

HONG KONG INTERNATIONAL ARBITRATION CENTRE

.hk Domain Name Dispute Resolution ARBITRATION PANEL DECISION

Complainant:	The Toronto-Dominion Bank (trading as TD Bank Group)
Respondent:	Telecom Digital Securities Limited
Case Number:	DHK-2100180
Contested Domain Name:	<tdsecurities.com.hk>
Panel Member:	David L. Kreider

1. Parties and Contested Domain Name

The Complainant in this administrative proceeding is The Toronto-Dominion Bank (trading as TD Bank Group), whose address is Toronto-Dominion Centre King Street West and Bay Street, Toronto, Ontario MK5 1A2 Canada.

The Respondent is Telecom Digital Securities Limited, whose address is 16/F., Riley House, 88 Lei Muk Road, Hong Kong.

The domain name at issue (the “**Disputed Domain Name**”) is <tdsecurities.com.hk>, registered by the Respondent with Hong Kong Domain Name Registration Company Limited.

2. Procedural History

On 26 February 2021, the Complainant filed a Complaint with the Hong Kong International Arbitration Centre (“**HKIAC**”) pursuant to the Domain Name Dispute Resolution Policy (“**Policy**”), adopted by the Hong Kong Domain Name Internet Registration Corporation Limited (“**HKIRC**”), effective from 22 February 2011, the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure (“**Rules of Procedure**”), approved by HKIRC effective from 15 July 2020, and the HKIAC Supplemental Rules for HKIRC Domain Name Dispute Resolution Policy (“**HKIAC Supplemental Rules**”), effective from 15 July 2020. The Complainants elected that this case be dealt with by a one-person panel.

On 26 February 2021, the HKIAC transmitted by email to the Registrar, HKIRC, a request for registrar verification in connection with the Disputed Domain Name. On 1 March 2021, the Registrar transmitted by email to the HKIAC its verification response, confirming that the Respondent is listed as the registrant and providing email contact details as dnsadmin@mango.cc.

On 8 March 2021, the HKIAC transmitted the Complaint and evidence to the Respondent, by email addressed to dnsadmin@mango.cc and notified the Respondent of the commencement of the action, requesting that the Respondent submit a Response within 15 business days, and further specifying the due date as being on or before 29 March 2021 (“**Notification**”).

On 30 March 2021, the HKIAC replied to the Complainant, advising that a Response to the Complaint had not been submitted to the HKIAC within the required period of time. Since the Respondent defaulted and did not mention the Panel selection in accordance with the time specified in the Rules, the HKIAC Supplemental Rules, and the Notification, the HKIAC informed the Complainants and Respondent that the HKIAC would appoint a one-person panel to proceed to render the decision.

On 31 March 2021, having received a Declaration of Impartiality and Independence and a Statement of Acceptance, the HKIAC notified the parties that the Panel in this case had been selected, with Mr. David L. Kreider acting as the sole panelist.

Also on 31 March 2021, the Panel received the file from the HKIAC and should render the Decision on or before 26 April 2021, if there are no exceptional circumstances.

3. Factual Background

For the Complainant

The Complainant, The Toronto-Dominion Bank, trading as and known as TD Bank Group, is the second largest bank in Canada by market capitalization and deposits, and the sixth largest bank in North America. The Complainant was formed in 1955 through the merger of the Bank of Toronto and The Dominion Bank, which were founded in 1855 and 1869, respectively. The Complainant was registered in Hong Kong as an Overseas Company under Part XI of the Companies Ordinance on 31 August 1984.

The Complainant established its securities business, commonly known as TD SECURITIES, in 1987, and is today a leader in capital markets and banking. The Complainant operates its TD SECURITIES business through 15 offices employing over 4,500 full time employees in financial centres around the world, including its office located in the Hong Kong Special Administrative Region of China.

The Complainant is the owner of a number of TD SECURITIES and TD trademarks registered in various countries and regions throughout the world including in Hong

Kong covering, *inter alia*, financial services, investment services, brokerage services, banking and insurance services. The Complainant's registered trademarks (the "Marks") have been used by the Complainant since at least as early as 5 July 1969.

For the Respondent

The Respondent, Telecom Digital Securities Limited, failed to submit a Response timely, or at all, and has not appeared in these administrative proceedings.

4. Parties' Contentions

The Complainant

The Complainant submits that the distinctive part of the Disputed Domain Name is "tdsecurities" and is identical to the Complainant's "TD SECURITIES" Mark. Alternatively, the Complainant alleges, the distinctive part of the Disputed Domain Name is "td" and is identical to the Complainant's "TD" Mark.

The Complainant avers that the Respondent conducts business under the name "TD King Securities". No evidence could be found that the Respondent has ever been commonly known as "TD" or "TD Securities". The Complainant's evidence reflects that the Respondent amended its former English language name, Telecom Digital Securities Limited, and adopted the new company name "TD King Securities Limited" on 13 December 2019. A search of the records reflects that the Respondent does not own any trademark registrations for "TD" or "TD Securities" in Hong Kong.

The Complainant has no relationship with the Respondent, and the latter has not been licensed or authorized by the former to use "TD" or "TD Securities", or to register a domain name on the Complainant's behalf. The Complainant submits that the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name within the purview of Paragraph 4(a)(ii) of the Policy.

The Complainant registered its official domain name <tdsecurities.com> in 1997 and began using this domain name as the situs for its official website in 1997. The Respondent registered the Disputed Domain Name ten years later, on 14 July 2007.

The Complaint alleges that available archive records reflect that the Respondent first began using its website in or around December 2019, around the time the Respondent adopted its current company name "TD King Securities Limited". Given the high reputation and recognition that the Complainant's Marks enjoys globally, the Complainant alleges, the Respondent must have been aware of the Complainant's Marks and domain name <tdsecurities.com> when it began using the Disputed Domain Name.

The Complainant observes that users of the public Internet who enter the Disputed Domain Name into their web browsers are redirected to the Respondent's website at the domain name <tdks.cc>, which is a competing website promoting or offering

securities investment or brokerage-related services similar to those offered by the Complainant. Because the Disputed Domain Name is confusingly similar to the Complainant's Marks, the Complainant alleges, the Respondent is capitalizing on confusion created by it and competing for online traffic destined for the Complainant.

The Complainant asserts:

“Accordingly, it is clear that the Respondent is using the [D]isputed [D]omain [N]ame in bad faith as it contains the entirety of the Complainant's TD and TD SECURITIES trademarks and is identical with the Complainant's <tdsecurities.com> domain name save and except for the .hk country code top-level domain, and it is not used by the Respondent but instead automatically redirects online traffic to its website at <tdks.cc>.”

The Respondent

As is noted above, The Respondent, Telecom Digital Securities Limited, failed to submit a Response in these administrative proceedings.

5. Findings

According to Paragraph 4(a) of the Policy, which is applicable hereto, the Complainant has the burden of proving that:

- (i) the Disputed Domain Name is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith; and
- (iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of domain name.

(i). Identical/confusing similarity

Inasmuch as the Disputed Domain Name incorporates the entirety of both the Complainant's registered TD Mark, and the Complainant's registered TD SECURITIES Mark, the Panel has no difficulty finding that the standing requirement under paragraph 4(a)(i) of the Policy is satisfied.

(ii). Rights or Legitimate Interests of Respondent

The Complaint alleges that the Complainant has no relationship with the Respondent, and the latter has not been licensed or authorized by the former to use the TD or TD Securities Marks, or to register a domain name on the Complainant's behalf, and that the Respondent is not commonly known by the names TD or TD SECURITIES.

As the Complaint correctly asserts, once the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interest in the Disputed Domain Name, the burden of coming forward with evidence demonstrating its rights or legitimate interests in respect of the Disputed Domain Name shifts to the Respondent. *See, Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. D2008-1393.

Here, the Respondent, Telecom Digital Securities Limited, failed to submit a Response and has not appeared in these proceedings or refuted the Complainant's *prima facie* case.

Accordingly, the Panel finds that paragraph 4(a)(ii) of the Policy is satisfied.

(iii). Bad faith

The Panel notes that the Disputed Domain Name, which was registered by the Respondent on 14 July 2007, incorporates the entirety of the Complainant's official domain name <tdsecurities.com>, the only change being the addition of the top-level domain ".hk". From the time of registration, the Respondent has apparently been engaged in the securities business under the name "Telecom Digital Securities Limited", the same business as that of the Complainant.

It appears from Complainant's evidence that the Respondent changed its corporate name from "Telecom Digital Securities Limited" to "TD King Securities Limited" on 13 December 2019, and that the Respondent established a competing website at the domain <tdks.cc> around this same time.

The Complainant alleges that users of the public Internet who entered the Disputed Domain Name into their web browsers were "automatically redirected" to the Respondent's competing website at the domain name <tdks.cc>, promoting or offering securities investment or brokerage-related services similar to those offered by the Complainant.

Paragraph 4(a)(iii) of the Policy requires that a complainant prove that a disputed domain name has been registered and is being used in bad faith. Both elements must be established.

Here, the Complainant's evidence reflects that the domain name <tdks.cc> was registered on 29 October 2019. The Complainant candidly acknowledges, "there is no evidence that the Respondent has used the disputed domain name before then", *i.e.*,

during the period from the registration of the Disputed Domain Name on 14 July 2007 through 29 October 2019, when the Respondent registered its <tdks.cc> and later began diverting traffic to its competing website.

The Complainant avers:

“Given the high reputation and recognition that the Complainant enjoys globally, the Respondent must be aware of the high risk of confusion by using the disputed domain name. As explained above, *the obvious inference and conclusion is that the Respondent registered the disputed domain name to create a likelihood of confusion and/or intentionally mislead Internet users, including prospective customers, into believing that it is connected to, endorsed by and/or otherwise associated with the Complainant*, and thereby disrupting the Complainant's business and directing legitimate traffic away from the Complainant.” (Emphasis added).

The Panel agrees. Taking into account the totality of the circumstances, including, *inter alia*, such factors as the reputation and high global standing of the Complainant's brand and Marks; the Respondent's failure to submit a Response or in any way rebut the Complainant's claim for relief; the implausibility of any good faith use to which the Disputed Domain Name might be put, especially in the hands of a competitor in the securities industry, the Panel considers that the “passive holding doctrine” applies in the present case. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-003.

The Panel finds that the Respondent both registered, and is using, the Disputed Domain Name in bad faith to intentionally mislead public Internet users for its own commercial gain and that paragraph 4(a)(iii) of the Policy is satisfied.

(iv). If the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of domain name

Not applicable.

6. Conclusions

It is accordingly ORDERED that the domain name <tdsecurities.com.hk> be TRANSFERRED to the Complainant.



David L. Kreider, C. Arb.
Panelist

Dated: 07 April 2021