of the infringement.

The court has the power to award interest on claims for debt and damages and on the judgment award.

Under normal circumstances, a winning party is also entitled to recover legal costs from the losing party. Parties may agree on the amount of legal costs to be recovered, failing which the winning party can request the court to assess the amount. For the majority of cases, legal costs are assessed on a party-to-party basis (ie, only costs that were necessary or properly incurred are recoverable). In practice, costs recovered on this basis usually do not represent the full legal costs that the claimant actually spent out of pocket. Legal costs may be assessed on a more generous basis (eg, an indemnity basis) if, for example, the losing party might have engaged in abusive behaviour when conducting the litigation.

For HKDRP proceedings, no monetary relief is available.

18 What criminal remedies exist, if any?

Criminal remedies do not exist in relation to the registration of a .hk ccTLD as such. However, criminal remedies can apply in cases where the domain name is used as part of other criminal activities. For example, if the domain name is directed to a website that sells goods infringing copyright

Update and trends

Some trademark owners who have secured .hk domain names are faced with situations of domain hijacking. Domain hijacking (unlike cybersquatting) occurs where a person gains unauthorised access to a registrant's domain name account and changes the registration particulars of the domain name or arranges the unauthorised transfer of the domain name. Domain hijacking is often carried out by hackers to transfer the ownership of the domain name away from the legitimate registrant to the hijacker, and to redirect visitors of the affected website to fraudulent websites. Domain hijackers may acquire personal information of the actual domain name registrant from public or illegitimate sources, then use the information impersonate the registrant and convince the registrar to modify the underlying domain name server (DNS) records. In January 2015, the HKIRC introduced the '.hk LOCK' service to help registrants take preventive steps to stop domain hijacking. The .hk LOCK service blocks any changes from being made to the DNS records of .hk domains. DNS records can only be unlocked for modification or transfer at the request of authorised persons appointed by the registrant. Each registrant can nominate a maximum of three authorised persons. An authorised person's identity will be verified by HKIRC's staff each time a request for change of a DNS record is made. The HKIRC will also only unlock the DNS records for 15 minutes after the identity of the authorised person has been verified. The HKIRC charges a fee of HK\$2,000 a year for the .hk LOCK service.

or bearing a forged trademark or that are used for fraudulent activities (eg, theft, hacking), then criminal liabilities may ensue.

19 Is there a time frame within which an action must be initiated?

The limitation period for court action based on tort (eg, trademark infringement or passing off) is six years from the date on which the cause of action accrued.

There are no limitation periods applicable to the initiation of HKDRP arbitration proceedings.

20 Can a registrant's rights in a domain name expire because of non-use? Can a registrant be estopped from bringing an infringement action? In what circumstances?

A registrant's rights in a .hk ccTLD will not expire because of non-use. On the other hand, delay or laches in taking court action against the registration or use of a .hk ccTLD is not by itself a bar to the lawsuit, although such factors may serve to indicate a lesser degree of confusion or damage posed by the registration or use of the domain name.

21 What is the typical time frame for an infringement action at first instance and on appeal?

A full-blown, complex litigation can take at least two to three years from filing the lawsuit to the delivery of the first instance judgment. The appeal may take a further year or so. In cases concluded by way of default judgment or summary judgment, the process will be quicker and can take approximately three to six months.

HKDRP arbitration proceedings usually last around two months from the filing of the complaint to the rendering of the decision. The process may be delayed if interlocutory applications are sought.

22 Is a case law overview available on procedural or substantive issues? Does the case law have a precedential value?

HKSAR adopts a common law system. Judicial decisions of superior courts in the HKSAR are binding or have significant precedential value over the lower courts on identical or similar issues. Case law from other jurisdictions of the common law world are also frequently referred to and have important reference value (in particular English case law).

The HKIAC maintains an online database of all decisions made for HKDRP proceedings. This is freely searchable. The HKDRPs do not operate on a strict doctrine of precedent. However, in practice panellists do refer to prior panel decisions (and UDRP decisions) when dealing with similar issues.

23 Can parties choose a panellist in an ADR procedure involving a ccTLD? Can they oppose an appointment?

If a single-member arbitration panel is selected, the HKIAC will appoint the panellist and the parties have no right to choose.

If either the complainant or the respondent elects a three-member arbitration panel, the complainant and the respondent can each provide the names and contact details of three candidates to serve as one of the panellists. The HKIAC shall endeavour to appoint one panellist from the list of candidates provided by each of the complainant and the respondent. The third panellist shall be appointed by the HKIAC from a list of five candidates submitted by the HKIAC to the parties – the HKIAC's selection from among the five being made in a manner and to the extent possible that the preferences of both parties are reasonably balanced. The candidates must be drawn from the list of panellists maintained by the HKIAC.

Where the complainant elects a three-member arbitration panel, the complainant will have to pay all the fees. Where the election for a three-member arbitration panel was made by the respondent, the applicable fees will be shared equally between the parties.

A party cannot oppose an appointment of a panellist but it may challenge its appointment on the ground that there are justifiable doubts as to a panellist's impartiality or independence. The HKIAC, at its sole discretion, shall decide whether such doubts are justified, and if the HKIAC so finds, it shall remove the panellist and appoint a replacement.

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24 What is the typical range of costs associated with an infringement action, including pre-litigation procedures, trial or ADR, and appeal? Can these costs be recovered?

Legal costs for litigation in the HKSAR are very difficult to estimate and depend on many factors (eg, the number of interlocutory applications, the volume of discovery documents involved, the number of witnesses and the choice of advocates). At a minimum, a court action based on trademark infringement or passing off typically costs HK\$400,000 to HK\$800,000 if the case proceeds to full trial. An appeal usually costs at least HK\$100,000 to HK\$300,000. If the case ends up with a default judgment or summary judgment, the typical cost range is HK\$50,000 to HK\$100,000.

The official cost for filing a complaint under HKDRP is HK\$10,000 (one panellist) or HK\$20,000 (for three panellists). Legal representation is an extra cost, although this is not mandatory for HKDRP proceedings. In practice, many parties (especially complainants) would engage lawyers to advise on and handle the proceedings. The costs associated with any court action, including any legal costs, may be recoverable by the successful party by seeking a court order against the unsuccessful party to the proceedings. Such costs awards are ordered by the courts at their discretion, and the amount of costs that can be recovered will be assessed by the court. However, for HKDRP proceedings, the costs for filing a complaint and any associated legal costs are not recoverable under the HKDRP.

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