In the Matter of Domain Name Dispute

Between

Sime Darby Berhad ... **Complainant**

And

e Web Solutions ... **Respondent**

Case No. rca/dndr/2007/10

ADMINISTRATIVE PANEL DECISION

Submitted by:

T. KUHANANDAN

[SINGLE PANELIST]

MESSRS BADRI KUHAN YEOH & GHANDI

Advocates & Solicitors

Intellectual Property (IP), IT, Corporate & Commercial Attorneys

Suite 44-2, Bgn TK & G Chambers

No. 44, Jalan Kemuja, Bangsar Utama

59000 Kuala Lumpur

Tel No. 03-22834145 / Fax No. 03-22835284

Email: bkyg@bkyg.com / website: www.bkyg.com

REGIONAL CENTRE
FOR ARBITRATION KUALA LUMPUR

ADMINISTRATIVE PANEL DECISION

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1. The Parties

The Complainant is **Sime Darby Berhad (Company No. 47159-M)**

The Respondent is **e Web Solutions**

2. The Domain Name and Registration

Domain Name : **simedarby.com.my**
Registrar : Malaysian Network Information Centre (MYNIC)

3. Procedural History

(i) A complaint was lodged by the Complainant on May 18, 2007, which was acknowledged receipt by Kuala Lumpur Regional Centre for Arbitration (KLRCA) on May 21, 2007.

(ii) The Kuala Lumpur Regional Centre for Arbitration (KLRCA) had vide letter of May 23, 2007 commenced proceedings and had requested the Respondent to respond on or before June 13, 2007.

(iii) The complaint was also sent by email to the Respondent e Web Solutions and at HostRelax.com.HostRelax on May 22, 2007.

4. Factual Background

The domain name in issue "**simedarby.com.my**" (hereinafter referred as "disputed domain name") was created (registered) with MYNIC on August 17, 2006 vide Registration No. D1A067867 by the Respondent as evidenced by "Annex-2" and will be expired on August 17, 2007.

A search at the Companies Commission of Malaysia, both at the Registrar of Companies and Registrar of Business yielded no information on the Complainant.

The Complainant consists of subsidiaries. Majority of the Complainant's subsidiaries would either use the trade/service mark "SIME DARBY" and/or the word "SIME" as a house mark denoting that the goods and services originate from the Complainant and/or its subsidiaries alongside their own trade and service marks.

The Complainant claimed that their subsidiaries are known to the public and members of the trade as being part of the "Sime Darby Group". Copies of letterheads of some of the Complainant's subsidiaries showing the use of the Complainant's trade/service mark as evidenced by "ANNEX-4".

The Complainant in their complaint stated that they have the exclusive right to use the registered trade/services marks and they are and were either through its subsidiaries or on its own, at all material times the registered proprietor of the trade and service marks, inter alia "SIME DARBY", "SIME DARBY & Device", "SIME TYRES" and/or "SIMENET" in Malaysia and several other countries. As evidenced by "ANNEX-3".

The Complainant in their complaint also stated that though the use of the trade/service mark "SIME DARBY" to distinguish goods/services of the Complainant from other traders, the Complainant and/or its subsidiaries has established goodwill and reputation and they have achieved good group profit as shown in their Annual Report 2006. As evidenced by "ANNEX-9", "ANNEX-10" and "ANNEX-11".

The Complainant is also registered proprietor of the domain name "simedarby.com" as evidence by "ANNEX-5".

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

5.1 The Complainant contends that:-

(i) The Complainant has the exclusive right to use the trademark "SIMEDARBY" in relation to the goods/services it is registered in the countries where registrations are obtained.

(ii) The disputed domain name incorporates the used of the words and/or the name of "SIME DARBY" and is identical or confusingly similar to the Complainant's trade name, trader/services marks in which the Complainant has rights.

(iii) The element of bad faith is evidentially present when:-

(a) The Complainant and/or it's subsidiary has registered the mark "SIME DARBY" or mark carries the word "SIME" as a house mark in Malaysia and several other countries as evidenced by "ANNEX-3".

(b) The Complainant is the proprietor of the top level domain name "simdarby.com" as evidenced by "ANNEX-5", will lead the public to assume and be misled that the Disputed Domain Name belongs either to the Complainant or any of the Complainant's subsidiary companies.

(c) As the Respondent has displayed a website with the Disputed Domain Name in replation to travel and car hire related services, the use by the Respondent of the Disputed Domain Name and the display of travel and car hire services can be construed as a calculated move by the Respondent to deceive and mislead the public into a belief that the website bearing the disputed domain name is a website sanctioned by the Complainant and that the Respondent is part of the Complainant's group of companies as the Complainant has

subsidiaries that provide travel, holiday and car rental services. The Complainant's brochure as evidence by "ANNEX-6" and "ANNEX-7".

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

6. Discussion and Findings

On the papers before the Panel, which were annexed together with the relevant evidence to substantiate the Complainant's complaint, the Panel is 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 disputed domain name in bad faith.

The reasons are stated hereinbelow:-

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

The Complainant's trademark submitted for registration in Malaysia and various countries is "SIME DARBY" and the Disputed Domain Name is "**simedarby.com.my**".

The Complainant has also substantiated the registration of the domain name of "simedarby.com" as evidence by "ANNEX-5".

The Disputed Domain Name incorporates the mark "SIME DARBY", with the addition of a gTLD ".com" and ccTLD ".my". It is found in the decision of ***Volkswagen Group Singapore Pte Ltd v Webmotion Design*** **Case No.: rca/dndr/2003/01 (int)**, that the inclusion of a gTLD and ccTLD is immaterial in determining identity or similarity between the trademarks and domain names. The Panel therefore finds that the Disputed Domain Name is identical to the mark "SIME DARBY".

Further, it abundantly clear from the annexure provided by the Complainant that the "simedarby" is associated with the Complainant and therefore the Complainant has rights to the trademark "SIME DARBY" together with the goodwill. The Respondent's registered domain name of the same mark is identical and confusingly similar to the Complainant's mark "SIME DARBY" and/or "SIME" being used to denote the goods and services originate from the Complainant and/or its subsidiaries.

The Panel further finds there is sufficient likelihood of confusion that leads to known as an "initial interest confusion", where the Internet user when looking for a specific website is led to the domain holder's website through the identity or similarity of the domain name with a third-party's trademark (***Volvo Trademark Holding AB v e-motordealer Ltd***, WIPO Case No D2002-0036 and "***holidayinnhotelreservations.com***" case, WIPO Case No D2003-0222)

In a cyber squatting instance, like the Respondent which the Panel can safely assume, that by registering the Disputed Domain Name containing the word "simedarby.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 infringement or passing off.

The Disputed Domain Name is almost identical and confusingly similar to the Complainant's trademark of "SIME DARBY" and/or "SIME" which are registered in various countries. There is no evidence shown that the mark "SIME DARBY" is registered in Malaysia. However, the Complainant has been representing and the connecting to the mark "SIME DARBY" and/or "SIME" as a corporate name (including the use by its subsidiaries), in their letter heads and brochures. The use of the mark "SIME DARBY" and/or "SIME" is known to the public members of the trade as part of the Complainant.

(ii) <u>The Respondent's registration was done in bad faith</u>

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) The Complainant stated that the Respondent has displayed a website with the Disputed Domain Name in relation to travel and car hire related services which would lead the public into a belief that the website is sanctioned by the Complainant and the Respondent is part of the Complainant's group companies as the Complainant's has subsidiaries that provide travel, holiday and car rental services as evidence by "ANNEX-6" and "ANNEX-7".

(b) Further, the Complainant's mark "SIME DARBY" is a well known mark to the public and members of trade in Malaysia as being part of the Complainant. From the appearance of the domain name does show 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 when it was not so nor the Respondent was licensed to do so.

(c) The Respondent has not provided any evidence of any factual or contemplated good faith use of the Disputed Domain Name.

Hence, the Panel is 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 "**simedarby.com.my**" which will expire in 17 August 2007, to be transferred to the Complainant forthwith.

Dated this July 23, 2007.

T. KUHANANDAN
Single Panelist