

**Administrative Panel Decision**

**IN THE MATTER OF A DOMAIN NAME DISPUTE**

**Between**

**MANCHESTER UNITED LIMITED** (previously known as Manchester United plc)  
**[Complainant]**

**And**

**ASIA BUREAU.COM SDN BHD [Respondent]**

**Case No: KLRCA/DNDR-268-2014**

**1. The Parties**

- 1.1 The Complainant is Manchester United Limited (previously known as Manchester United plc), with an address at Old Trafford, Manchester M16 0RA.
- 1.2 The Respondent is Asia Bureau.com Sdn Bhd, with its address at Unit 621, 6<sup>th</sup> Floor, Block A, Kelana Centre Point, No. 3 Jalan SS7/19, Kelana Jaya 47301 Petaling Jaya.

**2. The Domain Name and Registrar**

- 2.1 The Domain Name in issue is [www.manutd.my](http://www.manutd.my) ("Domain Name"). The Registrar of the Domain Name is the Malaysian Network Information Centre ("MYNIC").

**3. Procedural History**

- 3.1 The Complaint is dated 20 October 2014 and was filed with the Kuala Lumpur Regional Centre for Arbitration ("the Centre") in accordance with the formal requirements of the MYNIC's (.my) Domain Name Dispute Resolution Policy ("MYDRP") ("the Policy"), the Rules of the MYDRP ("the Rules") and the Supplemental Rules of the Kuala Lumpur Regional Centre for Arbitration ("the Supplemental Rules").
- 3.2 The Respondent received the Complaint Notification Instructions from the Centre by an email dated 6 November 2014. On 26 November 2014, the Centre received the Respondent's Response to the Complaint. On 3 December 2014, the Centre received the Complainant's Reply to the Respondent's Response.
- 3.3 In view of the Complainant having designated a single panellist, the Centre invited Mr Khoo Guan Huat on 8 December 2014 to serve as sole panellist in the instant case ("the Panel"). The Panel has submitted a Declaration of Impartiality

and Independence via e-mail on 10 December 2014 and by hand on 12 December 2014 respectively, pursuant to the Rules.

3.4 The Complainant seeks the remedy of having the Domain Name transferred to it.

#### 4. Factual Background

4.1 The Complainant, Manchester United Limited (previously known as Manchester United plc) owns a professional football club from England, known as MANCHESTER UNITED football club (“the Club”).

4.2 Since 1902 and throughout the years, the Club has been known as ‘MANCHESTER UNITED’, and by the shortened versions:

- a) ‘MAN UTD’ (being the abbreviated form of MANCHESTER UNITED);
- b) ‘MAN UNITED’ (being the abbreviated form of MANCHESTER UNITED); and
- c) ‘MUFC’ (being the abbreviated form of MANCHESTER UNITED and the descriptions ‘Football Club’).

4.3 The Complainant uses the shortened versions of ‘MAN UNITED’ and ‘MAN UTD’ interchangeably with its full name ‘MANCHESTER UNITED’ and these shorter versions are known to the trade, industry and public as reference to the Manchester United Football Club.

4.4 Even though the Club is an English football club by origin, the Club has over the course of many years, established a presence in Asia, including Malaysia. The Panel notes from Tab 6 and 7 of the CBD that this includes partnerships with local brands such as Telekom Malaysia Berhad (TM) and AirAsia.

4.5 The Complainant is the registered proprietor of the trade marks “MAN UNITED” and “MAN UTD” in the following classes of goods and services in Malaysia (collectively known as “the MAN UTD marks”).

ITEM NO.	TRADE MARK	TRADE MARK NO.	CLASS
1.	MAN UNITED	96002892	9
2.	MAN UNITED	96002888	16
3.	MAN UTD	96002886	9
4.	MAN UTD	96002889	16

4.6 The Complainant has adduced copies of the Certificates of Registration of the MAN UTD Mark [Tab 16 of the CBD].

- 4.7 The Complainant is also the registered proprietor of similar trade marks in various classes in other countries, including the United Kingdom, European Community, Singapore and Hong Kong.
- 4.8 The Complainant's main website which can be assessed at the URL [www.manutd.com](http://www.manutd.com), which was first registered on 12 September 1996. The Complainant is also the domain name registrant of its brand name Manchester United, including its variations, [www.manutd.asia](http://www.manutd.asia), [www.manchesterunited.com.cn](http://www.manchesterunited.com.cn), [www.manunited.eu](http://www.manunited.eu), [www.mufoundation.co.uk](http://www.mufoundation.co.uk) and [www.manutd.co.uk](http://www.manutd.co.uk). These websites are accessible to the Complainant's fans worldwide, including Malaysia.
- 4.9 The Complainant has also used the MAN UTD marks either as a trademark and/or a domain name, and has created significant goodwill and reputation in respect of its website.
- 4.10 Merchandise bearing the MAN UTD marks have been and continue to be sold. Between 2005 and 2009, the Complainant sold between 1.2 and 1.5 million replica shirts per season globally.
- 4.11 Promotional eyewear items bearing the MAN UTD marks were sold at the MAPO fair (Optical Fair) at Kuala Lumpur Convention Centre from 23 till 24 April 2011.
- 4.12 The Respondent is a private limited company incorporated under the laws of Malaysia and having its registered address in Petaling Jaya, Selangor. The Respondent registered the disputed Domain Name [www.manutd.my](http://www.manutd.my) with MYNIC on 18 February 2008 [as per MYNIC Whois Service report at Tab 25 of the Reply]. The domain name [www.manutd.my](http://www.manutd.my) leads to a blank page [Tab 23 of the Reply].

## **5. The Parties' Contentions**

### **A. The Complainant**

- 5.1 The Complainant relies on the above stated facts and contends that the disputed Domain Name is confusingly similar and/or deceptively similar to the Complainant's registered MAN UTD marks.
- 5.2 The Complainant contends that in view of the large number of domain names owned by the Complainant and the easy accessibility by Malaysian visitors towards these domain names, the average public in Malaysia would believe that any domain name with the format [www.manutd...](http://www.manutd...) is connected to the Complainant. The disputed Domain Name is no exception.
- 5.3 The Complainant further contends that it has fulfilled the requisite elements of para 5.2 of the Policy in that the Domain Name is identical and or confusingly

similar to the MAN UTD marks and the Respondent has registered and/or used the Domain Name in bad faith.

5.4 The Respondent's Response was brief. In summary, the Respondent states that:

- a) The Domain Name is to represent the names of the Respondent's family geese pets, namely "Manut" and "Degil" that are the children's favourite which act as their guards warding off trespassers and that the children have formed a close bond with the pets. It is also meant as a private and personal blog for the children to post write ups and pictures of their pets.
- b) The Domain Name was made available to register in 2008 after the dot.my priority registration in 2007.
- c) The word manutd squares out the names of the pets in abbreviation, Manut and Degil.
- d) The Respondent is domiciled in Malaysia and therefore was purchased by the Respondent in good faith and for valuable consideration vide an open tender.
- e) The Domain Name has no reference in any way whatsoever to the Complainant's marks (the MAN UTD marks) hence there is no infringement of the Complainant's marks. All the marks attached by the Complainant purportedly registered are only related to goods.
- f) The Complainant's claim to exclusive ownership and rights to the words MANCHESTER UNITED and/or the disseminated words or alphabet is unfair and too wide. The words MANCHESTER UNITED is only known amongst ardent football fans and has no relevance to anyone else.
- g) The Complainant has figuratively stated that only about "25% of the population of Malaysia support Manchester United" is far from claiming presence and popularity in Malaysia.
- h) The Complainant's monopolistic claim is in contravention of fair commercial freedom and laissez faire principles.
- i) The Complainant's commercial activities in Malaysia is not prejudiced nor affected in any way by the Respondent's ownership of the Domain Name.

5.5 The Complainant, in its Reply to the Respondent's Response, states that:

- a) The Respondent failed to establish that its use of the Domain Name was not in bad faith in that it had not shown evidence of its rights and legitimate interests.

- b) The Respondent had not and still has not used or made preparations to use the Domain Name in relation to a genuine offering of goods or services. As at 1 December 2014, the Domain Name remains inaccessible.
- c) There is no nexus between the nature of the Respondent's professed business and its derivation claim such that it could be said that the Respondent is commonly known by the Domain Name even though no trade mark or service mark in the same had been acquired.
- d) There were no activities on the Domain Name that could be linked to its claim that the website was meant to be a 'private and personal blog for the children to post write ups and pictures of their pets' and a search on the MYNIC Whois database revealed that as of the date of the Reply, [www.manutdegil.my](http://www.manutdegil.my) is available.

**6. 1<sup>st</sup> Requirement – Whether the domain name is identical to or confusingly similar to a trademark or service mark in which the Complainant has rights**

- 6.1 To satisfy this requirement, two elements need to be present. The Complainant must show that it has rights to a trademark or service mark, and that the Domain Name is identical or confusingly similar to this trademark or service mark.
- 6.2 The Panel is satisfied that the Complainant has adduced sufficient evidence to show that it has rights in the MAN UTD marks. The Complainant has provided evidence of trade mark registration in Malaysia and given that MAN UTD is a well-known trade mark, the registration of the MAN UTD marks in the classes of goods and services in paragraph 4.5 above further reaffirm the Complainant's undisputed rights in the trade marks.
- 6.3 In any event, MAN UTD as a well-known trademark has not been challenged by the Respondent. Premised on the statutory rights of the Complainant to the MAN UTD marks, the Complainant has rights to the trademark MAN UTD.
- 6.4 The Panel also finds that the Domain Name [www.manutd.my](http://www.manutd.my) incorporates the Complainant's MAN UTD marks. The additional indicator .com or .my is of no significance. There is a general consensus that the relevant test is whether the domain name incorporates the dominant and distinguishing part of the complainant's mark (*Volkswagen Group Singapore Pte. Ltd and Webmotion Design*, Case No: rca/dndr/2003/01; *Yahoo! Inc v. Yahoo Computer Services*, Case No: DPH2001-0001; *Hugo Boss AG and Eppies Internet*, Case No: rca/dndr/2004/02).
- 6.5 Accordingly, the Panel has no difficulty in finding that the Domain Name [www.manutd.my](http://www.manutd.my) is identical or confusingly similar to the MAN UTD marks.

**7. 2<sup>nd</sup> Requirement – That the Respondent has no rights or legitimate interests in respect of the domain name**

7.1 In order to demonstrate that the Respondent does have the requisite rights or legitimate interests that would merit its entitlement to the Domain Name, the Respondent must prove the following in accordance to Paragraph 7.2 of the Policy:

- a) Before the date of communication of the Complaint, it has used or made preparation to use the Domain Name or a name corresponding to the Domain Name in relation to a genuine offering of goods or services; or
- b) It is commonly known by the Domain Name even though it has acquired no trade mark or service mark rights in the same; or
- c) It is using the Domain Name for legitimate, non-commercial and/or fair purposes and has no intention of using the same for profits or to deceive the public.

7.2 The Complainant contends that the Respondent has not used or made preparations to use the Domain Name in relation to a genuine offering of goods or services.

7.3 The Complainant further contends that based on the search on the Companies Commission of Malaysia, the Respondent's professed business is unrelated to the Respondent's derivation claim that 'manutd' is a combination of the names given to the 2 geese.

7.4 Absent any justifiable reasons from the Respondent, there is no plausible reason which the Respondent could possibly claim that his usage of the Domain Name be anything other than trying to take advantage of the Complainant's goodwill and reputation.

7.5 In the present proceedings, the Panel does not find any argument put forth by the Respondent convincing. The act of registering a domain name does not give the registrant a right or legitimate interest in the domain name (*Hamlet Group. Inc v James Lansford*, WIPO Case no. D2000-0073; *Robert Chiappetta dbs Discount Hydrophonics v. C.J. Morales*, WIPO Case no. D2002-1103).

**8. 3<sup>rd</sup> Requirement – Whether the Respondent's domain name has been registered or used in bad faith**

8.1 Whether the Respondent has used or registered the disputed Domain Name in bad faith is a matter of fact to be determined on or inferred from the evidence, surrounding circumstances and conduct of the Respondent.

- 8.2 Given the circumstances, the Panel finds it difficult to agree with the Respondent that the Respondent could not possibly misappropriate and usurp the Complainant's goodwill, reputation and commercial advantage in the use of the name MAN UTD just because it is alleged that the Respondent did not use or was not using the domain name commercially.
- 8.3 Inactive holding of domain names can amount to bad faith use (*Volkswagen Group Singapore Pte. Ltd and Webmotion Design*, Case No: rca/dndr/2003/01).
- 8.4 The Panel is persuaded to follow the decision in *Google Inc. v Googles Entertainment*, Case No SDRP-2002-0003(F) that bad faith use is not limited to positive action, but such use could be inferred from a respondent's passive holding of the domain name.
- 8.5 The Panel is therefore of the view that this is a case in which a domain name has been registered in bad faith.

## 9. Order

- 9.1 Based on the foregoing, the Panel orders that the Domain Name [www.manutd.my](http://www.manutd.my) be transferred to the Complainant.

Dated this 23<sup>rd</sup> December 2014



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KHOO GUAN HUAT  
Single-member Panel