

## **ADMINISTRATIVE PANEL DECISION**

**In the matter of**

**Netflowers Pte Ltd (Complainant)**

**-And-**

**Chan, Hong Mun T/A Mymall Dot Com Enterprise (Respondent)**

**Case No. rca/dndr/2005/07**

### **1. The Parties**

The Complainant Netflowers Pte Ltd is a company incorporated under the laws of Singapore and represented by Ting and Partners, Advocates and Solicitors, Kuala Lumpur, Malaysia.

The Respondent is Chan, Hong Mun t/a Mymall Dot Com Enterprise of Cheras, Kuala Lumpur, Malaysia, represented by Goh Wong Pereira, Advocates and Solicitors, Kuala Lumpur, Malaysia.

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

The domain name is <myflower.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') by email on November 21, 2005 and by hard copy on November 22, 2005. The Centre sent an Acknowledgement of Receipt of Complaint on November 23, 2005 and on November 24, 2005 submitted to MYNIC a request for verification of the identity of the domain name holder. The MYNIC 'whois' search result indicated that the current registrant of the disputed domain name is Mymall Dot Com Enterprise.

The Centre verified that the Complaint satisfied the formal requirements of the MYNIC's (.my) Domain Name Dispute Resolution Policy ('the Policy'), the Rules of the MYNIC's (.my) Domain Name Dispute Resolution Policy ('the Rules') and the Supplementary Rules of the Regional Centre for Arbitration Kuala Lumpur ('the Supplementary Rules').

The Centre forwarded the Complaint to the Respondent and commenced the proceedings on November 29, 2005.

The Respondent submitted a Response by email and hard copy on December 19, 2005. The Complainant submitted a Reply to the Response by email and hard copy on January 3, 2006.

The Complainant having elected for a single member Panel, the Centre appointed The Honourable Neil Anthony Brown QC in this matter. The Panel having submitted a Statement of Declaration of Impartiality and Independence as required by the Centre, notification of the appointment was given on January 13, 2006. The projected date for decision was determined to be February 13, 2006.

The Panel finds that it has been properly constituted.

#### **4. Factual background**

These proceedings have been vigorously defended and it is not therefore surprising that many of the facts are in dispute. The Panel will therefore confine itself in this section of the decision to reciting the facts about which there is probably agreement and defer until later in the decision a discussion on the more contentious factual matters on which conclusions will have to be reached.

The Complainant is a Singapore company with a presence in Malaysia through a Malaysian subsidiary named Myflowers Sdn Bhd which was incorporated on November 15, 1999. Since that time the Complainant has been conducting the business of an online retail florist network commencing in Malaysia, but now operating in one form or another in 11 countries including Malaysia and Singapore. It also sells other gifts on-line.

It is the owner of two trademarks, the details of which are as follows:

- (a) trademark No.00015583 registered with the Registrar of Trade Marks of the Intellectual Property Corporation of Malaysia on November 6, 2000 for 'Myflowers (stylized)' in connection with , *inter alia*, retail services through the internet;
- (b) trade mark No.00015584, which is not as yet registered, but which has been approved by the Intellectual Property Corporation of Malaysia, as evidenced by Exhibit B to the Complaint which is a letter from the Corporation dated July 29, 2005. This trade mark is also for 'Myflowers (stylized)' in connection with flowers and plants.

As they are identical and as each of them creates rights in the Complainant, the two trademarks will be referred to in this decision as 'the trademark' except where it is necessary to specify them individually.

The Complainant has also registered three domain names for use in its business, namely <myflowers.com.my>, <myflowers.net> and <myflowers.com.sg>, the third being in the

country code for Singapore. All three domain names resolve to the same website which is the Complainant's website at <[www.myflowers.com.my](http://www.myflowers.com.my)>.

The Respondent is also an on-line retail florist and, like the Complainant, also sells other gifts as well as flowers. Together with Wong Soon Cheong, he registered Mymall Dot Com Enterprise as a business on December 12, 2004.

The Respondent registered the disputed domain name on January 11, 2005. It resolves to the Respondent's website [www.myflower.com.my](http://www.myflower.com.my). The website indicates that the Respondent uses it to conduct his business in Malaysia and Singapore.

## **5. The Parties' Contentions**

### **The Complainant**

The Complainant contends that the registration of the domain name <myflower.com.my> should be transferred from the Respondent to the Complainant. It contends that this should be done because it can make out a case that, within the meaning of the Policy, the domain name is identical to a trade mark or service mark in which the Complainant has rights and also that the domain name has been registered and used by the Respondent in bad faith.

In support of these contentions the Complainant maintains, first, that it is the owner of the trade mark 'Myflowers (stylized)' referred to above and that the domain name <myflower.com.my>. is identical to or confusingly similar to that trademark.

This is said to be so because the spelling of the two words is identical, except for the 'missing 's' ' of the trade mark and because a person using the domain name and finding that it resolves to the website <www.myflower.com.my> would instantly assume that this was the official website of Myflowers, that is to say the official website of the owner of the trademark.

The Complainant also maintains that the domain name has been registered and used in bad faith, for the Respondent's conduct falls squarely within paragraph 6.1(iv) of the Policy. In particular, the Complainant contends that the Respondent registered the domain name to trade on the Complainant's name with the intention of attracting and diverting internet users to the Respondent's own site by creating confusion or deception between the domain name and the trademark.

Moreover, that confusion is exacerbated, it is said, because the Respondent is actually using the domain name for that purpose. The result is that he is in effect diverting internet traffic to his own site which offers identical services to those offered by the Complainant, namely the delivery of flowers and gifts to customers in Malaysia and Singapore.

## **The Respondent**

The Respondent denies that the domain name is identical to or confusingly similar to the trade mark, for the word 'flower' that is contained in both of them is a common word and hence a generic expression. There are many such terms that are used in domain names and no-one can acquire exclusive rights in them. Moreover, the Respondent has lawfully registered the name in a descriptive sense, for it describes its own business, namely the supply of flowers.

The Respondent also denies that he registered and /or used the domain name in bad faith, because he has a legitimate interest in the domain name, within the meaning of Clause 7.2 of the Policy. That is so, he contends because, before he was notified of the dispute, he used the domain name in relation to a genuine offering of goods and services, namely the on-line supply of flowers and gifts and also because he, the Respondent, is known by the domain name.

Moreover, the Respondent denies that he registered or used the domain name with intention to confuse or deceive. Nor could such a confusion or deception occur, because the two websites are entirely different and this would be instantly recognized by visitors to the Respondent's site.

The Respondent also relies on the contention that he had no prior knowledge of the Complainant's trademark. He also contends that the Complainant's allegation that it has lost internet traffic and revenue is a mere assertion, unsupported by any evidence.

In general, the Respondent contends that he should not be unfairly hindered from using the domain name, when the name describes to consumers at large what the Respondent actually does, namely the supply and delivery of flowers.

## **Complainant's Reply**

The Complainant filed a Reply, which it is entitled to do pursuant to Rule 7. In the Reply it contends, first, that the Respondent's argument on whether the domain name is identical or confusingly similar to the trademark is misconceived.

This is so because the Complainant's case is not based on the Respondent's use of the generic word 'flower ', but on its use of the composite word 'myflower', which is neither generic nor descriptive.

Moreover, customers in search of flowers on the internet would not use the word 'myflower' unless they had in mind the Complainant's site. This website has now been usurped by the Respondent as he has registered a domain name closely resembling the trade mark and also the Complainant's domain name, thus diverting traffic to the Respondent's site.

Secondly, the Complainant reasserts that the domain name has been registered and/or used in bad faith. It points to the inadequacies in and the generally unreliable nature of the Respondent's evidence, which in any event shows at least that the Respondent could only have used the domain name in business after and not before he had registered it as a domain name and only shortly before he received a cease and desist letter from the Complainant's solicitors.

The evidence thus falls short of showing a legitimate interest in the registration and/or use of the domain name sufficient to satisfy Clause 7 of the Policy.

## **6. Discussion of the Issues**

Paragraph 17 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted by the parties and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

That being so, the Panel will now proceed to enquire if the Complainant has discharged the onus on it to prove each of the two elements specified in paragraph 5.2 of the Policy.

Those two elements, both of which must be proved, are:

- (i) that the Respondent's domain name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights; and
- (ii) that the domain name has been registered and/or used in bad faith.

The Panel will deal with each of the requirements of the Policy in turn.

### **Identical or confusingly similar**

The Panel finds that the domain name <myflower.com.my> is confusingly similar to the trade mark 'Myflowers (stylized)', details of which are given above.

The Panel makes that finding for the following reasons.

First, the substance of the domain name and the substance of the trademarks are identical, except for the omission in the domain name of the letter 's' that appears in the trade mark, making the former singular and the latter plural.

This is a distinction without a difference and, if it is a difference, it is one of such minor importance as not to negate what is otherwise a confusing similarity between the two expressions.

Clearly, disparities in spelling can defeat a finding of confusing similarity in appropriate cases, for the difference in spelling can be so great that the reader is virtually looking at two entirely different words. The test, however, to determine whether this has occurred is

to look at the two words in question from the standpoint of an objective bystander to see if the essential substance of the trademark has been carried over into the domain name or not.

Thus, in *Sydney Airport Corporation Limited v. John Crilly*, WIPO Case Number D2005-0989, 22-Nov-2005 the panel, as presently constituted, found that no substantial change had been made when the domain name registrant had added an 's' to the trademark Sydney Airport and registered the domain name <sydneyairports.com>, making the airports plural rather than singular and that the element of confusing similarity had therefore been made out. The panel was able to say:

' The Panel finds that the domain name <sydneyairports.com> is confusingly similar to the Complainant's registered trademark number 782285 in the name 'Sydney Airport'. That is so because, first, the substance of the domain name and the substance of the trademark are the same. It is true that the trademark has had the letter 's' added to it to convert the singular 'Sydney Airport' into the plural 'sydneyairports', but the substance of the words remains the same and it has long been held that minor additions of this sort cannot detract from what is an otherwise confusingly similarity.'

The present case is the same, for instead of an 's' being added, it has simply been dropped, but the substance of the words remains the same ; a minor omission of this sort cannot detract from what is an otherwise confusing similarity.

Similar conclusions to this have been reached in many UDRP<sup>1</sup> decisions, although they are not binding precedents. Examples of those decisions are *Busy Body, Inc. v. Fitness Outlet Inc.*, WIPO Case No. D2000-0127, *InfoSpace.com, Inc. v. Registrar Administrator Lew Blanck*, WIPO Case No. D2000-0069 and *Scholastic Inc. v. 366 Publications*, WIPO Case No. D2000-1627 and *Scholastic Inc. v. Applied, Software Solutions, Inc.* WIPO Case No. D2000-1629.

Perhaps the most apposite of the decisions is *The Sportsman's Guide Inc. v. Modern Limited, Cayman Islands*, WIPO Case No.2003-0305, where the trademark was THE SPORTSMAN'S GUIDE. The respondent had registered a domain name, dropping the apostrophe 's' and changing the 'a' from the trade mark to an 'e' to create <sportsmenguide.com>. The panel found that these minor spelling alterations '...do not render the domain name totally distinctive from the Complainant's trademark...', a conclusion equally applicable in the present case.

That type of comparison leads to the conclusion that the domain name is confusingly similar to the trade mark. The Respondent's argument, however, goes further, for he maintains that there can be no confusing similarity between the domain name and the trademark, when he has chosen for the domain name a generic and descriptive word, 'flower'.

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<sup>1</sup> Uniform Dispute Resolution Policy administered by the Internet Corporation for Assigned Names and Numbers (ICANN) with respect to global Top Level Domains.

That argument, however, is misconceived, for the domain name is not simply the word 'flower'. The Complainant's case is not that the Respondent has purloined the word 'flower', which is of course generic by itself, but that he has used the combined word 'myflower', just as the 'Myflowers' of the trade mark is a combined word. The Complainant's argument is not that the Respondent has expropriated a single, generic or descriptive word, but that he took a composite and unique word that is the Complainant's trade mark and that had come to be associated with the Complainant as the sign of its business and that he used the word without permission in his domain name, after making only a minor change to the spelling. The Respondent is therefore making the wrong comparison. When the correct comparison is made, namely between <myflower.com.my> and 'Myflowers', it is instantly seen that there is a close similarity between the two names.

But the Respondent also contends that the entire expression 'myflower' is generic or 'descriptive.' However, the Panel is not persuaded that the word 'myflower' is a generic or descriptive word at all. The fact that two generic words are combined does not necessarily mean that the resulting word is generic and in many cases, such as in the present case, it is not, for example where the creation of the combined word gives it a very specific meaning associated with the Complainant : see for example: *Laerdal Medical Corporation vs. Locks Computer Supply*, WIPO Case No. D2002-0063, where a similar argument was advanced on behalf of the respondent as has been put in the present case. It was argued in that case that the word 'heart' and 'start' were generic words and that as a consequence, the word 'heartstart' and the expression 'heart start' must also be generic and descriptive, in that case descriptive of defibrillators. That argument was rejected on the ground that there was no evidence to support its use in that sense. Indeed, as the panel observed, the fact that the Complainant has a registered trade mark in the expression, '...creates a higher burden for Respondent's evidence of genericness to overcome'. That view is also consistent with the views expressed in other UDRP cases such as *EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, WIPO Case No. D2000-0047 and *Scholastic Inc. v. Applied Software Solutions, Inc.* WIPO Case No. D2000-1629.

It is therefore a matter of evidence whether the word 'myflower', which the Respondent has used as its domain name, is a generic or descriptive word or not. The Respondent has asserted that the word is generic and that it is descriptive of what the Respondent describes as 'the types of businesses it is engaged in, namely the sale of flowers'. But there is no evidence to suggest that the word has come to be so regarded by the public or that it describes any business at all. Indeed, *prima facie*, the word sounds as if it were descriptive of a hobby or a personal pastime rather than a business.

Even if the word were descriptive of the business of the sale of flowers, that creates a greater difficulty for the Respondent. That difficulty is that the word, with the exception of one letter, is the same as the word 'Myflowers', a word over which the Complainant has a trade mark and which has come to have the specific meaning of the Complainant's business of a retail on-line florist. The Complainant has given evidence, in the form of a

Statutory Declaration supported by documents, of the actual use of the word 'Myflowers' in the market place since 1999, in both Malaysia 'and abroad', not as a generic or descriptive word, but as a trade mark and a business name that specifies the Complainant's own business of an online retail florist. Indeed, the Complainant adopted the word in 1999 as the name of the company through which it conducts its business in Malaysia and as its domain name.

Accordingly, the Respondent chose as his domain name a word that is probably not generic or descriptive and a word that, in any event, is virtually identical to a specific word with a specific meaning, namely the Complainant's trademark, business and domain name.

It is true, as the Respondent says, that the decision in *Dial-A-Mattress Operating Corporation v. Ultimate Search*, WIPO Case No.D2001-0764 exonerated a respondent who had registered as a domain name <matress.com>, a word that the panel described as a '...a variation of a common descriptive term', namely mattress. The respondent was exonerated because the Complainant was '... attempting to prevent use of a variation of a common descriptive term.' In the present case, however, the Respondent has not used 'flower' as the domain name, but 'myflower'; the domain name thus created is not 'a common descriptive term', but a combination of two words to create an unusual word which has come, at least in Malaysia and Singapore, to describe the Complainant's business. It is that name which the Respondent has taken and to which he has made a minor spelling alteration to create 'myflower'.

This simply underlines the notion that the domain name is similar to the trademark and confusingly so.

The Panel also accepts the Complainant's additional argument, which is in effect that this case goes further than confusion that has occurred because of a mere similarity between two names. As the Panel has already concluded, the Respondent chose a domain name which, with the difference of one letter, was the Complainant's trademark, its company name in Malaysia, its domain name and a name that had come to be associated with the Complainant's business and which it had publicly used and promoted in the region since 1999.

These facts call for an explanation from the Respondent as to how this happened and why, of all the names that he could have chosen, he chose <myflower.com.my>. No such explanation has been given and this is a fatal omission from the Respondent's case.

In the absence of such an explanation, the Panel is entitled to draw the inference that when the Respondent decided to set up business as an on-line florist, he was influenced by the fact that there was already a well-established firm in the same line of business in Malaysia, namely the Complainant and that he chose the domain name <myflower.com.my> for the reason that it was virtually the Complainant's trade mark, business name and domain name and that he hoped to trade off the cachet that came with it.



Accordingly, the Panel concludes that the choice of domain name, being a name that was similar to the Complainant's trade mark, was deliberately made and that the real reason for the confusing similarity between the domain name and the trade mark was because the Respondent wanted to bring about that result. This adds to the conclusion that the domain name is not only similar to the trade mark but confusingly so.

Finally, the presence of the generic Top Level Domain suffix '.com' in the domain name and which of course is not in the trademark, does not mean that the domain name is any the less confusingly similar to the trademark. Such extensions and other minor additions or omissions such as accents are always disregarded for the purpose of making this comparison; see *Société des Hôtels Méridien v. ABC-Consulting*, WIPO Case No. D2004-0792 and *Supre Pty Ltd v. Paul King*, WIPO Case No. DAU2004-0006. Likewise, the stylized depiction of the word 'Myflowers' in each trade mark is disregarded in making the comparison, for such graphics cannot be translated into a domain name and the word is taken as being expressed in the normal style.

Accordingly, the Panel finds that the domain name at issue is confusingly similar to the two trade marks specified above, in which the Complainant has rights as their owner.

The Complainant has therefore made out the first of the two elements that it must establish under paragraph 5.2 of the Policy.

### **Rights and Legitimate interests**

Paragraph 7 of the Policy provides in effect that to rebut the allegation that a domain name was registered and has been used in bad faith, a respondent may prove that the registration and/or use was not in bad faith because the respondent has rights and legitimate interests in the domain name.

As the Respondent in the present proceedings has sought to bring himself within that provision, it is necessary to see if he can do so successfully, before dealing with the wider issue of bad faith.

The Respondent specifically relies on paragraph 7.2 of the Policy. That paragraph provides that evidence of rights and legitimate interests in the domain name may include the following:

- (i) before the date of (the respondent's) being informed of the complainant's dispute, (the respondent) had used or made preparations to use the domain name in relation to a genuine offering of goods or services;
- (ii) the respondent is commonly known by the domain name;

- (iii) (the respondent) is using the domain name for legitimate, non-commercial and/or fair purposes and has no intention of using it for profits or to deceive the public.

The Respondent relies on the first two of those provisions.

### **A genuine offering of goods and services**

With respect to the first of the provisions, the Respondent contends he was 'actively' making a genuine offering of goods and services, namely as an online supplier of flowers and gifts, 'in 2004'. The certificate of his registration as a business, which is Exhibit B to the Response shows that the registration occurred on December 28, 2004. However, that is not evidence of when the Respondent started the business in question. Businesses have records and it is easy to produce them and establish when a business commenced actual operations as a matter of fact. That being so and there being a complete absence of evidence to support the proposition that the Respondent was 'actively' making a genuine offering of goods and services 'in 2004', the Panel does not accept that this was so.

Even if it were so, it is not the point at issue. Paragraph 7.2(i) of the Policy requires that the domain name itself or a name corresponding to it was used for the offering of goods or services.

The domain name was registered on January 11, 2005 and it is therefore impossible that it could have been used in business prior to that date.

The Panel, therefore, does not accept that the Respondent was using the domain name in business in 2004.

Nor is there any evidence that the domain name, or a name corresponding to it, was used in relation to a genuine offering of goods or services before the cease and desist letter was sent by the Complainant's solicitors to the Respondent by facsimile on October 10, 2005.

It is true that the Respondent produced as Exhibit C to his Response, a document said to be a print-out of his remittance statement, although the name 'myflower' does not appear anywhere on the statement. It shows, at best, that Mymall Dot Com Enterprise's earliest receipt of money was on August 15, 2005.

It is therefore a matter for the Panel to decide if the totality of this evidence is sufficient to justify the conclusion that the Respondent used the domain name for a genuine offering of goods and services before it was informed of the Complainant's dispute. It has often been said that UDRP proceedings are inadequate to resolve such fine issues of fact in the absence of discovery and a hearing where witnesses can be tested. Any UDRP panel is therefore left to decide the proceedings on its general impression of the evidence that has been presented to it and by following the principle that it must be satisfied about an issue on the balance of probabilities.

Applying that test in the present case, the Panel is not satisfied that the evidence shows that the Respondent used the domain name in relation to a genuine offering of goods or services before it had notice of the dispute. This is because (a) the Respondent's assertion that he was 'actively' doing so 'in 2004' is clearly wrong and is rejected, (b) the rejection of that claim colours the value of the Respondent's other evidence; (c) the Respondent must have received notice of the dispute on October 10, 2005 when it was faxed to him and not 'in November' as he claims and, most importantly, (d) if the offering of goods were genuine and regular, there would be the usual business records in the nature of order forms and suchlike to show it and those records could have been produced.

In addition to all of this, it must be remembered that the defence that is given to respondents in paragraph 7.2 (i) of the Policy is to cover cases where, as a matter of substance and reality, the respondent was in business under the domain name or a name corresponding to it and in circumstances where, having regard to the duration of the business, its operation and how it came about that the particular domain name was chosen, it can fairly be regarded as 'genuine' and not as a recent invention. As the substance of the Panel's decision in this case is that the Respondent probably knew of the Complainant's name, trade mark and domain names when he registered the contentious domain name, it is unable to say that the defence provided in paragraph 7.2(i) of the Policy has been made out by the Respondent.

The significance of the use of the word 'genuine' in paragraph 7.2(i) of the Policy is seen by the significance of the expression '*bona fide*' in paragraph 4 of the ICANN Policy and the manner in which UDRP panels have interpreted the provision. For example, in one of the more recent decisions, *Pet Food Experts, Inc v. R. Ryner*, WIPO Case No. D2005-0536, the panel re-iterated the longstanding view of UDRP panels view by saying:

'Respondent contends that it has a legitimate interest in the Domain Name because it adopted the name without knowledge of Complainant and has used the Domain Name for a *bona fide* offering of goods for two years prior to any objection by Complainant.

A similar situation was addressed in *American Eyewear, Inc. v. Thralow, Inc.*, [WIPO Case No. D2001-0991](#) (2001), which states:...

"Although use in connection with the sale of goods or services is apparent, our inquiry must go further since not all such use qualifies as *bona fide* use. "To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy." *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847.'

The Panel is not bound by those views, but it independently holds the same view. In other words, the word 'genuine' would not have been used in the Policy unless it was meant to require something more than a mere offering of goods or services.

Some of the significant factors in determining if a respondent is *bona fide* or genuine, or not, are whether there is a legitimate explanation for the choice of the domain name, a reasonable period of use before the dispute arose and the lack of any intention to infringe the trademark. In the present case, the Respondent probably had knowledge of the trade mark before starting its business and before registering the domain name, has given no explanation for choosing the particular domain name, had used the domain name for a very short period of time before the dispute arose, had used it to solicit business in a major market area of the Complainant, namely Malaysia and Singapore and has been doing so by using the Complainant's trade mark, business and domain names with only one minor spelling alteration. It is because of those factors that the Panel concludes that, even if there were an offering of goods and services by the Respondent before October 10, 2005, it was not a genuine one.

In the course of his submissions the Respondent cited several UDRP decisions where complaints were denied on the ground that before notice of the dispute, the respondent had used the domain name for a genuine offering of goods and services. The Respondent uses those cases to argue that in the present case it also used the domain name for a genuine offering of goods.

Those cases are of course interesting illustrations of the issue involved, but they highlight why in the present case the Respondent cannot succeed. For example in *Bear Sterns Companies Inc v. Pacific Residential*, WIPO Case No.D2004-0314, in contrast to the present case, the evidence was that there had actually been a *bona fide* offering of services, whereas in the present case the Panel does not accept that the offering was genuine. In *Credit Management Solutions, Inc. v. Collex Resource Management*, WIPO Case No.D2000-0029, the complaint was denied because the respondent was using the domain name not in the same sense as it was used in the trade mark, but in an entirely different field and directed to different people. In the present case, the Respondent has been using the domain name as a retail, on-line florist, which is the same use as the Complainant makes of its trade mark and he has also been using it to engage in competition for the Complainant's potential customers.

Similarly, in *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp*, WIPO Case No. D2001- 0031, the successful respondent had been using the domain name for a legitimate business, not in the trade mark sense but a different sense, which was also the situation in *Ledtronic, Inc., v. Ledtronic v. Sdn Bhd*, Case No: rca/dndr/2004/05. In contrast, in the present proceedings, the Respondent's business that he is promoting with the domain name is substantially the same as the Complainant's business, the domain name is being used in the same field, it is being used in a trade mark sense to describe the goods being sold by the Respondent and it is being used to solicit business in a major part of the Complainant's market, namely Malaysia and Singapore.

Accordingly, as a matter of evidence, the Panel is not persuaded on the balance of probabilities that the Respondent, in any real sense, used the domain name for a genuine offering of goods.

### **Known by the domain name**

With respect to the second of the provisions, i.e. that the Respondent was known by the domain name, he cannot succeed, for his own evidence proves, if anything, the opposite of the requirement. It must be shown under paragraph 7.2 (ii) that the respondent is 'commonly known by the Domain Name'. The Respondent registered himself in business not as 'myflower.com.my', but as Mymall Dot Com Enterprise; his order forms and invoice/receipts were made out in that name; direct payments were made to it and the remittance statements show payments to have been made to it. The best that the Respondent can do is to say that he is 'also' known by the domain name 'for all intents and purposes'. That is not what the Policy requires and the evidence falls far short of proving the requirement.

Moreover, the Policy is clearly intended to cover legitimate cases where a registrant is reflecting his or her own name in a domain name. The Respondent is outside the intention of the Policy and in any event has shown no facts to bring himself within it.

This case is therefore entirely different from the *Ledtronics Case* relied on by the Respondent. In that case, the domain name was <ledtronics.com.my> and the Respondent's name was Ledtronics Sdn Bhd, so it was clear that the respondent was known by the domain name for the two names were the same. In the present case, the domain name is <myflower.com.my> and the Respondent, according to its own documents, is not 'myflower', but Chan Hong Mun T/A Mymall Dot Com Enterprise or alternatively, according to the MYNIC 'whois search', Mymall Dot Com Enterprise.

Accordingly, it cannot be said that the Respondent has brought himself within either paragraph 7.2 (i) or (ii) of the Policy to establish that he has rights and legitimate interests in the domain name.

### **Bad faith**

As to the second element that must be proved by a complainant under the Policy, bad faith, the Complainant has based its case on paragraph 6.1(iv) of the Policy. Thus, it argues that the Respondent has registered and used the domain name for the purposes of and also with the intention of attracting and diverting internet users to his website. It argues further that within the meaning of paragraph 6.1(iv), this has been done by creating a possibility of confusion or deception that the Respondent's website is operated by the Complainant, is authorised by it or is in some other way connected with it, due to the close similarity between the domain name on the one hand and the Complainant's trade mark and domain names on the other.

As it is also an essential element to be proved, the Complainant says that the Respondent has engaged in these activities for commercial gain.

The Panel accepts these arguments and finds that within the meaning of paragraph 6.1(iv) the Respondent both registered and is using the domain name in bad faith. That is so because in the opinion of the Panel, the Respondent registered and used the domain name to attract internet users to its website <www.myflower.com.my> by creating the possibility of confusion that the website was connected with the Complainant and the Complainant's trade mark. The Panel also finds that the Respondent did this for commercial gain.

The Panel has come to those conclusions for the following reasons.

First, the domain name chosen by the Respondent is virtually identical to the Complainant's trademark. This instantly raises the question as to how this occurred.

As the Panel has already noted, it is a fatal omission from the Respondent's proof that he nowhere gives a plausible explanation, or any explanation at all, as to why he chose the name 'myflower' for his domain name.

The necessity for giving such an explanation, especially in proceedings that the Respondent knows are contested and where he must be presumed to know that the issue is a significant one, is self-explanatory. Its importance has been commented on in UDRP decisions such as *Cassava Enterprises Limited, Cassava Enterprises (Gibraltar) Limited v. Victor Chandler International Limited*, WIPO Case No. D2004-0753. Panels dealing with these matters may also draw inferences where appropriate, including inferences from the fact that evidence on a specific issue has not been given.

In the absence of any explanation as to why the Respondent chose the name 'myflower' for the domain name, the Panel is left with having to decide whether it is simply a coincidence that the Respondent chose a name with an uncanny resemblance to the Complainant's trademark, which the Complainant had embodied in its Malaysian company name and its website and used publicly in its business promotions or whether, alternatively, the choice of that name was made by the Respondent intentionally, to invoke or bring to the mind of consumers the Complainant's name and then to trade on it for commercial gain.

The Panel can only decide such matters on the balance of probabilities and on the material put before it.

The Panel concludes that the latter is by far the more probable explanation, for the following reasons.

The Complainant had been in business under its current name for five years before the domain name was registered by the Respondent, its business was in the same geographical location as the Respondent, the Complainant had been actively promoting itself in the commercial community in that region and in the community at large by advertising and its business was in an industry that depended on public recognition of its name. It is therefore more probable than not that the Respondent knew of the existence of

the Complainant, its name and general activities, just as the public at large clearly knew of the Complainant by reason of their taking part in the Complainant's promotions.

Ample evidence of these facts is to be found in the Statutory Declaration of Pua Kiam Wee prepared at the time of the application for the trade mark and which describes a history of advertising campaigns and tie-ups, joint promotions with Royal Selangor, an advertisement and a press article in The Straits Times and a promotion with Malayan Banking Berhad where the trademark appeared on leaflets sent to the Bank's credit card holders. The events received some hundreds of entries from the public. These activities cover the period from 1999 until December 13, 2001 when the Statutory Declaration was made and the continuation of the Complainant's business since then and until the present day can only have cemented the presence of the Complainant in the public mind in Malaysia and Singapore.

As these activities were clearly known to the public at large, it is more probable than not that they were also known to the Respondent at the time the domain name was registered and since then.

Such activities must confirm the probability that the domain name was chosen at least in part because it had come to be associated in the public mind in Malaysia and Singapore with the Complainant's business and as carrying a cachet of some value in the retail florist trade and the community in general.

As part of this significant omission from the evidence of the Respondent as to why he chose the domain name <myflower.com.my>, there is the additional factor that the Respondent could have chosen any number of other names for the domain name and hence for the business. It did not do so and the Panel is therefore left to draw its own conclusion as to why the Respondent ignored all other conceivable names, but chose the Complainant's trade mark, business name and domain name, omitting only one letter of that name.

### **Layout of the two websites**

Secondly, the layout and the content of the Respondent's website make it more probable than not that when in registering the domain name and subsequently in using it and the website based on it, the Respondent was invoking the name and concept of the Complainant and its website. The two are, of course, not identical and it could not be suggested that the Respondent's website is a complete copy of the Complainant's website. However, the general tone of the two, their contents and way in which the merchandise is described, are so similar that it is more probable than not that when the Respondent started business it had regard to the Complainant's website and has been influenced by it to the extent that consumers might well think it is the Complainant's site.

Here in a tabular form are some of the features of the home pages of the websites of the Complainant and the Respondent, taken from Exhibits C and G to the Complaint and

reflecting their contents on November 2, 18 and 21, 2005 in the case of the Complainant and October 10 and 11, 2005 in the case of the Respondent <sup>2</sup>.

www.myflowers.com.my	www.myflower.com.my
Number of illustrated flowers in and around the word 'myflowers': 3	Number of illustrated flowers in and around the word 'myflower': 3
Flowers used in text: 17	Flowers used in text: 7
Products offered and described as:	Products offered and described as:
E-flowers	flowers
All occasions	occasions/festives
Hand bouquets	flower bouquets
Flower arrangements	beautiful and exquisite designs
Gifts of health	-
Flowers and gifts	flowers/fruits/gifts
Congratulations	Congratulations
New born	New born Baby / Baby Gifts
Cakes	-
Sympathy	friends and loved ones/condolences
Gift Shop	fruits/gifts
Teddy bears	(teddy bear illustrated)
-	Crystal Collection
-	Win Roses

The sites are of course not identical but they appear very similar. The Respondent's allegation that the layout of his website is 'completely different' from that of the Complainant and that there is 'no visual similarity' between the two sites 'at all' is demonstratively untrue, as is seen from the above. So also is his contention that '...there is no possibility of any confusion or deception...' between the two websites, for in the opinion of the Panel, there was and is a high probability of confusion.

The Panel's conclusion is accordingly that there is such a degree of similarity between the two websites that a visitor, having used the address [www.myflower.com.my](http://www.myflower.com.my) by accident or design, would more probably than not conclude that the website was the website of the Complainant or at least connected with it.

Indeed, the Respondent appears to have encouraged that belief not only by the name and the layout of the site, but by using the plural expression Flowers Malaysia at least four times on the first page of the website, as in Flowers Malaysia and Send Flowers

<sup>2</sup> The Respondent, in Exhibit E to the Response, attached the first page only of each of the home pages as they were on December 15, 2005 and those pages appear to be substantially the same as they were on the dates reflected in the Complainant's exhibits.



Malaysia. In other words, such frequent use of the plural form would reinforce the belief that the visitor had arrived at the website of the Complainant, <www.myflowers.com.my>.

This comparison of the two websites, in addition to the other matters discussed, leads the Panel to the conclusion that the Respondent registered and has been using the domain name to attract internet users to his website by creating at least the possibility of confusion that his site is connected with the Complainant and its trade mark.

Such conduct has frequently been regarded in decisions in this field as bad faith. The decision in *The Sportsman's Guide Inc. v. Modern Limited, Cayman Islands (supra)* is one such example. As has been noted, in that case the respondent had registered the domain name <sportsmenguide.com> in a clear attempt to trade on the Complainant's trade mark THE SPORTSMAN'S GUIDE. Its conduct in offering links to websites, '...some of them for products similar with those of the Complainant' was held to constitute bad faith. In the present case, the Respondent has gone further, after making its own minor spelling adjustment, by offering virtually the same products as the Complainant and virtually under the Complainant's trading name. This clearly constitutes both registration and use in bad faith, although only one of those criteria need be established.

The Complainant has therefore made out the second element that it must establish under paragraph 5.2 of the Policy.

**Conclusion**

As the case has been made out, the only question remaining is the appropriate remedy.

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

.....  
The Honourable Neil Anthony Brown QC  
Sole Panelist

Date: February 13, 2006