

ADMINISTRATIVE PANEL DECISION

In the Matter of a Domain Name Dispute

Between

NEP Holdings (Malaysia) Berhad

... Complainant
And

Liew Bin Dian t/a C & C Network

... Respondent

Case No. rca/dndr/2004/04

1. The Parties

The Claimant is **NEP Holdings (Malaysia) Berhad (Company No. 333843-V)**

The Respondent is **Liew Bin Dian t/a C & C Network (Business Registration No. 1125072-V).**

2. The Domain Name and Registration

Domain Name : **360agaricus.com.my**

Registrar : Malaysian Network Information Centre (MYNIC)

3. Procedural History

- (i) A complaint was lodged by the Complainant on October 25, 2004 which was acknowledged receipt by Kuala Lumpur Regional Centre for Arbitration (KLRCA) on the same date.
 - (ii) The Kuala Lumpur Regional Centre for Arbitration (KLRCA) had vide letter of October 29, 2004 commenced proceedings and had requested the Respondent to respond on or before November 24, 2004.
- (i) The complaint was also dispatched by email to the Respondent now@tm.net.my on October 28, 2004 which was returned undelivered with remarks "Mailbox temporarily disable".
 - (ii) On November 2, 2004 the Administrator of the server at Daemon@ike-intl.com had confirmed that after one or more unsuccessful delivery attempts, the attached message to now@tm.net.my has been removed from the mail queue permanently for failure to deliver to the Respondent as mailbox for now@tm.net.my is temporarily disabled.

4. Factual Background

The domain name in issue "**360agaricus.com.my**" (hereinafter referred as "disputed domain name") was created (registered) with MYNIC on November 4, 2003 vide Registration No. DIA037844 by the Respondent as evidenced by **Exhibit C** and expired on November 4, 2004.

The Complainant in their complaint had stated that they are a well known business of health care products throughout the world and in Malaysia.

They contend that they have coined the trademark "**360agaricus**" and its variants as early as August 10, 2002 and has been using the said trademark since then.

In Malaysia, the Complainant has filed an Application No. 2003-14223 and 2003-14224 to register the trademark "**360 and device**" as a trademark in Classes 5 and 29 respectively on October 21, 2003 for the following specifications:-

Class 5

“pharmaceutical; medicinal drinks; pharmaceutical preparations; pills for pharmaceutical purposes; plant fibres; all included in Class 5”

Class 29

“mushrooms, preserved; vegetable juices for cooking; vegetable soup preparations; vegetables, cooked; vegetables, preserved; vegetables, dried; vegetables, tinned; all included in Class 29”

as evidenced by **Exhibit D** for which the Complainant contends they have the right.

The Complainant has registered several domain names publicizing the trademark “360agaricus” on its website and the related ones to the disputed domain name in issue are:-

- (i) www.diamond360agaricus.com;
- (ii) www.360agaricusblazeimurill.com;
- (iii) www.360agaricusnep.com
- (iv) www.360diamond.com
- (v) www.360agaricusbydiamond.com
- (vi) www.360rewardclub.com
- (vii) www.nep360agaricus.com
- (viii) www.360-agaricus.com

as evidenced by **Exhibit F**.

The Complainant has incurred substantial amount of monies in promoting “360agaricus” in Malaysia by advertisements, radio and flyers as evidenced by **Exhibit F** including launching a reward scheme marked as **Exhibit G**.

Laboratory Reports in **Exhibit H** on “360agaricus” has been obtained by the Complainant in September 2002.

The Complainant further contends that the Respondent was an authorized dealer of the Complainant’s marketing arm’s company namely Nature Environment Products Sdn Bhd since April 4, 2003 as evidenced by **Exhibit I** and was Head of the Department of the said Company for 14 months from May 15, 2000 to July 31, 2001.

The Complainant has further contended that the Respondent has in bad faith proceeded to register the domain name in issue and has also offered to sell the said domain name to the Respondent.

The Respondent has todate failed to provide a reply to the Complainant and as such, I am unable to provide the factual background for the Respondent.

5. The Parties’ Contention

I. The **Complainant** contends that:-

- (i) The Complainant has rights to the trademark “360agaricus”.
- (ii) The disputed domain name is identical or confusingly similar to the trademark “360-agaricus” used by the Complainant.
- (iii) The Respondent is not known by the name “360-agaricus” as his trading name is “C&C Network”
- (iv) There is no connection between the Complainant and the Respondent and the Complainant has not licenced or otherwise permitted the Respondent to register the disputed domain name incorporating the trademark “360agaricus”
- (v) The element of bad faith is evidentially present when:-
 - (a) The Respondent has offered for sale the disputed domain name to the Complainant as evidenced

by **Exhibit K**.

- (b) The Respondent had secured domain names in countries where the Complainant has commercial presences and interest, namely, Singapore and Hong Kong, which has prevented the Complainant's legitimate use and accordingly disrupted the Complainant's business.

- (c) The Respondent being an authorized dealer and Head of Department of the Complainant had knowledge of the commercial interest of the Complainant and the linkage of the mark "360agaricus" to the Complainant at all material times.

II. The **Respondent** has to date not submitted a reply to the Complainant's contentions.

6. **Discussions and Findings**

Having perused through the Complainant's complaint which have been substantiated by the relevant exhibits, I am convinced that the Complainant has established the following elements in the complaint which is incumbent on the Complainant to do so irrespective of the absence of the Respondent's reply pursuant to Rule 5.2 MYNIC (.my) Domain Name Dispute Resolution Policy

- (i) The disputed domain name is identical or confusingly similar to the trademark the Complainant has rights; and
- (ii) The Respondent has registered and/or used the Domain Name in bad faith;

for reasons stated hereinbelow:-

(i) **Identical or Confusingly Similar to Complainant's trademark**

The Complainant's trademark submitted for registration in Malaysia is "360 and device" and the disputed domain name is "360agaricus.com.my"

Until registration is obtained, the trademark being unregistered, one would have to look into the issue of passing off. (S.82 Trade Marks Act 1976).

The Court of Appeal in **British Telecommunications Plc v One In a Million [1998] 4 All ER pg 476** had decided that the mere registration of a domain name could give rise to the liability for passing off.

In a cybersquatting instance, like the Respondent which I can safely assume, that by registering the disputed domain name containing the word "360agaricus.com.my" the Respondent has falsely represented to the people that the Respondent was connected to or associated with the Complainant and thereby giving rise to the liability for passing off.

Further, the disputed domain name was an instrument of fraud and an unrealistic use of the name will result in passing off.

(Petroliam Nasional Berhad vs Khoo Nee Kiong [2003] 4 MLJ 216 which followed the approach taken in British Telecommunications Plc v One in a Million case)

The disputed domain name is almost identical and confusingly similar to the Complainant's trademark of "360 and device" filed in Malaysia for registration and the Complainant had not submitted the word "agaricus" together for registration. Nevertheless, the Complainant has been representing and connecting the trademark to the "Agaricus" word in their pamphlets and advertisement (see Exhibit F) and such it is within the knowledge of the people of the said connection and goodwill the Complainant has acquired over the years.

The Complainant has further substantiated the registration of the various domain name, the closest being

www.360-agaricus.com. It is abundantly clear from the exhibits provided by the Complainant that the “360agaricus” is associated with the Complainant and therefore the Complainant has rights to the trademark “360agaricus”. The Respondent’s registered domain name of the same mark is almost identical and confusingly similar to the Complainant’s mark “360” and the word “agaricus” being used to denote the product.

The Complainant’s right to the mark is further evidenced by the fact in commercially dealing with the marks internationally since August 10, 2002 which I have to accept on the face of it since it is not rebutted.

II **The Respondent’s registration was done in bad faith**

The elements of bad faith as stated in Rule 6 MYNIC’s Domain Name Dispute Resolution Policy are in existence in this case as follows:-

- (a) Exhibit K is the evidential document dated December 26, 2003 of the Respondent’s intention to sell the disputed Domain Name to the Complainant for a profit.
- (b) Further, in addition, on the face of the webpage, it can be construed that the appearance of the Domain Name, is with the intention to attract or divert for commercial gain, internet users to the Respondent’s website by creating a possibility of confusion or deception that the website and/or online location was operated or authorized with the Complainant and its trademark.
- (c) The very fact that the Respondent was previously engaged by the Complainant as part of their team imputes knowledge and intention in the Respondent to register the disputed domain name (having knowledge it has not been registered by the Complainant) to profit from the same.

Hence, I am convinced that the Respondent has registered the disputed domain name in bad faith.

7. **Conclusion**

In conclusion for reasons stated above, I hereby grant the Complainant’s request and order that the domain name “360agaricus.com.my” to be transferred to the Complainant if the said domain name, which expired on November 4, 2004 has been renewed by the Respondent.

Dated this December 22, 2004.

T. KUHANANDAN
Single Panelist