

**Administrative Panel Decision
In the matter of**

Between

FlyFirefly Sdn Bhd

And

Nikabina IT MSC Sdn Bhd

Case No: RCA/DNDR/2007/11

1. The Parties

The Claimant is FlyFirefly Sdn Bhd, a company incorporated under the laws of Malaysia, having its principal office and place of business in Subang, Selangor and represented by Wong & Partners, Advocates & Solicitors, Kuala Lumpur, Malaysia.

The Respondent is Nikabina IT MSC Sdn Bhd, a company incorporated under the laws of Malaysia, having its principal office in Kota Bharu, Kelantan and is acting on its own.

2. The Domain Name and Registrar

The domain name is <www.firefly.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 18 May 2007 both through e-mail and hardcopy. The Centre sent an Acknowledgement of Receipt dated 21 May 2007, and thereafter sent a request to MYNIC for verification of the identity of the domain name holder on 18 May 2007. The Centre forwarded the Complaint to the Respondent by courier and email on 29 May 2007.

The Complainant elects to have the Complaint decided by a three-member panel and the Centre has assigned the Complaint to the following Panel:

- (i) Ms. Ambiga Sreenevasan from Messrs. Sreenevasan, Advocates & Solicitors, Kuala Lumpur, Malaysia – the first panelist;
- (ii) Ms. Karen Abraham from Messrs. Shearn Delamore & Co., Advocates & Solicitors, Kuala Lumpur, Malaysia – the second panelist; and

- (iii) Haji Mohd Rasheed Khan bin Mohd Idris from Messrs. Azmi & Associates, Advocates & Solicitors, Kuala Lumpur, Malaysia, the third and the presiding panelist.

Notices of the appointment were sent on 2 July 2007 and the Panel has submitted statements of Declaration of Impartiality and Independence as required by the Centre.

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 22 May 2007.

Preliminary Issue of Interpleader

On 20 June 2007, the Respondent had filed its Response to the Complaint (hereinafter referred to as "the First Response"). Nevertheless, the First Response was provided by Mohammad Aswari bin Japar, who had applied to be made an interpleader in relation to this case. The Respondent signed the Certification under paragraph 5 of the First Response to comply with the Rules of MYDRP {Rule 6.3(vii)} and relied on the statements given by Mohammad Aswari bin Japar as a form of its First Response.

The Centre had on 27 June 2007 received a request for directions from the Complainant whether to respond to the response given by Mohammad Aswari bin Japar, who applied to be an interpleader in this case since the response was not from the Respondent.

The Complainant had also made a request to the Centre to temporarily suspend any reply to the response timeline required until the issue was resolved.

The Centre had via a letter dated 10 July 2007 requested the Panel to decide on the query raised by the Complainant. The Panel then deliberated on the issue as to whether to allow Mohammad Aswari bin Japar to become an interpleader in relation to this Case.

The Panel relied on the MYDRP Rules to decide the issue. Under the MYDRP Rules, the term "Respondent" has been defined as "*the Party (including its duly authorized representative) which has registered a domain name and against which a Complaint is filed by the Complainant*". The Panel notes that there is no provision for an interpleader under the MYDRP Rules.

Further, MYDRP Rule 12.1 requires that "*The Panel must conduct the Proceeding in compliance with the Policy and Rules. The Panel must also make sure that the Parties are treated fairly and that each Party is provided with a fair opportunity to present its case*".

Based on the above, the Panel unanimously agreed to decline the request made by Mohammad Aswari bin Japar for the following reasons:

- (i) Based on the MYDRP Rules, Mohammad Aswari bin Japar cannot be considered as Respondent since the domain name is registered in the name of Nikabina IT MSC Sdn Bhd; and
- (ii) the MYDRP Rules do not provide for any third party proceedings/for an interpleader to be added.

Consequent to the above, the Panel proposed the following, vide its letter to the Centre dated 18 July 2007:

- (a) the Respondent be given another ten (10) working days to amend or submit a new Response. If no new/amended Response is given, the Panel will treat the First Response filed by the Respondent as the Respondent's Response.
- (b) The Complainant be given the normal five (5) working days to submit its Reply after receipt of a new /amended Response from Respondent or if Respondent does not file any new Response, then the Complainant is to submit its Reply after notification by the Centre.

Pursuant to the Panel's decision, the Respondent filed a new Response dated 17 July, 2007 (hereinafter referred to as "the Second Response") and the Complainant filed its Reply to the Respondent's Second Response dated 10 August, 2007. The Second Response and Reply filed by the Respondent and Complainant respectively were forwarded to the Panel on 13 August 2007.

The Panel's decision is therefore based on the Complaint, the Second Response and the Reply which constitutes the complete record of the Proceeding (Rule 10 of the Supplemental Rules to MYNIC's (.my) DOMAIN NAME DISPUTE RESOLUTION POLICY).

Factual Background

The Complainant is a subsidiary company of Malaysian Airlines System Berhad ("MAS"), the leading Malaysian national airline company which has over 20 subsidiary and associate companies. The Complainant conceptualized the use of the mark "FIREFLY" for its services in early January 2007 and the services were officially launched on 17 March 2007.

The Complainant had, on 4 April 2007, filed trade mark applications in Malaysia under Class 39 (air travel services, airline services, aircraft chartering, passenger transport services, air cargo transport services, transport and delivery of goods, tour and cruise arranging services and package holiday services) and Class 43 (booking and reservation services for holidays, tours, hotels, guesthouse, accommodation and provision of food) for the marks "FIREFLY", "FIREFLY and device" and "FIREFLY AIRLINE (in Chinese Characters)".

The trade mark applications are as follows:

- i. TM Application 07005879 – firefly – in class 43;
- ii. TM Application 07005880 – firefly – in class 39;
- iii. TM Application 07005877 – firefly & device – class 43;
- iv. TM Application 07005878 – firefly & device – class 39;
- v. TM Application 07005875 – firefly airline in Chinese characters – class 43; and
- vi. TM Application 07005876 – firefly airline in Chinese characters – class 39.

(Collectively referred to as the FIREFLY marks.)

The Respondent is an IT solution company involved in the telecommunication, E-commerce and software development industry. Lokman Hakimi Bin Ismail (NRIC No. 760413-03-5749”) (“Lokman”) is a director of the Respondent.

A Whois search revealed that the Respondent registered the domain name www.firefly.com.my (“the Disputed Domain Name”) on 31 January 2007.

The Respondent, admitting that the Disputed Domain Name does not belong to it, confirmed that it registered the Disputed Domain Name on behalf/ in the interest of a friend named Mohammad Aswari Bin Japar (NRIC No. 680916-03-5417), the owner of a sole proprietorship known as Interprod Trading (hereinafter referred to as “Interprod”) which was registered on 6 November 1995. Mohammad Aswari Bin Japar, claiming that Interprod has interest in the registration and use of the Disputed Domain Name, has filed a trade mark application in Malaysia under Class 4 (fuel additives) on 2 April 2007 for the mark “FIREFLY A DROP MATTERS and device”.

On 19 March 2007, MAS received a proposal from Globalcomm Network (“Globalcomm”) offering to sell the Disputed Domain Name at RM1,500,000.00 (“First Proposal”). On 9 April 2007, Mohd Shamsuddin Taib (NRIC No. 761228-03-5397) (“Shamsuddin”), a sole proprietor of Globalcomm, made a second proposal to MAS offering to sell the Disputed Domain Name at a reduced price of RM500,000.00.

4. Parties’ Contentions

The Complainant contends that the Respondent has registered the Disputed Domain Name in bad faith for the purpose of commercial gain. Firstly, based on a Malaysian Companies Commission search report, the Respondent is a dormant company. Secondly, the Respondent does not have any right or legitimate interest in the Disputed Domain Name as the name “FIREFLY” has no connection whatsoever with the Respondent’s registered business and/or products and thirdly, the Respondent has no intention to carry out any real business using the website hosted under the Disputed Domain Name. The Complainant further contends that the Respondent has misused the registration of the Disputed Domain Name, which the Complainant believes is based on leaks of information from insiders in relation to the Complainant’s launching of its community (no frills) airline services using the name/mark “FIREFLY”.

The Respondent in its Second Response admits that the Disputed Domain Name does not belong to it and further confirmed that it registered the Disputed Domain Name on behalf/ in the interest of Mohammad Aswari bin Japar, the owner of a sole proprietorship, Interprod. The Respondent further states that Interprod is a manufacturing company that formulates and produces its own fuel additives bearing the brand name FireFly, and that it started to test market its additives in September 2005. It also states that some product tests were conducted under the said brand name as early as June 2005. It further states that the website www.firefly.com.my was set up to sell Mohammad Aswari bin Japar's fuel additives, selling auto spare parts and lubricant products.

In its Reply, the Complainant states that through its solicitors, Messrs Wong & Partners, it had engaged the services of a firm of private investigators to conduct an investigation on the nature and business activities of Globalcomm Network, the Respondent and the FIREFLY fuel additives business alleged in the website www.firefly.com.my.

Investigations by the said firm of private investigators commenced from 12th to 23rd April 2007 with visits to Globalcomm Network and the Respondent confirmed that none of these entities sold any FIREFLY additives. The investigators then attempted to make an online purchase of the alleged FIREFLY fuel additives advertised on the said website. Emails were sent by the investigators to the stated location set out in the website on 17th and 19th April 2007. According to the Complainant, no response was received by the investigators. On 20th April 2007, the page for online orders was removed from the website by the Respondent.

The Complainant prays that the Disputed Domain Name be transferred to the Complainant.

5. Discussion and Findings

Rule 17 of the MYDRP Rules 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 principles 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. It suffices for the Complainant to prove either one by virtue of the word 'and/or' in paragraph 5(ii) hereof above.

Identical or confusingly similar

The Panel finds that the Disputed Domain Name www.firefly.com.my incorporates the Complainant's mark "Firely", registration of which has been applied for by the Complainant with the Malaysian Intellectual Property Office on 4th April 2007, with the addition of a cctld ".my". The Panelists have no difficulty in finding that the Disputed Domain Name is identical to the Complainant's trade mark.

Rights and legitimate interests

According to Paragraph 7 of the Policy, the Respondent may prove its right and legitimate interest in the Disputed Domain Name by substantiating with 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 it has acquired no trade mark or service mark rights in the same name; or
- (iii) the Respondent is using the Domain Name for legitimate, non commercial and/or fair purposes and has no intention of using the same for profits or to deceive the public.

Before analyzing the above, the Panel is of the view that it is important to decide in the first place whether the Respondent has the right to register the domain name www.firefly.com.my or not.

According to the MYNIC Whois Service Report, the Respondent is listed as the registrant of the domain name www.firefly.com.my. Under the Registration Agreement entered into between the Respondent with the Malaysian Network Information Centre ("the Agreement"), the term "Registrant" is defined as the person who has applied for the registration of a domain name. The Respondent has made representations and warranties (via Clause 3 of the Agreement), inter alia, as follows:

- (i) the Respondent is the "person who qualifies to register the domain name"; and
- (ii) all the information in the application form submitted by the Respondent in registering the domain name www.firefly.com.my is complete, correct and accurate.

Further, Clause 5.4 of the Agreement empowers MYNIC to suspend or delete the domain name and terminate the Agreement in a case where the information supplied or provided to it is incomplete, incorrect or inaccurate.

The Respondent in its Second Response admitted that the Disputed Domain Name www.firefly.com.my does not belong to the Respondent but it belongs to the Respondent's friend, one Encik Aswari Japar, i.e. Mohammad Aswari bin Japar, who requested the Respondent to purchase the domain name www.firefly.com.my on behalf of his company, InterProd. Based on this admission, the Panel is of the view that the Respondent is not a qualified person to register the domain name www.firefly.com.my as such domain name does not belong to the Respondent. Further, there is a misrepresentation made by the Respondent in submitting the application to register the domain name www.firefly.com.my and thus the registration of the domain name www.firefly.com.my can be deleted by MYNIC.

The Respondent in its Second Response argues that it has applied for the registration of the Disputed Domain Name www.firefly.com.my on behalf of InterProd. The Respondent further contends that InterProd is a manufacturing company that formulates and produces its own fuel additives brand named "Firefly" and has started to test market its additives in September 2005. Despite the above, the Panel is of the view that the aforesaid facts are irrelevant to the present case as it does not assist to justify the Respondent's alleged right to the Disputed Domain Name.

Having perused the documents filed by the Respondent, the Panel is of the view that the Respondent has failed to prove item (i) in relation to Paragraph 7 of the Policy i.e. the respondent had used or made preparations to use the domain name www.firefly.com.my in relation to a genuine offering of goods or services. The Respondent in its Responses has clearly stated that the website www.firefly.com.my is used to sell Encik Aswari Japar's fuel additives, auto spare parts and lubricants products and not that of the Respondent's goods or services. The Panel construes this statement as an admission by the Respondent that it has no intention to use the Domain Name www.firefly.com.my. Further, the Panel notes that the Domain Name www.firefly.com.my has never been used to promote services provided by the Respondent.

In relation to item (ii) to Paragraph 7 of the Policy, the Panel notes that the Respondent is an Information Technology solution company known as Nikabina IT MSC Sdn Bhd. The Respondent does not incorporate the word "FIREFLY" in its name and none of the goods or services sold or provided by the Respondent uses the name "Firefly". As such, it is clear that the Respondent is not known to the public as "Firefly".

With regard to item (iii) above, the Panel is of the view that the Respondent does not have any right or legitimate interest in the Disputed Domain Name as the name "FIREFLY" has no connection with the Respondent's business.

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 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.

In relation to item (i) above, based on the Complaint filed by the Complainant, the Panel notes that two days after the official launch of the "FIREFLY" airline service, Malaysian Airlines System Berhad ("MAS"), the holding company of the Complainant received an unsolicited offer from Mohd Shamsuddin Taib of Globalcomm Network to sell the domain name www.firefly.com.my to MAS for RM1,500,000.00 and a second unsolicited offer for a reduced sum of RM500,000.00, which is far in excess of the Respondent's costs incurred in relation to the registration of the Disputed Domain Name, evidencing bad faith, if not in the registration then certainly in the use of the Disputed Domain Name. At the time when the first offer was made, the website was stated to be under construction. The offer for sale is clearly a use of the Disputed Domain Name "mainly to sell.... the Domain Name for profit" [See Clause 6.1(i) of the Policy]. In view of the Respondent's connection with Globalcomm Network, as asserted by the Complainant and not denied by the Respondent, this bad faith can be attributed to the Respondent.

With regard to item (ii) above, since the Respondent does not carry on any business using the "Firefly" mark, the Panel has no difficulty in imputing that the act of the Respondent in registering the domain name www.firefly.com.my amounts to an act of preventing the Complainant, the trade mark owner of the "Firefly" mark from using the Domain Name

incorporating its trade mark. The Panel is of the view that there is no doubt that with the registration of the Domain Name www.firefly.com.my by the Respondent, the Respondent has prevented the Complainant from using such Domain Name for its business.

The Panel is of the view that the Panel need not deal with paragraph (iii) and (iv) above, as evidence of paragraphs (i) and (ii) provide sufficient basis for a finding that there is a registration in bad faith by the Respondent.

Conclusion.

In accordance with the findings under paragraphs 5, 6 and 7 of the Policy and Rule 17 of the Rules, the Panel directs that the Domain Name www.firefly.com.my be transferred to the Complainant.

Dated 6th September 2007.

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Haji Mohd Rasheed Khan bin Mohd Idris
Presiding Panelist

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Ms Ambiga Sreenevasan
Panelist

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Ms Karen Abraham
Panelist