

ADMINISTRATIVE PANEL DECISION
IN THE MATTER OF A DOMAIN NAME DISPUTE

Between

GREEN HILLS HOLDING COMPANY

And

GRAPHIC BAY CREATION

Case No. KLRCA/DNDR-314-2015

1. THE PARTIES

- 1.1. The Complainant is Green Hills Holding Company, a corporation duly organised and existing under the laws of the State of Nevada of the United States of America. The Complainant's authorised representative is Karen Abraham of Messrs Shearn Delamore & Co., 7th Floor, Wisma Hamzah-Kwong Hing, No. 1, Leboh Ampang, 50100 Kuala Lumpur, Malaysia.
- 1.2. The Respondent is Graphic Bay Creation of Suite 722, Block B, Mentari Business Park, 2 Jalan PJS 8/5, 46150 Bandar Sunway, Selangor.

2. THE DOMAIN NAME AND REGISTRAR

The domain name in issue is <topoil.com.my> ("Disputed Domain Name"). The Registrar of <topoil.com.my> is the Malaysian Network Information Centre ("MYNIC").

3. PROCEDURAL HISTORY

- 3.1. This Complaint was filed on 15 May 2015 with the Kuala Lumpur Regional Centre for Arbitration ("Centre"). The Centre verified that the Complaint has satisfied the formal requirements of MYNIC's Domain Name Dispute Resolution Policy ("MYDRP"), the Rules of the MYDRP ("Rules"), and the Supplemental Rules of the Kuala Lumpur Regional Centre ("Supplemental Rules").
- 3.2. The Respondent was formally notified by the Centre in a Notification of Commencement of Proceedings dated 25 May 2015. In accordance with the Rules, the Respondent was allowed until 15 June 2015 to submit a Response to the Complaint. No response was received from the Respondent.

- 3.3. The Complainant has elected for a single member Panel and the Centre has appointed Ms. Charmayne Ong Poh Yin as the sole panellist in this matter. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence to the Centre on 23 June 2015, and is thereby properly constituted.

4. FACTUAL BACKGROUND

- 4.1. The Complainant is in the business of providing quality lubricants. The Complainant's exclusive licensees are Atlas Asia-Pacific, Inc. doing business as Top Oil Products Company and Top 1 Oil Products Company.
- 4.2. The Complainant became aware of use of a "TOP OIL" mark in Malaysia and conducted investigations into these activities. On or around 8 January 2013 the Complainant, through its solicitors, issued a cease & desist letter to two companies; Top Lubricant (M) Sdn. Bhd. ("Top Lubricant") and CBT Petroleum Sdn. Bhd. ("CBT Petroleum") demanding that they cease use of the "TOP OIL" mark as well as the Disputed Domain Name on the basis that it was identical or confusingly similar to the Complainant's "TOP FORMULA 1 & DESIGN" marks.
- 4.3. The Complainant's solicitors received a reply from the solicitors for Top Lubricant and CBT Petroleum on 22 January 2013. In their response, Top Lubricant and CBT Petroleum asserted that they were the creators and/or rightful owners of the "TOP OIL" mark, which appears to have been incorporated in the Disputed Domain Name.
- 4.4. The Complainant's solicitors sent a response to Top Lubricant and CBT Petroleum on 2 April 2013 and reiterated the Complainant's demands. No further correspondence between the parties was put in evidence before this Panel.
- 4.5. On or around 14 April 2013, the Complainant lodged an opposition against CBT Petroleum's Malaysian Trade Mark Application No. 2011003249 for the mark "TOP OIL & Device". On account that no counter-statement was filed by CBT Petroleum in response to the Complainant's notice of opposition, CBT Petroleum was deemed to have abandoned its application in accordance with the Trade Marks Act 1976.

- 4.6. On or around 20 May 2013, the Complainant conducted a whois search of the Disputed Domain Name which revealed its registrant to be a company known as TP Transport Sdn Bhd ("TP Transport"). The Complainant's investigations revealed that TP Transport may be related to related to Top Lubricant and CBT Petroleum, on account that the three companies were being operated by the same persons at a common office premises.
- 4.7. A subsequent whois search on 9 October 2014 brought to the Complainant's knowledge that the Disputed Domain Name was no longer registered by TP Transport but instead by the Respondent, Graphic Bay Creation.
- 4.8. The Disputed Domain Name <topoil.com.my> under Registration No. D1A247605 in the Respondent's name has been registered since 22 November 2013. The website of Top Lubricant remains at the Disputed Domain Name.

5. PARTIES' CONTENTIONS

5.1. In summary, the Complainant contends as follows:-

- 5.1.1. The Disputed Domain Name is phonetically, visually and conceptually similar to the Complainant's TOP family of Marks.
- 5.1.2. The Disputed Domain Name incorporates the name "TOP OIL" which consumers have come to recognize as originating from the Complainant and its related companies as the Complainant and/or its products are commonly known as "TOP", "TOP OIL", "TOP 1", and "TOP 1 OIL" in Malaysia and worldwide.
- 5.1.3. The Disputed Domain Name is identical to the Complainant's registered <topoil.com> domain name as it reproduces the words "TOP OIL" in its entirety.
- 5.1.4. The goods offered for sale under the website connected to the Disputed Domain Name are identical or substantially similar in nature to the Complainant's goods under the TOP family of Marks.
- 5.1.5. The Disputed Domain Name was registered and/or used primarily for the purpose of and with the intention to attract, or divert, for commercial gain,

Internet users to the Respondent's website wherein identical goods of that of the Complainant is offered for sale which will consequently create a likelihood of confusion or deception as to the source of said goods.

5.1.6. The Disputed Domain Name cannot be *bona fide* and is inherently deceptive in light of the Complainant's tremendous reputation and goodwill connected to the business under the TOP family of Marks. The Respondent knew or ought to have known of the Complainant's TOP family of Marks and their presence in Malaysia and worldwide since the Complainant's goods under the TOP family of Marks have been introduced in Malaysia and in the worldwide market as early as the 1980s.

5.1.7. The initial record created in respect of the Disputed Domain Name was on 6 June 2011 after the registration of the Complainant's domain names <topoil.com> and <top1oil.com>, which evidences a lack of *bona fide* intent on the part of the Respondent in attempting to pass itself off as having a trade connection with the Complainant.

5.1.8. The Respondent has no rights or legitimate interests in the Disputed Domain Name as the Complainant has never authorised the Respondent to use the name "TOP" and the Respondent was never known as nor was it associated with the Complainant's TOP family of Marks at any time. The Respondent's use of the Disputed Domain Name and corresponding website constitutes trade mark infringement and passing-off of the Complainant's goods. It also amounts to trafficking and use in bad faith by virtue of inappropriate reproduction of the trade dress and get up.

5.1.9. The Respondent has acted in bad faith as the adoption, registration and use of the Disputed Domain Name is a deliberate attempt to misappropriate and usurp the Complainant's goodwill, reputation and commercial advantage which they have already enjoyed in Malaysia and continue to enjoy.

5.1.10. The registration of the Disputed Domain Name deprives the Complainant of the opportunity of being contacted by or connected to existing or prospective users, thereby passing off its domain name as one that is associated with the Complainant.

5.2. The Complainant is seeking for a transfer of the Disputed Domain Name to the Complainant.

5.3. The Respondent did not file a Response.

6. DISCUSSION & FINDINGS

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

6.2. Paragraph 5 of the MYDRP 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.

6.3. **The 1st Element [Paragraph 5.2(i) of MYDRP]: Whether the Disputed Domain Name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights**

A. Marks in Which The Complainant Has Rights

6.3.1. The evidence submitted by the Complainant shows that the Complainant is the registered proprietor in Malaysia of Registered Trade Mark No. 88005600 for



in respect of "*industrial oils and greases, lubricants, namely motor oil, motor oil additives and greases; included in Class 4*" registered since 26 October 1988. It is also the registered proprietor of Registered Trade Mark No. 89004415



for in respect of "*brake fluid, cleaning fluids and fluid additives for automobile engines, including engine coolant, rust inhibitor, crankcase flush and automobile undercoating fluids and sprays; all included in Class 1*" registered

- since 25 July 1989 (“the Malaysian Registered Marks”). It does not appear from the documents before the Panel that there are any disclaimers imposed on the Complainant’s Malaysian Registered Marks.
- 6.3.2. The Complainant asserts that it obtained rights to the Malaysian Registered Trademarks by virtue of an assignment and this is evidenced by the Assignment dated 10 September 2008 assigning to the Complainant the rights to the Malaysian Registered Marks, along with Singapore Registered Marks No. T89/04627A and T89/04628Z.
- 6.3.3. In addition, the Complainant asserts that it is the registered proprietor of some ninety-four (94) other marks worldwide (“Foreign Trade Marks”).
- 6.3.4. The Complainant is relying on the Malaysian Registered Marks and Foreign Trade Marks to support its assertion that it has extensive goodwill and reputation in the following marks: “TOP”, “TOP OIL”, “TOP 1” and “TOP 1 OIL” in Malaysia and elsewhere.
- 6.3.5. Having perused the documents put before this Panel, it occurs to the Panel that the Complainant is recorded as registered proprietor only on a handful of the Foreign Trade Marks. What is evident is that a large proportion of the Foreign Trade Marks are registered in the names of other entities, such as Champion Oil Company dba. Top Oil Products Co., Top Oil Products Company and Atlas Imports-Exports, Inc.
- 6.3.6. The Panel takes cognizance of the views of the panellists in *William R. Hague Inc. dba Hague Quality Water International v Water N Boss Marketing Sdn. Bhd. (Case No rca/dndr/2006/09)*. The principle discussed in that matter was that to establish the Complainant’s rights, “the country where a Complainant’s trade mark is registered does not have to be the country of residence or incorporation of the Respondent.” Implicit in this is the principle that the foreign trade marks relied upon must belong to the Complainant and the Panel finds that it is entitled to only rely on the Foreign Trade Marks that are registered in its name, and no other.

6.3.7. It is observed that the Foreign Trade Marks registered in the name of the Complainant are primarily device marks identical or similar to the Malaysian



Registered Marks

6.3.8. The Panel is mindful that this is a domain name dispute. In order to determine whether the Disputed Domain Name is confusingly similar to the Complainant's mark, the Panel must first determine the dominant features of the Complainant's Mark. Having considered the mark as a whole, visually and aurally, the Panel is of the view that the dominant features of the Malaysian Registered Trade Marks and the Foreign Trade Marks are the word "TOP" and the numeral "1".

6.3.9. The Panel finds that there is insufficient evidence to support the Complainant's claim that it has rights over "TOP", "TOP OIL" and "TOP 1 OIL". As observed in *William R. Hague Inc. dba Hague Quality Water International v Water N Boss Marketing Sdn. Bhd. (Case No rca/dndr/2006/09)*: "It has also been held frequently by WIPO and NAF panels that a common law trademark can confer rights. However, a common law mark requires proof of long-established use and exposure of the mark in a particular market." The Panel finds that this requirement has not been met by evidence provided by the Complainant.

6.3.10. Looking at the totality of the evidence before the Panel, the Panel concludes that the Complainant has established trademark rights in "TOP 1".

B. Is the Disputed Domain Name Identical and/or Confusingly Similar?

6.3.11. This Panel disregards the <.com.my> of the Disputed Domain Name since use of the ccTLD is required, necessary and functional to a name in the Internet and is irrelevant for comparison purposes (*Pomellato S.p.A. v. Richard Tonetti, WIPO Case No. D 2000-0493; Volkswagen Group Singapore Pte Ltd v Webmotion Design, Case No. rca/dndr/2003/01*).

6.3.12. It is clear that the Complainant's marks are not identical to <topoil>, being the material portion of the Disputed Domain Name. The issue for determination is therefore whether <topoil> is confusingly similar to "TOP 1".

6.3.13. As observed in *Google Inc v Digiattack (Case No. rca/dndr/2009/17)*, the relevant test here is whether the Disputed Domain Name incorporates the dominant and distinguishing part of the Complainant's mark.

6.3.14. Comparing <topoil> with "TOP 1", on the face of it, the Panel is of the view that they do not appear to be confusingly similar.

6.3.15. The Panel therefore finds that the Complainant has not satisfied Paragraph 5.2(i) of the MYDRP.

6.4. The 2nd Element [Paragraph 5.2(ii) of MYDRP]: Whether Registration and/or Use of Domain Name in Bad Faith

6.4.1. The Panel observes that the Respondent is Graphic Bay Creation and not Top Lubricant or CBT Petroleum. As the Complaint is targeted at the activities of Top Lubricant and/or CBT Petroleum and the Complainant does not appear to make a distinction between these entities and the Respondent, this Panel will not address any issues that may arise from this fact.

6.4.2. Paragraph 6.1 of the MYDRP sets out certain circumstances in which the Complainant may show registration and/or use in bad faith. Paragraph 7 of the MYDRP allows a Respondent/registrant to prove that registration and/or use of the Disputed Domain Name was not in bad faith by establishing that the Respondent has rights and legitimate interests in the Domain Name. Notwithstanding that the Respondent has not filed a response to this Complaint, the Complainant is still required to show that the registration and/or use of the Disputed Domain Name was done in bad faith.

6.4.3. The Complainant claims it has tremendous reputation and goodwill in the business under the TOP family of Marks, and that they are well-known within the meaning of Article 6bis of the Paris Convention. The Complainant claims that the Respondent's choice of the Disputed Domain Name was done in bad faith as the Respondent knew or ought to have known about the Complainant's trademarks. The Complainant has provided a list of Foreign Trade Marks, only a handful of which were registered in the name of the Complainant. The extracts from the Complainant's licensee's website suggests some amount of use of the Complainant's trademarks, but do not conclusively demonstrate that the Complainant's trademarks are well-known in Malaysia or elsewhere. The Panel

is not persuaded that the Respondent knew or ought to have known about the Complainant's trademarks.

6.4.4. Furthermore, the extracts from Top Lubricant's website at the Disputed Domain Name do not reveal any representations that Top Lubricant is associated with the Complainant. There are also no similarities between the look and feel of the two websites to suggest that Top Lubricant is intentionally misleading members of the public that are accessing its website. Further, the report of the private investigator seems to suggest that Top Lubricant and/or CBT Petroleum are conducting their business independently and without reference to the Complainant. Additionally, there is no evidence to show that Top Lubricant and/or CBT Petroleum have registered the Disputed Domain Name with the intention to deprive the Complainant of the opportunity of being contacted by or connected to existing or prospective users. Finally, the Complainant's assertion that the Respondent's registration of the Disputed Domain Name on a date after the registration of <topoil.com> and <top1oil.com> cannot, in itself, amount to bad faith.

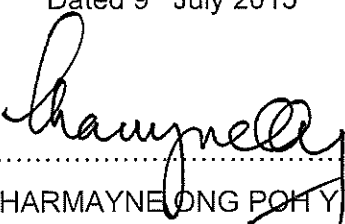
6.4.5. This Panel concludes that the requirement under Paragraph 5.2(ii) of the MYDRP has not been satisfied by the Complainant.

6.4.6. The Panel would make a final observation that this does not preclude the Complainant from pursuing any appropriate action in a court of law if the Complainant has cause to initiate a claim based on trademark infringement and/or passing off. As observed in *Ledtronics, Inc. v Ledtronics Sdn Bhd (Case No. rca/dndr/2004/05)* if the dispute is really directed at an action for trademark infringement and/or passing off, this is neither the forum nor is the Policy appropriate to resolve it.

7. CONCLUSION

In accordance with the findings under the MYDRP Policy and the Rules, the Panel dismisses this Complaint.

Dated 9th July 2015


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CHARMAYNE ONG POH YN