

# Shearn Delamore & co

YOUR REF KLRCA/DNDR-239-2014  
OUR REF SD (IP)3946894(KA)

PEGUAMBELA & PECUAMCARA  
NOTARI AWAM  
EJEN PATEN BERDAFTAR  
EJEN CAP DAGANGAN  
EJEN REKABENTUK PERINDUSTRIAN

4 September, 2014

ADVOCATES & SOLICITORS  
NOTARY PUBLIC  
REGISTERED PATENT AGENTS  
TRADE MARK AGENTS  
INDUSTRIAL DESIGN AGENTS

Kuala Lumpur Regional Centre for Arbitration  
Bangunan Sulaiman, Jalan Damansara,  
50676 Kuala Lumpur

**BY HAND**

ATTN Ms. Suganthy David

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Sheila Ramalingam  
Ameet Kaur Purba  
Michelle C.Y. Loi  
Kavitha Karuppannan  
Cynthia Lian Hsiao Feon

Dear Suganthy,

**Re: Panel's Decision in the matter of a Domain Name Dispute of [www.mudah2u.my](http://www.mudah2u.my)**

We refer to the above matter.

We hereby forward three (3) hard copies of the Panel's decision in the matter.

Kindly acknowledge receipt.

Thank you.

Yours faithfully,

Shearn Delamore & co

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A list of the names of Senior Assistants and Assistants is available upon request at our offices in Kuala Lumpur and Penang

## **ADMINISTRATIVE PANEL DECISION**

**In the matter of a domain name dispute of www.mudah2u.my**

**Mudah.my Sdn Bhd v Scalable Systems**

**Case No. KLRCA/DNDR-239-2014**

### **1. The Parties**

The Complainant is Mudah.my Sdn Bhd, a company incorporated under the laws of Malaysia and having its registered address at 20<sup>th</sup> Floor Ambank Group Building, 55 Jalan Raja Chulan, 50200 Kuala Lumpur, Wilayah Persekutuan.

The Respondent, Scalable Systems is a business incorporated under the laws of Malaysia, with an address at No. 7, Lintang Murni 5, Taman Desa Murni, Sungai Dua, 13800 Butterworth, Pulau Pinang.

### **2. The Domain Name and Registrar**

The domain name in dispute is <mudah2u.my> (“the disputed domain name”). The Registrar of the domain name is the Malaysian Network Information Centre (MYNIC).

### **3. Procedural History**

3.1 The Complainant filed its Complaint with the Kuala Lumpur Regional Centre for Arbitration (“the Centre”) on 8 July 2014 both through e-mail and hardcopy (“the Complaint”).

3.2 On 8 July 2014, the Centre transmitted a request via e-mail to the Domain Administrator for verification on the identity of the holder of the disputed domain name. The Centre received an affirmative e-mail reply from the Domain Administrator via email on 10 July 2014.

3.3 The Centre upon reviewing the Complaint and being satisfied that the formal requirements of the MYNIC's (.my) Domain Name Dispute Resolution Policy ("MYDRP") ("the Policy"), the Rules of the MYDRP ("Rules") and the Supplemental Rules of the Regional Centre for Arbitration Kuala Lumpur ("the Supplemental Rules") have been complied with, formally notified the Respondent of the Complaint on 11 July 2014 via e-mail. The proceeding "Proceeding") formally commenced on 11 July 2014.

3.4 There was no response filed by the Respondent.

3.5 In view of the Complainant having designated a single panelist, the Centre invited Ms. Karen Abraham on 11 August 2014 to serve as a panelist in the instant case ("the Panel"). The Panel has submitted a Declaration of Impartiality and Independence via e-mail on 14 August 2014 and via post on 15 August 2014 respectively, pursuant to the Rules. On 25 August 2014, the Panel requested for an extension of time to forward its decision via e-mail and based on Rule 17 of the Rules, the Centre accepted and granted an extension of time until 4 September 2014.

#### **4. Factual Background**

4.1 The Complainant is Mudah.my Sdn Bhd, a company incorporated under the laws of Malaysia and having its registered address in Kuala Lumpur.

4.2 The Complainant owns and operates an online Internet platform which enables members of the public to advertise goods for sale.

4.3 The Complainant is the registered proprietor of the trade mark "MUDAH" in Classes 16, 35, 38 and 42 ('the MUDAH Mark'). The Complainant has adduced copies of the Certificates of Registration of the MUDAH Mark [Exhibit 3].

- 4.4 The Complainant is also the registered proprietor of 32 other marks in Malaysia comprising the word “MUDAH” (“the family of MUDAH Marks”). The Complainant has adduced copies of the Certificates of Registration of the family of MUDAH Marks [Exhibit 4].
- 4.5 The Complainant’s business was initially conducted through the domain name [www.mudah.com.my](http://www.mudah.com.my), which was registered on 9 October 2007 and subsequently the domain name [www.mudah.my](http://www.mudah.my) (“Mudah.my”) which was registered on 5 February 2008. Since its launch, the Mudah.my website has enabled members of the public to advertise their goods for sale conveniently from any location, and the advertised goods can consequently be bought by any member of the public.
- 4.6 The Complainant has also used its MUDAH Mark and/or the family of MUDAH Marks either as a trade mark and/or a domain name, and has created significant goodwill and reputation in respect of its online marketplace services and business.
- 4.7 The Respondent is a business registered on 13 November 2007 under the Registration of Business Act 1956. The nature of the Respondent’s business as described on the records of the Companies Commission of Malaysia is IT Consultant. The Respondent registered the disputed domain name [www.mudah2u.my](http://www.mudah2u.my) with MYNIC Berhad on 23 August 2011.

## **5. The Parties’ Contentions**

### **A. Complainant**

- 5.1 The Complainant relies on the above stated facts and contends that the disputed domain name is confusingly and/or deceptively similar to the Complainant’s registered MUDAH Mark and/or family of MUDAH Marks.
- 5.2 Since the launch of its Mudah.my website, the Complainant claims it has become the largest and most popular online marketplace website in Malaysia and that members of the trade and public associate the MUDAH Mark and family of MUDAH Marks with the services of the Complainant.

- 5.3 The Complainant contends that the Respondent had sent text messages to users of the Complainant's website informing them of a new portal to place their advertisements for free at the Respondent's mudah2u website, and that the text messages were designed to divert users to the Respondent's mudah2u website.
- 5.4 The Complainant asserts that through its solicitors, it sent a cease and desist letter dated 6 November 2013 to the Respondent demanding that the Respondent cease and desist from using the MUDAH Mark and the family of MUDAH Marks in its web site and as part of the disputed domain name. Although a follow up letter was sent by the Complainant's solicitors on 11 December 2013, there was no response from the Respondent.
- 5.5 The Complainant claims that subsequently it came to their attention that all contents on the Respondent's mudah2u website had been removed and replaced with a notice which stated that the said website was for sale for a minimum price of RM 100,000. The Complainant further observed that while the notice was still posted on the Respondent's mudah2u website as at 18 April 2014, the asking price had however been removed. The Complainant contends that the notice of sale on the Respondent's mudah2u website had since been replaced by another notice which stated that the Respondent had moved from the mudah2u website to a new domain at [www.paperplane.com.my](http://www.paperplane.com.my).
- 5.6 The Complainant asserts that the disputed domain name is confusing and/or deceptively similar to the Complainant's family of MUDAH Marks for the following reasons:-
- 5.6.1 The disputed domain name is phonetically, visually and conceptually similar to the Complainant's "MUDAH" Mark and the family of MUDAH Marks. The disputed domain name incorporates the MUDAH Mark with the addition of the suffix "2u" which is a non-distinctive suffix and is a descriptive and generic term for online services.

5.6.2 The Respondent's services in the Respondent's mudah2u website are identical or substantially similar to the Complainant's online marketplace services and for which the Complainant's MUDAH Mark and family of MUDAH Marks are registered.

5.6.3 The Respondent's mudah2u website is likely to mislead members of the trade and public into the false supposition and belief that the services advertised and offered therein are services offered by, originating from, associated with, or endorsed by the Complainant and that the disputed domain name belongs to or is in some way connected with or associated to the Complainant. Members of the trade and public may also be misled into believing that the disputed domain name is a variant or sub-brand of the MUDAH Mark or is part of the family of MUDAH Marks.

5.7 The Complainant states that the disputed domain name has been registered and used in bad faith by the Respondent as there was a clear intention to attract or divert, for commercial gain, Internet users to the Respondent's mudah2u website by creating a likelihood of confusion or deception that the Respondent's mudah2u website is operated or authorized by, or otherwise connected with the Complainant's Mudah.my website and /or is part of the family of MUDAH Marks.

5.7.1 The Respondent knew or ought to have known of the MUDAH Marks prior to the registration and/or use of the disputed domain name in light of the Complainant's reputation and goodwill in the MUDAH Mark and the family of MUDAH Marks.

5.7.2 The Respondent's conduct in registering and using the disputed domain name which offers the same or substantially similar services as that of the Complainant was intended to ride and cash in on the substantial reputation and goodwill in the MUDAH Mark and the family of MUDAH Marks, and to falsely represent to members of the public that the Respondent was in some way connected or endorsed by the Complainant when this was not the case.

5.7.3 The Complainant contends that the Respondent has registered and used the disputed domain name mainly for the purpose to sell, rent or transfer the disputed domain name for profit. The Respondent clearly intended to divert internet users, in particular Mudah.my

website users, to its mudah2u website, thereby building traffic with the ultimate intention of selling the disputed domain name for a profit.

- 5.7.4 The Complainant contends that the registration and use of the disputed domain name has and will continue to cause disruption to the business of the Complainant, and will continue to cause substantial loss and damage to the reputation and goodwill of the Complainant in the MUDAH Mark and/or the family of MUDAH Marks.
- 5.8 The Complainant also contends that the Respondent has no right or legitimate interests in respect of the disputed domain name and has instead registered and used the disputed domain name with the intention of cashing in on the Complainant's substantial reputation and goodwill in the MUDAH Mark and the family of MUDAH Marks and diverting internet users to its mudah2u website, so that the Respondent can eventually sell off the disputed domain name at a higher price.
- 5.9 The Complainant further claims that the Respondent's failure to respond to the cease and desist letter coupled with the action in putting up the disputed domain name for sale after it had received the cease and desist letter issued by the Complainant's solicitors shows that the Respondent did not intend to defend the registration and/or use the disputed domain name to offer genuine services.
- 5.10 In accordance with Para 12(1)(i) of the Policy, the Complainant requests that the disputed domain name <[www.mudah2u.my](http://www.mudah2u.my)> be transferred to the Complainant.

**B. Respondent**

The Respondent has not submitted any response under Paragraph 6 of the Rules.

## **6. Discussions and Findings**

- 6.1 As provided by Rule 17.1 of the Rules, the Panel hereby gives its decision based on the documents and evidence submitted by the Parties, the Policy and the Rules as well as any other relevant rule and principle of law applied in Malaysia.
- 6.2 Paragraph 5.2 of the Policy provides that the Complainant must establish the following two 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.

### **Identical or Confusingly Similar**

- 6.3 The Panel finds that the Complainant has adduced sufficient evidence to demonstrate that it is the registered proprietor and common law owner of the MUDAH Mark and the family of MUDAH Marks in Malaysia.
- 6.4 The Complainant has also registered the domain name [www.mudah.com.my](http://www.mudah.com.my) on 9 October 2007 and subsequently [www.mudah.my](http://www.mudah.my) (hereinafter referred to as “Mudah.my”) on 5 February 2008.
- 6.5 The disputed domain name <mudah2u.my> incorporates the Complainant’s registered mark ‘MUDAH’ notwithstanding the addition of the suffix “2u”.
- 6.6 In assessing the similarity between both the Complainant’s trade marks and the Respondent’s disputed domain name, the Panel finds that the disputed domain name incorporates an identical mark to the Complainant’s MUDAH Mark as it incorporates the word “mudah” in its entirety. The Panel takes cognisance that the word “2u” is a commonly used abbreviation by web based



service providers to describe the expression “to you” to provide the perception that the services can be provided for or catered to the end user.

- 6.7 It is salient to note that the essential feature of the disputed domain name is the word “mudah” and therefore, even if consideration is given to the presence of the suffix “2u”, the addition of such a suffix is insufficient to negate the likely confusion and/or deception from arising as a result of the registration and use of the disputed domain name. This is consistent with decisions that the mere addition of a non-significant element does not generally differentiate the domain name from the registered trade mark. (*Britannia Building Society v. Britannia Fraud Prevention Case No. D2001-0505*). Thus, the addition of other terms in the domain name, in this instance the addition of the suffix “2u”, does not affect a finding that the disputed domain name is confusingly similar to the Complainant’s MUDAH Mark and the family of MUDAH Marks to which the Complainant has rights (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale, Case No. D2000-0662*). The incorporation of the Complainant’s registered mark MUDAH alone in the disputed domain name is sufficient to show confusing similarity to the Complainant’s MUDAH Mark.
- 6.8 Furthermore, as the Complainant’s family of MUDAH Marks all contain the word “mudah” together with a variant of words, the abbreviation “2u” is likely to be perceived as an extension of the Complainant’s family of MUDAH Marks. There is therefore a strong likelihood that the disputed domain name will cause confusion as the presence of “2u” does not serve to distinguish the disputed domain name from the Complainant’s MUDAH Mark or family of MUDAH Marks.
- 6.9 Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s MUDAH Mark and the family of MUDAH Marks.

### **Rights and Legitimate Interest**

- 6.10 In order to demonstrate that the Respondent does have the requisite rights or legitimate interest that would merit its entitlement to the disputed domain name, the Respondent must prove the following in accordance to Paragraph 7.2 of the Policy:
- (i) before the date of communication of the Complaint, it has used or made preparations to use the disputed domain name or a name corresponding to the disputed domain name in relation to a genuine offering of goods or services; or
  - (ii) it is commonly known by the disputed domain name even though it has acquired no trade mark or service mark rights in the same; or
  - (iii) it 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.
- 6.11 There has been no response by the Respondent in the matter and therefore, there is no assertion or evidence adduced to demonstrate any rights and legitimate interest on the part of the Respondent. In light of the Respondent's failure to offer any explanation and justification, the Panel finds that there is no evidence on record to demonstrate that the Respondent has any rights or legitimate interests in respect of the disputed domain name [www.mudah2u.my](http://www.mudah2u.my) or that it has acquired any trade mark rights in the same.
- 6.12 The Complainant on the other hand has established its rights and ownership to the MUDAH Mark prior to the Respondent's registration of the disputed domain name on 23 August 2011. At the time the Respondent had registered the disputed domain name, the Complainant's online marketplace business under the MUDAH Mark and the family of MUDAH Marks had already been in operation for approximately 4 years.

6.13 Had the Respondent been legitimately interested in the disputed domain name, the Respondent would have at least attempted to defend its registration and/or use of the disputed domain name by responding to the cease and desist letter and reminder and/or filing a response to refute the Complainant's assertions and contentions. Accordingly, the Panel takes the view that the Complainant has adduced sufficient unchallenged evidence to show that the Respondent does not have the requisite rights or legitimate interest as described in paragraph 7 of the Policy.

#### **Bad Faith**

6.14 Paragraph 6.1 of the Policy stipulates that the evidence of bad faith registration and/or use of the domain name may include amongst others, the following circumstances:-

- (i) registration and/or use of the Domain Name mainly to sell, rent or transfer the domain name for profit to the Complainant, its competitor or the owner of the trade mark or service mark; or
- (iii) registration and/or use of the domain name to prevent the owner of a trade mark or service mark from using the domain name which is identical with its trade mark or service mark; or
- (iv) registration and/or use of the domain name to disrupt the business of the Complainant; or
- (v) registration and/or use of the domain name for the purposes of and with the intention to attract or divert, for commercial gain, Internet users to:-
  - (a) the Respondent's web site;
  - (b) a web site of the Complainant's competitor; or
  - (c) any other web site and/or online location,

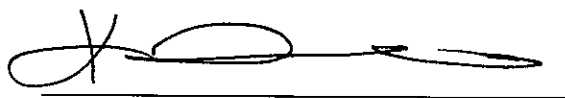
by creating a possibility of confusion or deception that the web site and/or online location is operated or authorised by, or otherwise connected with the Complainant and/or its trade mark or service mark.

- 6.15 The Complainant states that the Respondent registered the disputed domain name in bad faith as there was a clear intention to attract or divert Internet users to the Respondent's mudah2u website from the Complainant. The Complainant further states that the Respondent had registered the disputed domain name in bad faith as there was a clear intention to ride and cash in on the substantial reputation and goodwill in the MUDAH Mark and/or family of MUDAH Marks and to falsely represent that the Respondent's mudah2u web site is connected, affiliated, associated, licensed, sponsored and/or endorsed by the Complainant.
- 6.16 The Complainant contends that by sending text messages to the Complainant's users and customers claiming that "Mudah" the Respondent has "launched a new buy and sell portal", the Respondent has misled and confused the Complainant's users and customers into believing that the disputed domain name is a new web portal owned by the Complainant and has hence acted in bad faith in so doing.
- 6.17 Although the Respondent was given notice of the Complainant's objections vide cease and desist letters, the Respondent posted a notice on the disputed domain name which stated that the Respondent's mudah2u web site was for sale for a minimum price of RM100, 000. This clearly illustrates that the Respondent had no bona fide intent to use the disputed domain name but in fact intended to obtain a commercial gain by riding on the reputation and goodwill of the Complainant in the MUDAH Mark and the family of MUDAH Marks to attract or divert potential or existing customers of the Complainant to its website.

- 6.18 As indicated above, the Respondent did not contest any of the Complainant's assertions of facts nor its contentions. The Panel therefore takes the view that the adoption of the MUDAH trade mark by the Respondent as its domain name in relation to substantially similar services cannot be a mere coincidence and that the Respondent registered the disputed domain name in bad faith with the intention to mislead and confuse members of the public into believing that there existed an association or connection between the Respondent and the Complainant when in fact, there was none.
- 6.19 In view of all the evidence submitted by the Complainant, the facts and circumstances, and the Respondent's failure to respond or refute the Complainant's contentions, the Panel finds that the disputed domain name has been registered and used in bad faith.

7. **Conclusion**

- 7.1 Upon an evaluation and consideration of the circumstances and the evidence of the case, the Panel decides that the disputed domain name registered by the Respondent is confusingly similar to the MUDAH Mark and the family of MUDAH Marks which the Complainant has rights to, that the Respondent has no rights or legitimate interests in the disputed domain name and, that the Respondent's domain name has been registered and is being used in bad faith.
- 7.2 Accordingly, pursuant to paragraph 12.1(i) of the Policy and Rule 17.2 of the Rules, the Panel requires that the registration of the domain name [www.mudah2u.my](http://www.mudah2u.my) be transferred to the Complainant.



Karen Abraham

Presiding / Sole Panelist

Dated: 4 September 2014