

**Administrative Panel Decision
In the matter of**

Between

BDMG Pte Ltd

And

ACME POSITIVE Sdn Bhd

Case No: RCA/DNDR/2008/16

1. The Parties

The Claimant is BDMG Pte Ltd, a company incorporated in 2003 under the laws of Singapore having registered office and place of business in Singapore and represented by Tong Lai Ling of Messers Raja, Darryl & Loh, Kuala Lumpur, Malaysia.

The Respondent is ACME Positive SDN BHD, a company incorporated under the laws of Malaysia, having its principal office in Puchong, Selangor, Malaysia and is represented by Mr. Teymoor Nabili.

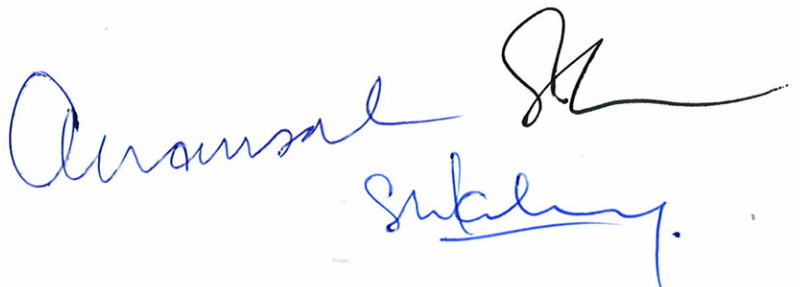
2. The Domain Name and Registrar

The domain name in dispute is <mumcentre.com.my> ("the Domain Name") and was registered on February 8, 2007. The Registrar is the Malaysian Network Information Centre (MYNIC) ("the Registrar").

3. Procedural History

The Complainant filed the Complaint with the Regional Centre for Arbitration Kuala Lumpur ('the Centre') on July 17, 2008 both through e-mail and hardcopy. The Centre sent an acknowledgement of receipt dated July 17, 2008 and thereafter on the same day sent a request to MYNIC for verification of the identity of the Domain Name holder. Having verified that the Complainant 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 Supplemental Rules of the Centre ("the Supplemental Rules") the Centre formally commenced this proceeding on July 21, 2008.

The Centre forwarded the Complaint to the Respondent on July 21, 2008. The Complainant elects to have the Complaint decided by a three-member panel and the Centre has assigned the Complaint to the following Panel:

The block contains three handwritten signatures in blue ink. The signature on the left is 'Anwarul', the one in the middle is 'Subah', and the one on the right is 'JH'.

- (i) Mr. Khoo Guan Haut- (the first panelist);
- (ii) Mr. Soh Kar Liang – (the second panelist); and
- (iii) Mr. Ashwinie Kumar Bansal- (the third and the presiding panelist).

Notices of the appointment were sent to the members of panel who had submitted statements of Declaration of Impartiality and Independence on August 29, 2008 as required by the Centre. An examination of this material confirms that all technical requirements for the initiation of this proceeding were complied with.

On August 21, 2008, the Respondent filed its Response to the Complaint. The Complainant filed its Reply on August 29, 2008. The Respondent sent an Amended Response via email dated September 2, 2008 (“Amended Response”). The Complainant objected via e-mail dated September 13, 2008 to the Amended Response.

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”*.

Having considered the Complainant’s objections to the Amended Response, the Panel decided to allow filing of the Amended Response to grant fair opportunity to the Respondent as per Rule 12.1.

The Panel’s decision is, therefore, based on the Complainant, the Amended Response and the Reply of the Complainant, the Policy, the Rules and the Supplemental Rules, which constitute the record of the Proceeding.

4. Factual background

The Complainant BDMG Pte Ltd was incorporated in Singapore on July 24, 2003 as a Limited Exempt Private Company. It had developed proprietary online marketing and media programs and it is involved in Internet media business and creates revenue by advertizing sales. The Complainant registered the domain name <mumcentre.com> on May 17, 2005 and thereafter a website was launched by him with this domain name to offer an online and web-based resource centre and buying guide for mothers and pregnant women (the “Complainant’s Website”). The Complainant has been using the trade mark MumCentre at the Complainant’s Website since then. The Complainant’s Website has achieved significant popularity and prominence and was dubbed a “Google Killer” by the Business Review in its June 2007 issue. The Complainant has yet to obtain registration for its trade mark MumCentre in Malaysia.

The Respondent registered the Domain Name on February 8, 2007 with consent and co-operation of the Complainant as per terms and conditions of Memorandum of Understanding (“the MOU”) signed by the Complainant and the Respondent which came to effect on March 1, 2007. Disputes arose between the parties after one year of the MOU and the parties were not able to resolve the same. The Respondent continued to hold registration and use of the Domain Name. Hence the present Complaint was filed by the Complainant.



5. Parties' Contentions

The Complainant contends that the Complainant is premised on the usage of the Domain Name and not 'registration' because the Respondent had been continuing the usage and holding registration of the Domain Name after the Respondent's right and license to represent MumCentre website and MumCentre products and services in Malaysian market had ceased. Registration and initial usage of the Domain Name was allowed under the MOU between the parties. The Respondent no longer acts as the representative of MumCentre website and its products and services in the Malaysian market and it no longer has right to use the Domain Name.

The Respondent contends it is a legitimately registered company offering genuine goods and services, properly using the Domain Name and that the Complainant agreed and participated in the registration of the Domain Name. The Complainant was involved in planning, devising and implementing the business operations of the Respondent for almost two years. The Complainant has attempted reverse hijacking of the Domain Name. He further contends that the real dispute related to differences regarding interpretation of the MOU and responsibilities of the parties there under which is pending adjudication by the Singapore International Arbitration Centre.

6. Discussion and Findings

Rule 17 of the 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 Policy provides that the Complainant must establish BOTH of the following elements in the Complaint:

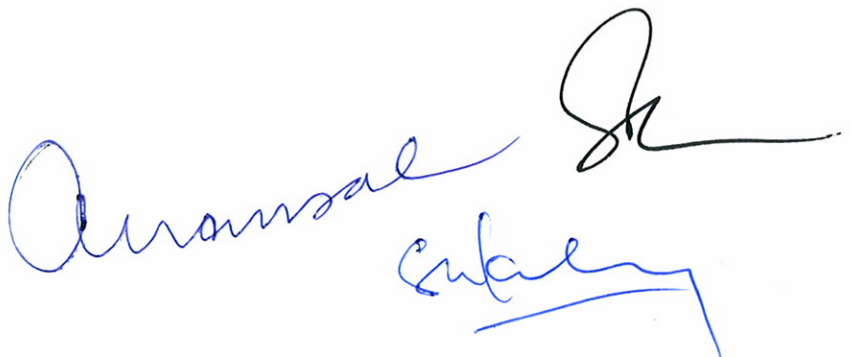
- (i) the Domain Name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights; and
- (ii) the Respondent has registered and/or used the Domain Name in bad faith.

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 words 'and/or' in paragraph 5(ii) hereof above.

Identical or confusingly similar

In view of the Complainant's use and registration of the domain name <mumcentre.com> and the unregistered trade mark MumCentre, the Complainant clearly has rights in the trade mark MumCentre. The Panel finds that the Domain Name incorporates the Complainant's trade mark MumCentre and also the Domain Name "mumcentre.com", registration, with the addition of a ccTLD ".my". It is an established approach to disregard the TLD and ccTLD portions of a domain name when comparing with a trade mark. On that basis, the Panelists have no difficulty in finding that the Disputed Domain Name is identical to the Complainant's mark.

Rights and legitimate interests



is maintaining control over the Domain Name. The Complainant does not deny that it had been a willing participant at the time when the website was set up. The Complainant argues that once disputes arose with the Respondent, the licence or consent to use the trademark, and therefore by extension, the Domain Name, ceased. The Respondent has not dealt with this argument. The Respondent contended that there was no trademark violation if the Complainant had not registered its trademark. The fact that there is no registered trademark infringement does not mean that the Respondent can claim rights to continued use of the trademark, hence the Domain Name; and operate the website bearing the Domain Name without the consent of the Complainant. The case of *Hai-O Enterprise Bhd v Nguang Chang* [1992] 4 CLJ 1985 states the following principles:

- (a) A foreign manufacturer who places his mark on his product which he intends to export for sale into Malaysia is the proprietor of the mark;
- (b) An importer of the goods does not acquire any proprietary rights over the manufacturer's mark;
- (c) an importer who has registered himself as the proprietor of the mark, even where he does so with the knowledge of the manufacturer, must be treated as having wrongly registered the mark.

By reason of this authority cited above, where it is clear that the proprietorship in the MumCentre mark vests in the Complainant, the Respondent cannot be said to have any proprietary rights over the mark. The Respondent has not denied that the Respondent's licence or authority to use the MumCentre mark has ceased as a result of the disputes arising. The Respondent is therefore no longer in a position to assert any right or legitimate interest in the trademark, and its continued use of the Domain Name has prevented and is still preventing the Complainant from using the Domain Name. As a result of this, upon the cessation of the right or licence to use the trademark MumCentre, any continued use of the Domain Name < mumcentre.com.my> would be in bad faith. The allegation of reverse hijack has no force in view of the discussion made above and same is rejected.

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 Domain Name < mumcentre.com.my> be transferred to the Complainant.

Dated September 22, 2008.

.....
Presiding Panelist

.....
Panelist

.....
Panelist