

**Administrative Panel Decision
In the matter of**

**Between
Hugo Boss AG**

**And
Eppies Internet**

Case No: rca/dndr/2004/02

1. The Parties

The Claimant is Hugo Boss, A.G. a corporation incorporated under the laws of the Federal Republic of Germany, having a principal office and place of business in Metzingen, Germany.

The Respondent is Eppies Internet, a corporation incorporated under the laws of Malaysia, having a principal office in Gurun, Kedah. The date of registration of Eppies Internet is 16/09/01.

2. The Domain Name and Registrar

The domain name is <boss.com.my>.

The Registrar is the Malaysian Network Information Centre (MYNIC).

3. Procedural History

The Complainant filed its Complaint with the Regional Centre for Arbitration Kuala Lumpur ('the Centre') on May 31, 2004 both through e-mail and hardcopy. The Centre sent an acknowledgement of Receipt dated June 1, 2004, and thereafter sent a request to MYNIC for verification of the identity of the domain name holder on June 2, 2004. The Centre forwarded the Complaint to the Respondent by registered post and email on June 9, 2004.

An examination of this material confirms that all technical requirements for the initiation of this proceeding were met. Having verified that the Complaint satisfied the formal requirements of the MYNIC's (.my) Domain Name Dispute Resolution Policy and Rules, and the Centre's Supplemental Rules, the Centre formally commenced this proceeding on June 18, 2004.

On July 9th, 2005, the Respondent through its technical contact, Anthony Tsai of Eppies Digital Information and Communication Group (hereinafter referred to as the "Group), sent an e-mail to the Centre reacting to the Complaint, but did not submit a proper response.

The Complainant elected a single-member panel. A one member Administrative Panel, Dr. Ida Madieha bt. Abdul Ghani Azmi, was constituted by the Centre. Notice of the appointment was sent on the July 14, 2004 and the Panel has submitted a statement of Declaration of Impartiality and Independence as required by the Centre.

Factual Background

The Complainant is Hugo Boss AG, the owner of the trade mark HUGO and/or BOSS. The Complainant is a German company named after its founder Hugo Boss that has existed for more than 70 years. The Complainant deals with a wide variety of goods including perfumes, fashion clothing, clothing, footwear, sportswear, sport articles, eyeglasses, leather products, watches, lighters and other products for men, women and children.

The Complainant trades their goods worldwide and spent a considerable amount of money on advertising. In Malaysia alone, the Complainant has spent about 94 million (USD) in 2001 in advertising in various forms including print, sponsorship and Malaysian media.

Their trade mark 'BOSS', 'HUGO BOSS and BOSS HUGO BOSS' has been registered in many countries including Australia, Canada, China, France, Germany, Hong Kong, Singapore, Taiwan, Thailand, United Kingdom, USA. The Complainant has also obtained international registration for the mark 'Baldessarini HUGO BOSS', 'Baldessarini', 'BOSS HUGO BOSS', 'HUGO', 'HUGO HUGO BOSS', 'BHB' and 'BOSS'.

The Complaint is based on the trade mark 'BOSS' which is registered in 10 countries and is pending in Malaysia for three classes of goods; class 18 (leather goods, cases and bags, umbrellas and parasols, belts made of leather); class 25 (clothing and fashion articles) and class 34 (tobacco and tobacco products, smoker's articles' matches).

The disputed domain name <boss.com.my> was created by Huey Enterprise on Feb 16, 2000 (as per the MYNIC search report marked as exhibit [8]). The proprietor of Huey Enterprise is Kuek Huey Huey. The most recent search at MYNIC web site revealed that the domain name is now owned by a business named Eppies Internet (as per the MYNIC search report marked as exhibit [1]). Through a Registry of Business search, it is confirmed that Kuek Huey Huey is also the proprietor of Eppies Internet. The Complainant contends that as both Huey Enterprise and Eppies Internet are owned by the same person, Kuek Huey Huey is ultimately responsible for the registration of the Disputed Domain Name.

The Complainant had sent a cease and desist letter dated July 25, 2001 (as per exhibit 10).

The Domain Name remained dormant for several years and for a short period of time around May 2003 it was linked to a website www.hiboss.net. The Respondent appears to belong to a company names ePPIES Digital Communication & Information Group ("the Group"). A Whois search revealed that the Group has also registered www.hugolead.com

(as per exhibit 17) , www.hiboss.net, www.apple.com.my (as per exhibit 18); www.etaipei21.com and www.witai.com (as per exhibit 13).

4. Parties Contentions

The Complainant contends that the Respondent has registered and/or used the Disputed Domain Name in bad faith on several grounds. Firstly, the Complainant alleges that the Respondent has demonstrated the intention to profit from registering the Disputed Domain Name. The Complainant also alleged that as “the Group” had registered four other domain names; www.boss.com.my; www.hiboss.net; www.hugolead.com and www.apple.com.my. These registrations demonstrate a willful attempt to ride on the goodwill and reputation of their well known BOSS trade mark. The Complainant asserts that the Respondent does not have any legitimate interest on the domain name as the disputed domain name remained dormant and does not have any constructive content except for a short period of time around 2003 when it was linked to the website www.hiboss.net. The Respondent is neither the licensee of the Complainant, nor is it otherwise authorized to use the Complainant’s BOSS trade marks. The Complainant also contends that the respondent is not commonly known as “BOSS” neither does the Respondent own a business named “BOSS”.

The Respondent has not submitted a valid Response under para 6 of the Rules. However, through several e-mail correspondence, the last being on 9th July, 2003, the Respondent through its technical contact, Anthony Tsai of the Group, denies these contentions and asserts that the Complainant do not have a monopoly over the word ‘BOSS’ as the word is a common English word. In particular, the Respondent asserts that it is only trading on computer equipment and should not be confused with the Complainant’s goods.

5. Discussion and Findings

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.

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.

It has to be noted that the Complainant need not prove that both the registration and usage of the domain name has been done in bad faith. Suffice if the Complainant is to prove either one by virtue of the word ‘and/or’ in paragraph 5(ii) above.

Identical or confusingly similar

The Panelist finds that the disputed domain name <boss.com.my> incorporates the Complainant’s mark ‘BOSS’, with the addition of a gtld “.com” and a cctld “.my”. The

Panelist has no difficulty in finding that the disputed domain name is identical to the Complainant's trade mark.

Rights and legitimate interests

According to para 7 of the Policy, the Respondent may prove his right and legitimate interest in the disputed Domain Name by substantiating evidence that:

- (i) before the date of the respondent being informed of the Complainant's dispute, the respondent had used or made preparations to use the Domain Name or a name corresponding to the Domain Name in relation to a genuine offering of goods or services; or
- (ii) the respondent is commonly known by the Domain Name even though he has acquired no trade mark or service mark rights in the same name; or
- (iii) the respondent are using the 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.

Through its e-mail dated July 9, 2005, the Respondent through its technical contact, Anthony Tsai, avers that the Complainant do not have an absolute monopoly over the word 'BOSS' as it is a common word.

The Complainant, however, avers that the word 'boss' is no longer a common word but a well known mark. This is because the 'HUGO and/or BOSS' trade marks are widely used and extensively advertised world wide. The sales turnover in Malaysia alone accounts to 251, 800 USD in 1999 and doubled in 2002 to 548, 500 USD. In Malaysia, the mark 'HUGO BOSS' has been registered in class 18 and 25, 'Boss Hugo Boss' in class 25 and 'Hugo Hugo Boss' in class 18. The four registrations are limited to the combination marks, 'HUGO BOSS', 'BOSS HUGO BOSS' and 'HUGO HUGO BOSS'.

On top of that, the Complainant has another 11 pending applications in various classes of goods, primarily pertains to apparels and clothing but also covers tobacco products, advertising, business management (Class 35) and planning of business premises (class 42). Off the 11 pending applications, three relates to the mark 'BOSS' in class 18, 25 and 34.

The Complainant contends that by virtue of the Complainant's history as well as the Complainant's established name in trade, the public and members of the trade have come to recognize and associate the Complainant's BOSS trade marks as originating from the Complainant and no other.

The Complainant's right over the mark HUGO and/or BOSS is undisputed. In fact, the complainant asserts that their marks HUGO and/or BOSS are well known marks. In Malaysia, since 2000, a more extensive protection has been conferred for well known marks as per section 70 (B)(1) of the Trade Marks Act 1976. Article 13 of the Trade Mark Regulations 1997 further details 6 elements of well-known mark; all of which are proven by the Complainant. The Complainant has maintained an impressive international

portfolio by attaining registration of the HUGO and/or BOSS marks in more than 20 countries and has also enlisted international registration. The Complainant has demonstrated that the annual sales figure in Malaysia and the amount of money invested in advertisements and promotion of HUGO and/or BOSS products is substantial.

The Complainant has adduced a considerable number of opposition proceedings in national trade mark offices that have upheld that the mark 'HUGO BOSS' and 'BOSS' to be well known. In Austria, the Complainant won an opposition proceeding against a third party for registering the trade mark BOSS! in boldscript for goods in Classes 32 (in respect of energy drinks, vitamin and isotonic beverages, non-alcoholic mineral waters, beers) and 33 (in respect of alcoholic beverages (except beers) but excluding liqueur, gin and cognac) in 1999.

In China, the Complainant won an opposition proceeding against a third party in 2004 for registering the mark 'BOSS Republic' covering "clothes, hats, shoes, etc" in Class 25. Earlier on in 1999, the Complainant filed an opposition against the registration of the mark 'BOSSI INTERNATIONAL' in respect to traveling cases, (luggage) boxes and clothes bag for traveling. Besides that they have also managed to file opposition against several registrations involving the Chinese characters of BOSS HUGO BOSS. In Taiwan the Complainant won an administrative suit to overturn an opposition decision in regards to the registration of the trade mark "LENBOSS". In the opposition against the registration of the mark 'SPLENDID BOSS', despite the addition of the word "SPLENDID", the Trade Mark Office noted that the key word is "BOSS" and found in favour of the Complainant. The Complainant has also won several opposition proceedings against the registration of "RICH BOSS", "KIDS BOSS", "gim by bos" "BOSS and device" on Chinese characters, BOSSLADY and several other proceedings in Austria.

The Complainant has also successfully filed a complaint to the WIPO Arbitration and Mediation Centre against a third party that registered the domain names, 'bossshoes.com', 'bossshoes.net' and 'bossshoes.org' (Case No. D2000-1135). The Complainant won an ICANN domain name dispute case, Hugo Boss AG v Dr. Yang Consulting Case, over the domain name "myhugoboss.com" (Case No D2000-1109)

All these leads to the conclusion that the HUGO and/or BOSS trade marks are well known trade marks according to the criteria set down in Article 13 B of the Trade Mark Regulations 1997.

The Respondent through its technical contact, Anthony Tsai, asserts in an e-mail dated July 9th, 2004, that the word 'boss' is a common English word, which should not be owned by anybody. The Respondent asserts that several registrations on that domain names in other countries exist such as www.BOSS.COM; boss.fr; boss.ab.ac;boss.on.ca;boss.ch; boss.je; boss.co.kr; boss.nl; boss.no; boss.co.nz; boss.com.sg; boss.com.au; and (simply) boss.

The Respondent asserts further that the use of the domain name is for the purpose of legitimate selling of goods, in this instance of a product known as BOSS (Broadband Office Storage Server) – the FTP server/network to store up NAS by IOGEAR.

A deeper analysis of the WHOIS report provided by the Respondent reveals that most of the other registrants of the variation of the 'boss' domain name have legitimate entitlement over the name as they are either acronyms of their business name or they are commonly known as 'boss'. In this case, the Respondent is not commonly known by the domain name. And if their assertion is true that the use of the domain name is for the purpose of legitimate selling of computer equipment under the trade mark BOSS, the Respondent had not furnished any documentary evidence of a proper licence from the proprietor of the goods.

From the Respondent's e-mail, it looks clear that the Respondent knows of the existence of the Complainant's marks. The Respondent was aware that the mark is being widely publicized globally and constantly features throughout the Internet but asserts that the complainants' official web site is 'hugoboss.com'.

The Respondent cites cases of other common words such as 'apple' and raises the question as to who has a right over the word – is it California Apple, a fresh apple seller or the jean manufacturer or Apple Computer?

Yet what the Respondent has not revealed is that in all these cases the sellers have legitimate rights over the mark 'apple'. The Panelist is also particularly troubled with the Group's registration of the domain name 'apple.com.my'. Whilst the word 'apple' may arguably be open to others, it is really questionable why the Group (of which the respondent is a member) should be having the well known logo of Apple Computer on their web site (as per exhibit 18).

The Respondent had also cited the ICANN's rule that common word such as car, bank, fish, travel, software, etc. belongs to the public realm and that nobody has a right to stop others from registering domain names like ecar, ebank, efish, elaw, ebook. etravel, esoftware etc.

The Panelist agree that 'BOSS' is a common word and in its common usage, the word means 'master, employer or a person having control over others'. (Longman Dictionary of Contemporary English). It has to be noted that 'boss' is an undistinctive word, and most likely used daily in Malaysia where English language is the second language and the preferred language in business.

However, it is possible for someone to develop goodwill over a common word through long standing trade of goods, so much so that the word attain a secondary meaning.

The constraint is that holders of a well known mark consisting of common words may have difficulty in stopping others from using that word as their domain name if the usage is legitimate. In such a case, if another internet user has an innocent and legitimate reason for using the common word as a domain name and is the first to register it, that user should be able to use the domain name, provided that it has not otherwise infringed upon or cause confusion on the well known trade mark.

Taking all these into account, the Panel found that the Respondent's claim do not inspire any credibility and merit non-acceptance. In relation to the Respondent's claim that it is using the mark in its ordinary dictionary meaning, it remains to be questioned why the Respondent (through its group, ePPIES Digital Communication & Information Group) has also registered www.hiboss.net and www.hugolead.com; two variations of both the 'BOSS' and 'HUGO' marks belonging to the Complainant. The Respondent has not supplied any shred of evidence rebutting this allegation. In light of this, it is reasonable for the Panelist to infer that the Respondent's usage of the word may not be as innocent as it claimed to be. The Respondent, therefore, fails to prove all three items (i) –(iii) enlisted under Paragraph 7 of the Policy justifying its rights over the domain name.

Bad Faith

Clause 6.1 of the Policy sets out the evidence of bad faith registration which may include, among others, the following circumstances:-

- (i) you registered and/or are using 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
- (ii) you registered and/or are using 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
- (iii) you registered and/or are using the Domain Name to disrupt the business of the Complainant; or
- (iv) you registered and/or are using the Domain Name for the purposes of and with the intention to attract or divert, for commercial gain, Internet users to:-
 - (a) your 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 authorized by, or otherwise connected with the Complainant and/or its trade mark or service mark.

As for item (i), the Complainant asserted that the Respondent had indicated the intention to profit from registering the Disputed Domain Name and demonstrates bad faith through its response on 6 December 2002. This is when the Respondent indicated that it 'expect more sincerity [from the Complainant] for further negotiation on either transferring the ownership of the said domain name to [the Complainant] and/or other settlements for this dispute'.

The Panelist is of the view that the Respondent's response may not be a clear indication of the intention to sell, rent or transfer the disputed domain name for a profit. In fact, when the Complainant's lawyer initiated for the assignment of the disputed domain name for a modest sum, initially for RM 500 and later for USD 500, to defray the out of pocket costs of maintaining the domain name, the Respondent did not make any counter offers.

As for item (ii), the Panelist has no difficulty in imputing that the Respondent had engaged in a conduct to prevent the trade mark owner from using that domain name which is identical with its trade mark or service mark. The Respondent asserts that the Complainant's official web sites are www.hugoboss.com and www.hugo.com and not www.boss.com. The Respondent also claims that it is using the disputed domain name in its ordinary English meaning. According to the Respondent, 'each peoples want to become boss. In view of this spot, our company take the word BOSS as our website, we provide a fast and easy way to achieve their dreams, everybody are possible to become BOSS.'(e-mail dated July 9, 2004)

However, the Respondent has not managed to substantiate its claim that the usage of the word 'boss' reflects the dictionary meaning of the word. As there was no evidence to the effect, there is no plausible reason that the registration can be done other than bad faith as the Group has also registered other domain names containing both the 'HUGO' and 'BOSS' marks. It would be entirely different if these registrations involved only the common expression of the word 'boss', but this is not the case here. It is thus reasonable for the Panelist to infer that the respondent's claim is highly in suspect.

What about item (iii)? Is there any indication that the Respondent is using or registering the domain name to disrupt the business of the Complainant? The Panelist found that there is no compelling evidence to support this element and thus is completely inapplicable. The Respondent is not the competitor of the Complainant and thus there is no possibility of disrupting the business of the Complainant.

Item (iv) requires that there is an intention to attracting or divert, for commercial gain, Internet users from the Complainant's web site to the respondents. This diversion created 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.

The Respondent through its technical contact, Anthony Tsai refutes (through e-mail correspondence dated 12/06/02) that it has caused confusion or deception on the mind of Internet user to believe that the said domain name has any connection or association with the complainant. Even though the Respondent concedes that the Complainant's brand is well known throughout the world, it is also known that the Complainant does not sell computer and related service. Thus, there is no possibility of confusion or association with the Complainant.

Is there a possibility of confusion and deception or at least association with the Complainant's mark? A visit to "www.boss.com.my" reveals that the layout of the web page including the logo BOSS that is used by the Respondent is different from the Complainant. None of the materials in that web site contains any trade marks and/or logos of the complainant. The possibility of confusion or association with the Complainant is missing here.

The Complainant has not revealed any instances whereby users have actually been confused into thinking that the respondent's web site is connected or at least associated with the Complainant.

There is not enough evidence to substantiate the claim that the respondent is capitalizing on Complainant's fame. There is no visual similarity between the respondent's web site and the Complainant's. There is no attempt to create confusion especially so that the goods are entirely different altogether.

In light of all the evidence submitted by the Complainant, the facts and circumstances discussed above, the Panelist found that the Complainant has succeeded in proving item (ii) of Paragraph 5.2 of the Policy.

Conclusion.

In accordance with findings under paragraphs 5 and 7 of the Policy and Rule 17 of the Rules, the Panel directs that the domain name <boss.com.my> be transferred to the Complainant.

**Assoc. Prof. Dr. Ida Madieha
Abdul Ghani Azmi
Sole Panelist**

Date: 5th August 2004.