

**Administrative Panel Decision
In the matter of**

Between

Budget Rent A Car System Inc
[Complainant]

And

Budget-Rent-A-Car Sdn Bhd
[Respondent]

Case No. rca/dndr/2008/15

1. The Parties

The Complainant is Budget Rent A Car System, Inc, a Delaware corporation incorporated in the United States of America in 1958 with its principal place of business at in New Jersey. The Complainant is a subsidiary of Avis Budget Group, Inc.

The Respondent, Budget Rent-A-Car Sdn Bhd is a company incorporated under the laws of Malaysia, having a registered office at 35-36, Pengkalan Weld, Penang 10300, Malaysia.

2. The Domain Name and Registrar

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

The Registrar is MYNIC Berhad (MYNIC).

3. Procedural History

The Complainant filed its Complaint with the Regional Centre for Arbitration Kuala Lumpur ("the Centre") on 24 April 2008 both through e-mail and hardcopy. The Centre sent an Acknowledgement of Receipt dated 24 April 2008 and thereafter sent a request to MYNIC for verification of the identity of the domain name holder on 29 April 2008. The Centre forwarded the Complaint to the Respondent by courier and email on 29 April 2008.

An examination of this material confirms that all technical requirements for the initiation of this proceeding have been satisfied. 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 proceedings formally commenced on 29 April 2008.

The Respondent did not submit any response or request for any additional time as provided by the Rules.

The Complainant elected Wong Jin Nee as its choice of panellist. The Panel has submitted a statement of Declaration of Impartiality and Independence as required by the Centre.

4. Factual Background

The Complainant is Budget Rent A Car System, Inc, a Delaware corporation incorporated in the United States of America in 1958 with its principal place of business at in New Jersey.

The Complainant offers vehicle rental services and other related services worldwide. The Complainant is a franchisor of a system of business for the promotion and assistance of independently owned and operated vehicle rental offices including policies, procedures and techniques designed to enable such offices to compete more effectively in the vehicle rental market, including truck rental services. The Complainant licenses its franchisees the right to use the BUDGET trade mark in their vehicle rental offices throughout the United States of America and has licensed the BUDGET trade marks to Master Franchisees operating in numerous countries worldwide. The Complainant and its licensees have used the BUDGET trade mark continuously in various forms since at least as early as July 1960. As of January 2007, there were over 980 Budget rental locations in the United States of America and over 1000 Budget locations in other countries.

The Complainant has expended significant time, resources and efforts in advertising, promoting and establishing the goodwill of the BUDGET trade marks in association with its business worldwide for over 45 years. The Complainant claimed that by virtue of its extensive use and promotion worldwide, the BUDGET trade marks are well known marks entitled to protection under Article 6bis of the Paris Convention.

The Complainant is the owner of various BUDGET trade mark registrations and applications worldwide. The Complainant is also the registrant of over 350 worldwide registrations and pending applications for other BUDGET formative trade marks in over 100 countries. The Complainant has attached a list of its worldwide registrations and applications [Annexure 4]. In Malaysia, the Complainant has filed 2 trade mark applications for the marks BUDGET and BUDGET LOGO (DUAL TRIANGLE DESIGN) for services in Class 39 in 1997 and these applications are still pending registration [Annexure 4].

The Complainant's website is at the URL <http://www.budget.com>. The Complainant also has another website for the truck rental division of Budget at

www.budgettruck.com. The Complainant's webpages at these websites and at its country specific domains are adduced as Annexure 5.

The Respondent created the disputed domain name www.budget.com.my on 26 April 2005 [as per the MYNIC Whois search report at Annexure 3]. Copies of the print-outs from the Respondent's website www.budget.com.my are adduced as Annexure 6.

On 13 April 2007, the Complainant, through its solicitors, issued a cease and desist letter to the Respondent, demanding that it ceased the use of the BUDGET trade marks as part of the Respondent's company name and domain name. The Respondent did not respond to the said cease and desist letter. The Respondent did not respond to subsequent letters from the Complainant's solicitors. Copies of these letters are adduced as Annexure 7.

5. Parties' Contentions

The Complainant relies on the above stated facts and contends that the Respondent does not have any rights or legitimate interests in the domain name www.budget.com.my. The Complainant has never authorised the Respondent to use the word "BUDGET" in the disputed domain name nor has the Complainant authorised the Respondent to provide any services bearing the BUDGET trade marks in Malaysia.

The Complainant contends that the Respondent is not commonly known by the name "BUDGET". The Complainant further contends that the Respondent has registered the disputed domain name without authorisation and use of the disputed domain name www.budget.com.my will lead an internet user into believing that the Respondent is associated with the Complainant.

The Complainant claims that the Respondent has intentionally registered and used the disputed domain name in bad faith as given the fact that the BUDGET trade marks are well known, the Respondent must have or should have reasonably have known that the BUDGET trade marks have been used in relation to vehicle rentals.

In view of the goodwill of the Complainant, the Complainant contends that any person visiting the website designated by the disputed domain name www.budget.com.my would assume that the website has been created with the endorsement or participation of the Complainant's BUDGET trade marks. The Complainant further contends that the Respondent has linked its website with Budget International without the Complainant's authorisation, misleading and confusing customers into believing that it is associated with or is part of the Complainant's group or business and has acted in bad faith.

The Complainant states that the disputed domain name has been registered in bad faith by the Respondent as there was a clear indication that the Respondent by using the disputed domain name, deliberately attracts potential customers of the Complainant's products and services to its website for commercial purposes. Specific reference is made by the Complainant to the cases of Apple Computer Inc. v Omar Acosta Rivera (WIPO Case No. D2006-1118) and Red Bull GmbH v. Harold Gutch (WIPO Case No. D2000-0766) [Annexure 8], where the Panel found the use of the domain name by the respondent therein would lead visitors to believe that the domain name was affiliated with the complainant, holding that the registration alone was equal to use in bad faith.

The Complainant further claims that the Respondent's action in registering the disputed domain name www.budget.com.my may also deprive the Complainant of the opportunity of being contacted by existing or prospective customers thereby disrupting its business as the Respondent is passing off its domain name as one which is associated with the Complainant.

The Complainant has made reference to the decision of the Malaysian Courts in Thrifty Rent-A-Car Systems Inc, v. Thrifty Rent-A-Car Sdn Bhd (Annexure 8) as indicating the willingness of Malaysian courts to embrace the concept of borderless protection of well known marks in Malaysia in keeping with the spirit of Article 6bis of the Paris Convention and Article 16 of the TRIPS Agreement and stated that the Court held that the use of the THRIFTY marks in Malaysia by the Malaysian company constituted passing off. The Court accepted the reputation and goodwill acquired by Thrifty Rent-A-Car System Inc of the THRIFTY marks in the United States and countries in this region.

The Complainant has made references to a series of decisions whereby the Complainant had been successful in getting the offending domain names transferred to it [Annexure 9].

In accordance of Paragraph 12(1)(i) of the Policy, the Complainant requests that the disputed domain name, www.budget.com.my be transferred to the Complainant.

The Respondent did not file any response under Paragraph 6 of the Rules.

6. Discussions and Findings

Rule 17 of 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 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.

Identical or Confusingly Similar

The Panel finds that the Complainant has adduced sufficient evidence to demonstrate that that it has common law rights to the BUDGET trade marks worldwide including Malaysia. The disputed domain name www.budget.com.my incorporates the Complainant's BUDGET trade mark, notwithstanding the addition of a gTLD ".com" and a ccTLD ".my". Inclusion of such top level domain names is a technical requirement that should be disregarded when determining whether the domain name is identical or confusingly similar to the mark. The Panel has no difficulty in finding that the disputed domain name is identical to the Complainant's BUDGET trade marks.

Rights and legitimate interests

Paragraph 7 of the Policy provides that 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 disputed domain name or a name corresponding to the disputed domain name in relation to a genuine offering of goods or services; or
- (ii) the Respondent is commonly known by the disputed domain name even though it has acquired no trade mark or service mark right in the same name; or
- (iii) the Respondent is using the disputed 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.

The Respondent did not file any response to refute the Complainant's assertions and contentions.

While the Panel takes cognisance that the Respondent's company name is Budget Rent-A-Car Sdn Bhd, the incorporation of a company bearing the word "BUDGET" per se does not create any positive rights in the name for the Respondent and accordingly it will not automatically establish its rights and legitimate interests in the disputed domain name.

In light of the Respondent's failure to proffer any explanations and justifications, the Panel finds that there is no evidence on record to demonstrate that the Respondent has rights or legitimate interests in respect of the disputed domain name www.budget.com.my or it has acquired any trade mark right in the same. The Respondent has not been authorised by the Complainant to provide its services by reference to the Complainant's BUDGET trade marks. The Complainant on the other hand has established its rights and ownership to the BUDGET trade marks for many years prior the Respondent's registration of the disputed domain name in 2005.

Accordingly, the Panel finds that the Respondent has failed to establish any right or legitimate interest in the disputed domain name, in accordance with Paragraph 7 of the Policy.

Bad faith

Clause 6.1 of the Policy stipulates that the evidence of bad faith registration and/or use of the Domain Name may include, amongst 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 competitors 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; 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 authorised by, or otherwise connected with the Complainant and/or its trade mark or service mark.

The Complainant states that the Respondent has registered the disputed domain name in bad faith as there was a clear intention that the Respondent, by using the disputed domain name, deliberately attracts potential customers of the Complainant's services to its website for commercial purposes. The Complainant further contends that the Respondent registered the disputed domain name with an intention to attract or divert, for commercial gain, internet users from the Complainant's website to the Respondent's. The Respondent, by linking its website with Budget International without the Complainant's authorisation, has misled and confused customers into believing that it is associated with or is part of the Complainant's group or business and has acted in bad faith.

As indicated above, the Respondent did not contest any of the Complainant's assertions of facts nor its contentions. In particular, based on the manner of the Respondent's unauthorised link of its website to the Complainant's site as shown in Annexure 6 and given the extent of fame and reputation of the Complainant's BUDGET trade marks, the Panel finds that the Respondent has created a situation whereby users are likely to be misled or confused into thinking that the Respondent's website is connected to or at least associated with the Complainant and the Respondent is using the disputed domain name for the purposes of and with the intention to attract or divert, for some commercial gain, potential customers of the Complainant's services to its website. The Respondent has been given notices of the Complainant's objections on numerous occasions [Annexure 7]


and yet it chose to persist in such activities. This shows that it has actual knowledge of the Complainant's rights.

The Panel finds that the case falls squarely within Clause 6.1(iv) of the Policy, where the disputed domain name has been registered and used in bad faith since the Respondent registered and is using the disputed domain name for the purposes of and 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 web site and/or online location is operated or authorised by, or otherwise connected with the Complainant and/or its BUDGET trade marks.

In view of all the evidence submitted by the Complainant, the facts and circumstances, and in particular, the Respondent's failure to respond or refute the Complainant's contentions, the Panel finds that the disputed domain name has been registered and used in bad faith.

7. 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 disputed domain name www.budget.com.my be transferred to the Complainant.



Wong Jin Nee
Sole Panellist
Date: 1 July 2008