Administrative Panel Decision

In the matter of KLRCA/DNDR-278-2014

Between

Transplace Texas, L.P.
[Complainant]

And
Transplace Logistics Sdn Bhd
[Respondent]

Case No. KLRCA/DNDR-278-2014

1. The Parties

The Complainant is Transplace Texas, L.P., a registered limited partnership in the state of Texas and having a registered address at 5800 Granite Parkway, Suite 1000, Plano, Texas 75024, represented by Messrs Shearn Delamore, Kuala Lumpur, Malaysia.

The Respondent is Transplace Logistics Sdn Bhd (Co. No. 863983-X), a company duly incorporated in Malaysia with an address at Plot 23, Jalan Jelawat, 13700 Seberang Jaya, Pulau Pinang, represented by Messrs Vello & Associates, Penang, Malaysia.

2. The Domain Name and the Registrar

The disputed domain name is transplace.com.my and the Registrar is the Malaysian Network Information Centre (MYNIC).

3. Procedural History

The Complainant submitted its Complaint with the Kuala Lumpur Regional Centre for Arbitration ("the Centre") on 2 January 2015 pursuant to MYNIC's (.my) Domain Name Dispute Resolution Policy ("the Policy"), the Rules for MYNIC's (my.) Domain Name Dispute Resolution Policy ("the Rules") and the MYNIC's (my.) Supplemental Rules ("the Supplemental Rules") in respect of the disputed domain name.

The Respondent submitted a Response dated 29 January 2015.

The Complainant submitted a Reply to the Respondent's Response dated 11 February 2015.

An examination of the material confirms that all technical requirements for the initiation of this proceeding have been satisfied. Having verified that the Complaint satisfied the formal requirements, the proceedings formally commenced on 9 January 2015.

The Complainant having elected for a single member Panel, the Centre appointed Wong Jin Nee as the sole panellist in conformity with the Policy and the Rules. The Panellist has submitted a statement of Declaration of Impartiality and Independence as required by the Centre.

4. Factual Background

4.1 The Complainant is Transplace Texas, LP, a registered limited partnership in Texas, formed on 30 July 2001 through the merger of logistic business units from 6 of the US' largest publicly held truckload carriers, namely Covenant Transport, Inc, J.B. Hunt Transport Services, Inc., M.S Carriers, Inc., Swift Transportation Co., Inc, U.S. Xpress Enterprises, Inc and Werner Enterprises, Inc and having its registered address at 5800 Granite Parkway, Suite 1000, Plano, Texas 75024, United States of America.

4.2 The Complainant provides various services including procurement services, purchasing transportation and freight related goods and services for others, transportation logistic services such as arranging the transportation of goods for others, planning and scheduling shipments for users of transportation services and other related services ("Services"). The Complainant considers itself as a non-asset based third-party logistic provider offering manufacturers and retailers the optimal blend of logistics technology and transportation management services.

4.3 The Complainant has registered its domain name, transplace.com in 2001. The Complainant claims that it has since 2001 offered a web-enabled platform that brings together shippers and carriers worldwide to collaborate on their transportation logistics planning and execution in the most effective manner.

4.4 The Complainant further claims that it has used its website as early as 2000 and its website was and is available and accessible all over the world.

4.5 The Complainant claims that it has received numerous recognitions and accolades since as early as 2004 including its recognition by Logistic Management as a Top 10 3 PL by BP Solvay Polyethylene North America

as "Logistics Provider of the Year and by Sysco Food Service as "Transportation Provider of the Year".

4.6 The Complainant claims that the Services are extended across worldwide and it has adduced press release, articles and other documentary evidence to support its fame and notoriety in various parts of the world.

4.7 The Complainant has also adduced random copies of Bill of Lading and Sear Waybill as evidence of use of the mark "TRANSPLACE" in Malaysia for the Services rendered through the Complainant's agent, CDS Global Sdn Bhd. These documents were dated in 2011 and 2012.

4.8 The Complainant further contends that apart from the mark "TRANSPLACE", it also offers the Services by reference to a variation of the mark "TRANSPLACE" including TRANSPLACE (stylised version), TRANSPLACE PAY ON-DEMAND and TRANSPLACE.COM in various countries including Malaysia.

4.9 The Complainant submits that it has registered the mark TRANSPLACE.COM in the European Union (EU) since as early as 19 April 2002 and in Mexico since 6 February 2001. The Complainant also submitted a list of its trade mark registrations (including copies of the registration certificates, with the exception for Mexico) for the mark "TRANSPLACE" and its variations thereof in the United States of America, Canada, the EU and Mexico. The Complainant has filed an application for the mark "TRANSPLACE" in relation to services in Class 35 in Malaysia under Application No. 2012016552 on 28 September 2012 and it appears that the application is still pending due to objections raised (as shown by the MyIPO printout adduced as evidence in TAB 11 of the Complainant's Complaint).

4.10 The Respondent is a company incorporated under the laws of Malaysia with its registered address at 54, Lorong Perusahaan Maju 1, Kawasan Perusahaan Prai 4, Prai, 13600 Pulau Pinang. The Respondent was incorporated on 10 July 2009 and registered the disputed domain name transplace.com.my on 21 July 2009 [as per the Whois extract as shown in Exhibit B of the Complainant's Complaint].

5. The Parties' Contentions

The Complainant

5.1 The Complainant contends that the registration of the disputed domain name should be transferred to the Complainant.

5.2 The Complainant relies on the adduced facts and evidence and contends that it has fulfilled the requisite elements of paragraph 5.2 of the Policy, in particular:

5.2.1 the disputed domain name is identical to and/or confusingly similar with the Complainant's trade marks to which the Complainant has rights; and

5.2.2 the Respondent has registered and used the disputed domain name in bad faith.

5.3 In support of these contentions, the Complainant asserts and maintains various points including the following:

5.3.1 It is evident that the disputed domain name is identical with the Complainant's trade mark "TRANSPLACE". In fact the entire term "TRANSPLACE" has been adopted. The inclusion of suffix "com.my" is immaterial and inconsequential in determining whether a disputed domain name is identical to or confusingly similar with the Complainant's trade marks. Accordingly, the requirement in paragraph 5.2(i) has been satisfied.

5.3.2 The Complainant stressed that the TRANSPLACE mark was first used by the Complainant since at least July 2000. The extent of the Services by reference to the Complainant's TRANSPLACE mark has reached the Asian region including Malaysia both by its delivery services as well as via its web-enabled platform since 2001.

5.3.3 Accordingly, the Respondent should be aware or taken to be aware of the Complainant's rights prior to registering the disputed domain name.

5.3.4 The Complainant further contends that the choice of the word "TRANSPLACE" by the Respondent cannot be incidental, particularly given the global nature of transportation and logistic services in general and reputation attained by the Complainant for the Services worldwide.

5.3.5 The Complainant further claims that a reasonable and prudent businessman seeking to engage in a similar trade and business would conduct checks online to find out if there are other parties who were using or might have used the word "TRANSPLACE" as a domain name or trade mark. With the availability and accessibility of the Complainant's web-enabled platform at the material time, the Respondent should have discovered the Complainant's website, namely transplace.com.

5.3.6 The Complainant further contends that the Respondent's choice of the word "Transplace" is nothing more than an attempt to prevent the Complainant, being the owner of the TRANSPLACE marks from

registering other domain names with the same name. It is a deliberate attempt to misappropriate and usurp the Complainant's goodwill and commercial reputation which the Complainant has enjoyed in Malaysia and continues to enjoy.

5.3.7 The Complainant stressed that its website was already accessible by Malaysians some 8 years ago prior to the registration of the disputed domain name by the Respondent.

5.3.8 The Complainant asserts that its potential customer might be led to assume that the Respondent's website operated under the disputed domain name is a website registered by the Complainant and as such, there is a likelihood of confusion and deception due to the similar nature of the services offered by the Complainant and the Respondent.

The Respondent

5.4 The Respondent argues that the prefix "TRANS" denotes across or beyond and the word "place" refers to a geographical area with a boundary or a portion of space. Both these words can be associated with various meanings and/or definitions when conjoined and as such, it cannot be said to have acquired distinctiveness.

5.5 The Respondent further argues that the two marks as in use by the Complainant and the Respondent respectively (as depicted in paragraph 4.0 of the Respondent's Response, which representations were adduced by the Respondent in support of its arguments) are visibly distinguishable and are not identical. The Respondent has submitted extensive and detailed justifications in distinguishing the two marks in actual use and made onerous efforts to highlight the differences between the two marks in use including the differences in colours of the website of the Respondent from those of the Complainant. The Respondent invites the Panel to view the respective websites of the parties which the Respondent claims to be clearly different. The Respondent further submits that the surrounding conditions mitigate the similarities of the marks.

5.6 The Respondent further argues that the Complainant's goods and services are different from those of the Complainant's and the trade channels, advertisement and targeted classes of prospective purchasers are also different.

5.7 The Respondent vigorously submits that the Complainant has not produced any evidence to demonstrate that there is or there has been any actual confusion or that the Respondent intended to create any confusion amongst the consumers.

5.8 The Respondent avers that it is a legitimate business operator providing trucks and warehouses for storage. This is supported by its existing business and assets comprising 40 trucks and 3 warehouses totalling RM5 million. The Respondent submits that the Complainant's arguments are unsubstantiated and baseless and its registration of the disputed domain name cannot be said to be made on bad faith.

Complainant's Reply

5.9 The Complainant filed a Reply, which it is entitled to do pursuant to Rule 7 of the Rules. In its Reply, the Complainant responded that the Respondent failed to establish that its use of the disputed domain name was not in bad faith nor has it shown evidence of its rights and legitimate interests.

5.10 The Complainant contends that the Respondent has not taken into account that the mark "TRANSPLACE", despite being a normal dictionary word could acquire secondary distinctiveness in respect of the services applied for.

5.11 The Complainant further objects to the premise of the comparison of the marks made by the Respondent on the basis that such manner of comparison is irrelevant, particularly having regard to the colours or representations of the websites.

5.12 The Complainant reiterates that its online platform has existed since at least 2001 and requested the Panel to take cognisance of the modern technology of which knowledge and awareness of a particular mark could be imputed. The Complainant further contends that the fact that its website was accessible at least 8 years prior to the registration of the disputed domain name was not denied by the Respondent. The Complainant reasserts that the disputed domain name has been registered and/or used in bad faith.

6. Discussions and Findings

6.1 Rule 17 of the Rules instructs the Panel to decide the proceeding based on the documents and evidence submitted by the Parties, the Policy and Rules as well as any other rules and principles of law which are applied in Malaysia.

6.2 Paragraph 5 of the Policy provides that the Complainant must establish BOTH of the following elements in the Complaint:

(i) The disputed domain name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights; and

(ii) The Respondent has registered and/or used the disputed domain name in bad faith.

The Panel will deal with each of the requirements of the Policy.

Identical or Confusingly Similar

6.3 The Panel finds that the Complainant has adduced significant and sufficient evidence to demonstrate that it has common law rights in the trade mark "TRANSPLACE" and its variations thereof in Malaysia for the Services. It has adduced evidence to show that it has registered its domain name, transplace.com in 2000 and has used the mark "TRANSPLACE" for the Services on its online platform operated via its website at www.transplace.com since 2001, at least 8 years prior to the registration of the disputed domain name by the Respondent. The Complainant has also registered its mark "TRANSPLACE" and its variations thereof in various countries, since as early as 2000 in the United States, 2001 in Mexico and 2002 in the European Union.

6.4 The Panel finds that the disputed domain name, transplace.com.my is identical to the Complainant's mark "TRANSPLACE". This is so notwithstanding the presence of the suffix ".com.my" which should be disregarded (as it is a technical requirement of registration) when determining if the disputed domain name is identical or confusingly similar to the Complainant's marks.

6.5 While the word "transplace" is not an invented word as such, it is not a dictionary word either. It is a word coined from the words "trans" and "place" to indirectly refer to the services which they are associated with or to hint at, but do not describe the nature or characteristics of the Services. This is one example of a suggestive mark. Other examples of suggestive marks include "Sunkist" for fruit products, "Coppertone" for tanning lotions or "Greyhound" for transportation services. The Respondent expressly concedes that the mark "TRANSPLACE" is suggestive in paragraph 7.0.2 (f) of its Response. Such marks including a "suggestive mark" could certainly acquire a secondary meaning and achieve distinctiveness as a trade mark through extensive use.

6.6 The Panel finds the Respondent's arguments and justifications in comparing the two marks in actual use, the similarity of goods and

services as well as their respective trade channels to be misconceived for the purpose of determining whether the disputed domain name is identical or confusingly similar with the Complainant's mark "TRANSPLACE". There is no necessity for the Panel to take into account the two marks in their respective actual uses, trade channels or fields of activities in determining whether the disputed domain name is identical to or confusingly similar to the Complainant's marks. The Panel merely has to look at the disputed domain name and the Complainant's mark(s) on their own to determine if the essential element of the Complainant's mark has been adopted or incorporated into the disputed domain name. The actual uses of these two marks or the contents of the respective websites would usually be disregarded in the threshold assessment of risk of similarity or confusing similarity under the first element of the Policy, although such contents may be regarded as relevant during the assessment of intent of a registrant to create confusion (*e.g.*, within a relevant market or language group) under subsequent elements (i.e. bad faith).

6.7 The Respondent did not proffer any explanation or justification for choosing and adopting the word "transplace". It merely points out that both the words "trans" and "place" could be associated with many various meaning and definitions.

6.8 Based on the comparison of the disputed domain name with the Complainant's mark "TRANSPLACE", the Panel considers the disputed domain name to be identical with the Complainant's mark "TRANSPLACE".

Rights and Legitimate Interests

6.9 Paragraph 7 of the Policy provides that in order for the Respondent to rebut the allegation that the disputed domain name was registered and has been used in bad faith, the Respondent may prove that it has rights and legitimate interests in the disputed domain name. Paragraph 7.2 of the Policy identified several types of evidence that could be adduced by the Respondent to support its case and they include:

(a) before the date of the communication of the Complaint, the Respondent has used or made preparations to use the disputed domain name in relation to a genuine offering of goods or services; or

(b) the Respondent is commonly known by the disputed domain name; or

(c) the Respondent is using the disputed domain name for legitimate, non-commercial and/or fair purposes and have no intention of using the same for profits or to deceive the public.

6.10 The Respondent contends that it is a legitimate business operator providing trucks and warehouses for storage and has for the benefit of the Panel attached various communications and documentation regarding its business as evidence of an existing business. It further claims that the registration of the disputed domain name cannot be said to be have been made in bad faith when there is an existing business and assets comprising 40 trucks and 3 warehouses totaling RM5 million.

6.11 The Complainant has strenuously argued in its Reply that the Respondent's claims of its asset worth are questionable as there is no substantive proof of the same. Further, it is questionable if these assets are related to the use of the disputed domain name.

6.12 Although Uniform Dispute Resolution Policy (UDRP) decisions are not binding precedents, the Panel has sought some guidance from the WIPO Overview of WIPO Panel Views on Selected UDRP Questions prepared by the WIPO Arbitration and Mediation Center. The Panel acknowledges that proceedings of this nature are usually inadequate to resolve disputed issues of facts in absence of discovery, sworn statements and/or a hearing where witnesses could be cross-examined. Based on such limitations, the Panel will have to decide if the totality of the documents provided would be sufficient to justify the claims and statements made by either party to the proceedings *(Netflowers Pte Ltd (Complainant) -And Chan, Hong Mun T/A Mymall Dot Com Enterprise (Respondent) Case No. rca/dndr/2005/07)*. The general standard of proof under the Policy is "on balance", often expressed as the "balance of probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party would typically need to establish that it is more likely than not that the claimed fact is true.

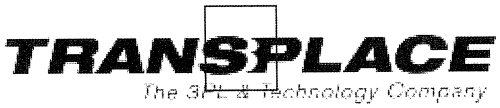
6.13 The Respondent has been rather persistent in inviting the Panel to view the websites of both parties to see that they are clearly different. Based on the printouts of the websites of the Respondent and the

Complainant, the contents and colours of these websites do appear different and distinguishable.

6.14 The Panel however noticed a close similarity between the Respondent's design, stylization, fonts and format in the Respondent's mark "TRANSPLACE" when compared to the Complainant's mark "TRANSPLACE" in use and as represented in selected certificates of registration for the Complainant's marks that were registered before the registration date of the disputed domain name on 21 July 2009. In addition, the lengths of these words in the two marks seem remarkably similar (despite the use of the "anchor device" to replace the letter "T").

The Respondent's mark in actual use at its website under the disputed domain name

The Complainant's mark in actual use at its website and represented in the various registration certificates adduced in Tab 10 of the Complaint



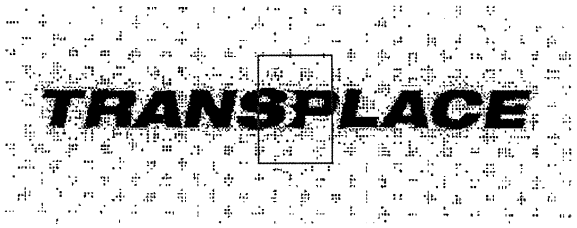
Int. Cl.: 35

Prior U.S. Cls.: 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 3,283,830
Registered Aug. 21, 2007

SERVICE MARK
PRINCIPAL REGISTER



Int. Cl.: 35

Prior U.S. Cls.: 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 3,304,299
Registered Oct. 2, 2007

SERVICE MARK
PRINCIPAL REGISTER

6.15 In addition to the documents and evidence submitted by the Parties, the Panel may undertake limited factual research into matters of public record if it deems this necessary to reach the right decision. This may include visiting the websites linked to the disputed domain name in order to obtain more information about the Respondent and the use of the disputed domain name and the Panel may also rely on her personal knowledge.

6.16 Given that the Respondent has failed to provide a legitimate explanation or reasoning for the choice of the disputed domain name (apart from stating that it is a suggestive word and words that can be associated with many various meanings) and due to the close similarity in the design, stylization, font and format of the word "Transplace" as adopted by the Respondent to the Complainant's "Transplace", the Panel believes the Respondent probably had knowledge of the Complainant's existence and the Complainant's marks prior to starting its business and before registering the disputed domain name.

6.17 Although the Respondent's company name is Transplace Logistics Sdn Bhd, the Panel notes that the company was incorporated on 10 July 2009, 11 days before the registration of the disputed domain name. Since the Complainant's website was already accessible by Malaysians some 8 years prior to the registration date of the disputed domain name and due to the close similarity in the design of the font, stylisation and format of the Respondent's mark "Transplace" as demonstrated above with the Complainant's mark "Transplace", the Panel believes the Respondent was aware of the Complainant's existence and the Complainant's mark "TRANSPLACE" and accordingly the Respondent has "actual" notice and not "constructive" notice of the Complainant and the Complainant's marks. Due to these factors, the Panel concludes that even if there were an offering of services by the Respondent before the date of the communication of the Complaint, it was not a genuine one. The mere assertion by the Respondent of its extensive assets does not establish nor justify its rights and legitimate interests in the disputed domain name.

6.18 The Panel concludes that the Respondent has not established that it has rights and legitimate interests in the disputed domain name.

Bad Faith

6.19 Paragraph 6.1 of the Policy provides that the evidence of bad faith registration and/or use of the disputed domain name may include amongst others, the circumstances identified from (i) to (iv). The phrase "may include" clearly suggests that the circumstances identified in this

paragraph 6.1 are not exhaustive and may extend to other circumstances not covered by this paragraph, as long as they are within the concept of "bad faith" registration and/or use.

6.20 The Complainant has contended that the choice of the word "TRANSPLACE" by the Respondent cannot be incidental. Given the global nature of the transportation and logistic services in general, the Complainant claims that the Respondent should be aware of the Complainant's ownership and usage of the TRANSPLACE marks when it commenced its business. The Complainant further claims that the Respondent has registered and/or used the disputed domain name to prevent the Complainant from registering other domain names with the same name and is a deliberate attempt to misappropriate and usurp the Complainant's goodwill and commercial reputation.

6.21 The Panel believes that the Respondent was fully aware the Complainant's existence and the use of the "TRANSPLACE" marks for the Services in 2009 and it has indeed adopted and used the disputed domain name to take an unfair advantage of the goodwill and reputation of the Complainant's marks "TRANSPLACE".

6.22 Based on all the evidence submitted by the Complainant, the facts and circumstances of the case, the Respondent's lack of justifications and explanations in choosing and adopting the mark "TRANSPLACE" as the disputed domain name and particularly, based on the close similarity in the design, stylization, fonts and format of the Respondent's mark with the Complainant's mark "TRANSPLACE" as shown above, the Panel finds that the disputed domain name has been registered and/or used in bad faith.

7. Conclusion

7.1 Based on all the facts and evidence adduced and upon the reasoning provided above, the Panel decides that:

(a) the disputed domain name is identical to the Complainant's marks "TRANSPLACE" to which the Complainant has rights; and

(b) the Respondent has registered and/or used the disputed domain name in bad faith.

7.2 Accordingly the Panel directs that the disputed domain name transplace.com.my be transferred to the Complainant.

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Wong Jin Nee
Sole Panellist
Date: 27 February 2015