

ADMINISTRATIVE PANEL DECISION

In the matter of a Domain Name Dispute

Between

CELCOM PLANET SDN. BHD

Complainant

And

O C TECH

Respondent

Case No: KLRCA/DNDR -373-2016

1. The Parties

1.1 The Complainant is Celcom Planet Sdn. Bhd., (the “Complainant”) a company incorporated in Malaysia and having its registered office at Level 26, NU Tower B, No.23 Jalan Tun Sambanthan KL Sentral, 50470 Kuala Lumpur, Malaysia.

1.2 The Respondent is OC Tech (the “Respondent”) a company registered in Malaysia and having its registered office at No.117, Jalan BSG 3, Bandar Star Gate Lebuhraya Sultanah Bahiyah, 05400 Alor Setah, Kedah.

2. The Domain Name and Registrar

2.1 The domain name in dispute is <shockingdeals.com.my> (the “Disputed Domain Name”) and the Registrar is the Malaysian Network Information Centre (“MYNIC”) (the “Registrar”).

3. Procedural History

3.1 On 23 March 2016, the Complainant filed the complaint with the Kuala Lumpur Regional Centre for Arbitration (‘the Centre’). The Centre verified that the Complaint 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 On 28 March 2016 the Centre formally notified the Respondent of the Complaint through a Notification of Commencement of Proceedings of the same date. The Respondent was given 15 days within which to submit a Response to the Complaint.

3.3 On 24 April 2016 the Respondent filed a Response and accordingly the Centre on 29 April 2016 gave the Complainant five days within which to file a Reply which said Reply was duly filed by the Complainant on 09 May 2016.

3.4 As the Complainant elected to have the Complainant determined by a three member Panel the Centre appointed Ms Peggy Cheung, Ms Karen Abraham and Professor Ike Ehiribe as Panelists and advised the parties accordingly through a Notification letter dated 16 May 2016.

4. Factual Background

4.1 The Complainant is said to be a joint venture company established by SK Planet Co., Ltd with Celcom Mobile Sdn Bhd, to expand the online business of SK Planet Co., Ltd in Malaysia. SK Planet Co., Ltd is said to provide services relating to online and mobile service platform with its integrated commerce, digital contents, and advertising & marketing businesses. SK Planet Co., Ltd is said to be the owner and/or beneficial owner of the mark "SHOCKING DEALS" in Class 35 in various jurisdictions including but not limited to Malaysia, South Korea and Turkey. The Complainant is authorized to use and act for matters relating to the Mark in Malaysia. SK Planet Co., Ltd has filed two trademark applications for the mark "SHOCKING DEALS" in Class 35 in Malaysia. The marks are still pending for registration.

4.2 The Complainant is said to have commenced operating the website "http://www.11street.my/" and providing services to the public since 01 April 2015. The website is said to serve as a platform for sellers and buyers to conduct online transactions of sale and purchase. The operation of the website includes a large section with the Mark "SHOCKING DEALS".

4.3 The Complainant's operation of the website is described as successful by far as the website has grown exponentially in terms of users and subscribers. The website is said to have acquired more than 700,000 subscribers and 14,000 sellers in Malaysia to date. Currently transactions through the website are said to exceed RM 1,000,000 a day. The Complainant is said to have invested substantial amounts of time, money and effort to advertise the website to the public and such efforts include advertising the website on Google and Yahoo Internet advertisement services. Thus the Complainant is said to have invested well over RM100, 000,000 since the launching of the website on just adverts alone. In the month of November 2015 the Complainant is said to have spent about RM3, 000,000 solely on advertising the website on the Internet through Google and Yahoo Internet advertisement services.

5. Parties Contentions

5.1 The Complainant contends that the Respondent has wrongfully and or illegally and or unlawfully registered the disputed domain name, which wholly consists of the words "SHOCKING DEALS". The Complainant

further asserts that the Disputed Domain Name is likely to deceive the public into believing that the Disputed Domain Name belongs to or is related to the Complainant and or SK Planet Co., Ltd.

- 5.2 The Complainant further contends that the Disputed Domain Name, which incorporates the mark "SHOCKINGDEALS" is identical and or is confusingly similar to the Complainant's Mark and the public would be confused as to the origins of the services provided by the Complainant.
- 5.3 The Complainant states that the Complainant and SK Planet Co. Ltd did not authorize and/or give consent to the Respondent to use the mark, "SHOCKINGDEALS" and or for the Respondent to use or register the Disputed Domain Name. As a consequence the Complainant further asserts that such purported registration of the Disputed Domain Name by the Respondent was done with bad faith on the part of the Respondent as the wrongful registration of the Disputed Domain Name does infringe the intellectual property rights of the Complainant and or SK Planet Co., Ltd.
- 5.4 The Complainant further argues that the Respondent's erroneous claim on the Disputed Domain Name damages the Complainant's business, goodwill and reputation and also amounts to the false designation of origin and/or false description and/or dilution.
- 5.5 In further demonstration of the Respondent's bad faith the Complainant alludes to the fact that the Complainant's website started operating in April 2015 with substantial and extensive promotion and advertising while the Respondent only registered the Disputed Domain Name on 21 August 2015 as a result, the Respondent clearly registered the Disputed Domain Name for either immediate or future unlawful financial benefits.
- 5.6 The Respondent denies these contentions and asserts that the Mark "SHOCKING DEALS" is used commonly and freely by other businesses especially for services like retailing and sales as advised by the Trade Mark Office in Malaysia who has indicated that the Complainant's registration of the words "SHOCKING DEALS" shall give no right to the exclusive use of those words.
- 5.7 The Respondent states further that it has invested substantial amounts of money to create the website <http://www.shockingdeals.com.my> to which the Disputed Domain Name resolves with their R&D team since February 2015. The Respondent further states that before they received the cease and desist letter from the Complainant on 16 November 2015 they had not heard of the Complainant's website at <http://www.11street.my>.

- 5.8 The Respondent contends further that the Complainant's allegations of misleading, confusing and deceiving the public is baseless as the words 'SHOCKING DEALS' is used commonly in business especially in retail and sales. The Respondent states further that they used a special software to create and design their logo for SHOCKING DEALS therefore the Complainant's allegations of confusing similarity to their Mark is clearly not the case.
- 5.9 The Respondent finally states that they provide only selective electronic products supplied by their Chinese vendors and are not like those people who purchase the domain name to resell to potential buyers at a higher value; therefore the Complainant's allegations of unlawful financial benefit whether immediate or for the future are illogical.
- 5.10 The Complainant denies the contentions of the Respondent and further asserts in the Reply as follows; first that the Registrar at the Malaysia trademark office was only addressing the registrability of the words "SHOCKING DEALS" as a trademark and not the common law rights of the Complainant.
- 5.11 Secondly, that the Complainant had written to LAZADA in 2015 demanding they cease using the words SHOCKING DEALS in their advertising and promotional materials and Lazada has since ceased using the words "SHOCKINGDEALS" as requested.
- 5.12 With reference to an invoice dated 15 February 2015 which the Respondent relies on the Complainant highlights two things: (1) The Vendor in the invoice Qinxan Tech Co., Limited was only incorporated on 07 August 2015 and (2) Notwithstanding that the invoice was dated February 2015 the registration of the website only took place in August 2015.
- 5.13 Finally, the Complainant alludes to the fact that the registration of a domain name does not supersede trade mark rights and that the Respondent would have acknowledged this fact at the point of registration of the Disputed Domain Name when it purportedly represented and warranted that the Disputed Domain Name does not infringe any registered or unregistered trademark of a third party as stated in paragraph 3.2 of the registration agreement in Annexure 10 attached to the Complaint.

6. Discussions and Findings

6.1 Rule 17 of the MYDRP 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 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 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 Domain Name in bad faith

6.3 Identical or confusingly similar

The Panel is satisfied that the Complainant has established that it owns both registered and unregistered rights in the words SHOCKING DEALS as is evidenced by the extracts from the Intellectual Property Corporation of Malaysia attached to the complaint even though the marks are still pending for registration: and the fact that the words have become a distinctive identifier to be associated with the Complainant and or its goods or services. In arriving at this finding the Panel has taken into account: (i) the extent of sales through subscribers and sellers in Malaysia said to be around 700,000 subscribers and 14,000 sellers; and (ii) advertising expenditure undertaken by the Complainant to advertise the website linked to the Mark on Google and Yahoo internet advertisement services – an amount said to be in the region of RM100, 000,00. See in support of this finding paragraph 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions 2nd Edition (WIPO Overview 2.0). Furthermore, the Panel has taken due notice of the letter written to Lazada and dated 26 June 2015 advising them to desist from using the mark “SHOCKING DEALS” for its ongoing Shocking Raya Deal promotion.

6.4 Without any hesitation the Panel finds that the Disputed Domain Name <shockingdeals.com.my> is confusingly similar to the mark “SHOCKING DEALS” in that the Disputed Domain Name wholly incorporates the key words “SHOCKING DEALS”. The Panel finds as has been held in numerous other UDRP decisions that the top level domain suffix “. Com” and the country identifier “. my” does absolutely nothing to prevent a finding of confusing similarity. See in this regard *Volkswagen Group Singapore Pte Ltd v. Webmotion Design*, Case No. RCA/DNDR/2003/01.

Rights and Legitimate interests

6.5 The Panel finds that the Respondent has failed to establish that it has any rights or legitimate interests in the Disputed Domain Name. Clearly, the Respondent was at no time authorized, licensed or permitted by the Complainant to use the Complainant’s mark and or register the Disputed Domain Name.

Further in this regard the Panel finds that the Respondent has not proffered any evidence to demonstrate that it did use or is preparing to use the Disputed Domain Name in connection with any *bona fide* offering of goods or services nor has the Respondent made any legitimate non-commercial or fair use of the Disputed Domain Name. See in support of the foregoing *Oki Data Americas Inc. v. ASD Inc.*, WIPO Case No. 2001 – 0903.

Bad Faith registration and use

6.6 The Panel accepts that the Respondent has elected to imitate the Complainant's use of the Mark "SHOCKING DEALS" either by using the same colours of red, black and white to inscribe the letters in the Mark and or by superimposing those letters on a drawing of an explosion. The Panel finds such conduct to be clear and uncontroverted evidence of an intention to exploit the Complainant's Mark for unlawful financial gain which in itself is evidence of bad faith use sequel to bad faith registration. On any view the Panel finds that in conjunction with registering the Disputed Domain Name on 15 August 2015 the Respondent must have known or ought to have known of the prior registered and or unregistered rights of the Complainant before electing to register the Disputed Domain Name. The Panel is satisfied that a simple search before the Respondent elected to register the Disputed Domain Name would have revealed evidence of the Complainant's prior registered and or unregistered rights within Malaysia and beyond. This Panel accepts that the Complainant's website linked to the "SHOCKING DEALS Mark commenced operations in April 2015 with extensive promotion and advertisement. The Panel therefore finds the Respondents assertions to the effect that it had never heard of the Complainant rights until it received a cease and desist letter in November 2015 as implausible.

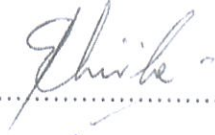
6.7 As is argued repeatedly by the Complainant the public will be deceived into believing that the Respondent is either related or associated with the Complainant which is not the case and or that the Disputed Domain Name will continue to cause confusion as regards the source of the goods and services provided by the Complainant under the respective "Shocking Deal" marks. Without any doubt the Complainant's registration of the Disputed Domain Name is tantamount to an infringement of the Complainant's intellectual property rights by reason of damage of the Complainant's business, goodwill and reputation.

7. Conclusion

7.1 In accordance with findings under the MYDRP Policy and the Rules, the Panel orders that the Disputed Domain Name <shockingdeals.com.my> be transferred to the Complainant forthwith.

Signed:

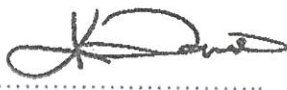
Professor Ike Ehiribe
(Presiding Panelist)



Ms Peggy Cheung
(Panelist)



Ms Karen Abraham
(Panelist)



Date: June 3, 2016.