



FORM H

NOTIFICATION OF DECISION BY THE PANEL TO THE REGIONAL CENTRE FOR ARBITRATION KUALA LUMPUR

1. DETAILS OF THE CASE: Google Inc v Digiattack

CASE NUMBER: rca/dndr/2009/17

DISPUTED DOMAIN NAME(S): www.google.my

CASE ADMINISTRATOR: Olivia Tan Swee Leng

PARTIES NAME:

a) Complainant: **Google Inc**

b) Respondent: **Digiattack**

2. NAME OF PANELLIST(S): Associate Professor Dr. Zinatul Ashiqin Zainol

Pursuant to Rule 17.3, the Panel hereby forwards its decision for the above-referenced case.

Signature :
Name of Panellist(s) : Associate Professor Dr. Zinatul Ashiqin Zainol
Date : 24th April 2009

ADMINISTRATIVE PANEL DECISION

Administrative Panel Decision

In the matter of

Between

Google Inc. (Complainant)

And

Digiattack (Respondent)

Case No rca/dndr/2009/17

1. The Parties

The Claimant is Google Inc, a company incorporated under the laws of the United States of America, having its principle place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043, United States of America. The Claimant is represented by Messrs. Shearn Delamore & Co. of Kuala Lumpur, Malaysia.

The Respondent is Digiattack of no 10A, Jalan Horney, 30300 Ipoh, Perak Darl Ridzuan. The Respondent is represented by Messrs. Vincent Hooi & Chan of Perak Darul Ridzuan, Malaysia.

2. The Domain Name and Registrar

The disputed domain name is www.google.my registered with MYNIC Berhad. (as of 20th February 2009, MYNIC Berhad is now known as .my DOMAIN REGISTRY)

3. Procedural History

The Complaint was filed with the Regional Centre for Arbitration, Kuala Lumpur (the "Centre") on 25th of February 2009 both through email and hardcopy. The Centre sent an Acknowledgement of Receipt on 27th of February. On 26th February, the Centre transmitted by email to .my DOMAIN REGISTRY a request for registrar verification in connection with the identity of the domain name holder. The Centre forwarded the Complaint to the Respondent on 27th February 2009. The Respondent submitted a Response on 23rd March (email and hardcopy). The Complainant submitted a Reply on 31st March.

The Centre verified that the Complaint satisfied the formal requirements of MYNIC's (.my) Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Centre's Supplemental Rules (the "Supplemental Rules"). The Centre formally commenced this proceeding on 2nd April 2009.

The parties elected a single-member panel. On 2nd April 2009, the Centre appointed Associate Professor Dr. Zinatul Ashiqin Zainol as its panel. The Panel has submitted

Statements of Acceptance and Declarations of Impartiality and Independence, as required by the Centre. The parties were notified of the appointment of the Panel on 6th April 2009.

4. Factual Background

The Complainant is Google Inc, a company incorporated under the laws of the United States of America having its principle place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043, United States of America. The Complainant specialises in online search, online advertisement, web based email, online mapping, telecommunications and other matters relating to services such as the provision of software interfaces over the World Wide Web etc.

The Complainant is the registered proprietor of the trade mark “GOOGLE” and “Google (stylised)” in the following classes of goods and services in Malaysia (collectively known as the GOOGLE marks.)

ITEM NO	TRADE MARK	TRADE MARK NO	CLASS
1.	GOOGLE	2003/12776	9
2.	GOOGLE	2003/12777	42
3.	GOOGLE	2005/10745	16
4.	GOOGLE	2005/10747	25

Copies of the Complainant’s trade mark registration certificates was attached as Annexure 4 to the Complaint. The Complainant also has pending trade mark applications in Malaysia. The GOOGLE marks include *inter alia* “Computer services, namely providing software interfaces available over a network in order to create a personalised online information services; extraction and retrieval information and data mining by means of global computer networks; creating indexes of information, indexes of web sites and indexes of other information resources in connection with global computer networks; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, by means of global computer information networks.

The Complainant’s main website can be assessed at the URL www.google.com and www.google.com.my

The Respondent is Digiattack of no 10A, Jalan Horney, 30300 Ipoh, Perak Darl Ridzuan The Respondent created the disputed name www.google.my on 7th March 2008 (as per MYNIC Whois Service report at Annexure 2). A copy of the printout from the Respondent’s website www.google.my are adduced as Annexure 6. The domain name www.google.my leads to a blank page.

On 6th June 2008, the Complainant, through its solicitors, sent a cease and desist letter to the Respondent to cease and desist use of the infringing domain name and another domain name also registered in the name of the Respondent, being www.google.net.my on the basis that the registrations and use of the domain names www.google.ney.my and www.google.my by the Respondent constituted trade mark infringement, passing-off and use in bad faith. (annexure 7)

On 10th June 2008, the Complainant's solicitors received a letter from the Respondent, informing that they agreed to disable the disputed domain name and they would cooperate with the Complainant's solicitors on the transfer of the disputed domain name to the Complainant. (annexure 8) The Complainant's administrative contact contacted the Respondent on the transfer but failed to receive any acknowledgement. The Complainant's solicitor wrote to the Respondent on 8th August 2008, to request that the Respondent facilitate the transfer of the disputed domain name to the Complainant. The Complainant's solicitor further followed up the said letter on 2nd October 2008. (annexure 9). There was no response from the Respondent.

Due to the non-response, the Complainant's solicitors wrote to administrators at MYNIC directly on 13th October 2008 to seek their assistance and cooperation to transfer the disputed domain name www.google.my to the Complainant, relying on the Respondent's letter dated 10th June 2008. A MYNIC representative contacted the Complainant's solicitor via telephone on 17th October 2008 whereupon advice was given that the Complainant should initiate proceedings under MYDRP against the Respondent.

5. Parties Contentions

The Complainant contents as follows:

The respondent has registered the domain name www.google.my without the authorisation of the Complainant. Further, as the Respondent has no association with the Complainant and / trade connection with the Complainant, the Respondent does not have any rights to the trade mark "GOOGLE" nor to the domain name www.google.my. The Respondent is not associated or commonly known by the name "GOOGLE". The Respondent's use of the disputed domain name and corresponding website constitute trade mark infringement and passing-off of the said services. It also amounts to trafficking and use of the disputed domain name in bad faith by virtue of the inappropriate reproduction of Google Inc.'s trade dress and get-up (www.google.com and www.google.com.my). Therefore, the Respondent's use of the domain name www.google.my will mislead the unsuspecting internet user and the public to believe that the Respondent is associated with Google Inc. and/or that a trade connection exists between the Complainant and the Respondent, which of course is untrue.

The Respondent has intentionally registered and used the domain name www.google.my in bad faith. Given that GOOGLE trade marks are well-known, the Respondent must have or should reasonable have known that the GOOGLE trade marks must have been used in relation to the said services. The fact that the Respondent acknowledged their bad faith action is evidenced by their letter dated 10th June 2008, wherein they agreed to disable www.google.my and transfer it to the Complainant.

In view of the goodwill and reputation of the Complainant, any person visiting the website www.google.my would assume that the website has been created with the sanction, endorsement or participation of the Complainant since the website's URL contains the trade mark GOOGLE. The Respondent has acted in bad faith as the adoption, registration and use of the disputed domain name is a deliberate attempt to misappropriate and usurp the Complainant's goodwill, reputation and commercial advantage which they have already enjoyed in Malaysia and continue to enjoy. Further, the use of disputed domain name can be deemed as an instrument of fraud which the unsuspecting public may not be aware of.

The Respondent's action in registering the domain name may also deprive the Complainant of the opportunity of being contacted by or connected to existing or prospective users, whereby disrupting its business as the Respondent is passing off its domain name as one that is associated with the Complainant.

As the site for the domain name www.google.my is a blank page (with reference to annexure 6), any persons visiting the website would assume that the link to a blank page was created by the endorsement or participation of the Complainant, given that the website's URL contains the Complainant's trade mark. This would obviously cause damage to the Complainant's business and reputation as the internet users and the public may adopt the mistaken belief and be confused into thinking that the Respondent's website is connected or at least associated with the Complainant. This may also lead internet users to be diverted and given the impression and/or mistaken belief that the Complainant is responsible for linking a blank page to the URL www.google.my

The Complainant has made reference to the decision of the Malaysian Courts in *Thrifty Rent-A-Car System Inc. v. Thrifty-A-Car Sdn. Bhd.* [2003] 1 LNS 607 as indicating the willingness of the Malaysian courts are now prepared to accept the concept 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. It was decided that use of the THRIFTY mark in Malaysia by the defendant in this case amounted to passing off. The Judge in this case accepted the reputation and goodwill acquired by the Plaintiff of the THRIFTY mark in the United States of America and countries in this region.

The Respondent denies these contentions and responded as follows:

The Complainant claims that Google is a search engine/tool used to locate resources over the world through its software interfaces. The Complainant is subject to strict proof of this fact.

The Complainant claims to be the registered proprietor of the trade mark "Google". However, the Complainant did not show that it is registered trade mark owner of the combination of the words whereby GOOGLE forms part of the word. If it is true, then any party who use GOOGLE in part of its domain name is guilty of infringing the Complainant's trade mark. The Complainant's trade mark can only be infringed if the party use the whole word GOOGLE by itself.

The Respondent requires the Complainant to conclusively shows that the Complainant is also a registered trade mark owner of other domain names where the word GOOGLE is part of the combination and not merely the owner of a singular word "GOOGLE" only.

The Respondent state that the Respondent purchased the domain name from MYNIC BERHAD at the price of RM100.00. As such, the domain name was legally brought by the Respondent. There is no misappropriation by the Respondent.

The Respondent brought the domain name to be kept only. The Respondent has never and does not intend to use the domain name for any profit making or other commercial activities. As such, there is no ill will on the Respondent's part. There is also no bad faith on the Respondent's part, as the Respondent has not profited at all from the domain name.

Nevertheless, the Respondent has already disabled the domain name <http://www.google.net>, <http://www.google.my> and <http://www.google.my> from the current parking page and has informed the Complainant. The Respondent has no website on the domain name.

The Respondent states that the letter dated 10th June 2008 is not an agreement to transfer but merely is the Respondent informing the Complainant that the domain name has been disabled from the parking page.

The Respondent contents that the Respondent buy the domain name under the implied authorization of the Complainant by purchasing the domain name from a registered dealer, i.e. MYNIC BERHAD.

The Respondent denies that this is a case of trade mark infringement and passing off of the Complainant's interest because the Respondent does not use the domain name for any commercial purpose at all nor for any profits at all. The Respondent denies that this amount to trafficking and bad faith.

The Respondent denies that the public on the Internet use will associate the Respondent with the Complainant or that the Respondent has a trade mark connection with the Complainant just because of the word GOOGLE in the domain name.

Regarding the various authorities presented by the Complainant, the Respondent states that in those authorities, the Respondent has benefited commercially from the domain name usage whereas in the present case, the Respondent has not benefited commercially at all.

The Respondent could not possibly misappropriate and usurp the Complainant's goodwill, reputation and commercial advantage in the use of the name GOOGLE because the Respondent did not use the domain name commercially.

The Respondent denies that any fraud is committed by the Respondent. The Respondent put the Complainant to strict proof that the Complainant's business is disrupted by the domain.

The Respondent again deny that the domain name www.google.my was registered by the Respondent in bad faith and the Respondent deny that it is identical/confusingly similar to the trade marks and service marks owned by the Complainant.

The Respondent enclosed a decision dated 7/5/2005 in China whereby GOOGLE INC pays \$1 million for the use of google.com.cn and google.cn. If Google Inc. has the trade mark in any name with the word Google, why they have to pay \$1 million. This shows that Google Inc. do not have the trade mark for any domain name with the word Google.

The Complainant reply, *inter alia*:

There is no requirement that the Complainant is to provide strict proof of the services it provides. The Rules under these proceedings state that the Complainant only needs to establish that the disputed domain name is:

1. identical/confusingly similar to the Complainant's trade and service marks; and
2. that the disputed domain name has been registered in bad faith by the Respondent.

The Complainant has provided sufficient evidence in the Complaint to establish that it is the registered proprietor of the word mark "GOOGLE". Any use of the Complainant's GOOGLE Trade Marks in the course of trade by any unauthorised person may amount to trade mark infringement pursuant to the Section 37 of the Trade Marks Act 1976 and/or passing off to and pursuant to the Rules provided under these proceedings.

Since the Respondent's conceded to disable the disputed domain name and further requesting for elaboration on information on how to transfer of the disputed domain name, it was apparent that the Respondent was not only aware of its bad faith action in registering a domain name to which it had no rights or legitimate interest or connection and/or association but agreed to the disablement of the disputed domain name and further subsequent transfer (which the Respondent had failed and/or neglected to perform)

Notwithstanding the fact that the Respondent has not made any profits from the disputed domain name, the Complainant asserts and reiterates that there is bad faith on the part of the Respondent and that the mere disablement of the disputed domain name is insufficient to negate bad faith. (*Kraft Foods (Norway) v. Wide*, WIPO Case no D2000-0911)

The fact that the Respondent had failed and/or neglected to transfer the disputed domain name following its letter of 10th June 2008 indicates, unequivocally, bad faith on its part and the disputed domain name which is identical to a registered trade and service mark registered in the name of the Complainant, i.e. "GOOGLE", still remains registered in the name of the Respondent.

Whilst at present the disputed domain name is disabled, there is no guarantee that the Respondent will refrain from using the disputed domain name which is a registered trade and service mark of the Complainant. Any use of the disputed domain name will create a possibility of confusion or deception that the website and/or online location is operated or authorised by, or otherwise connected with the complainant and/or the Complainant's GOOGLE Trade Marks.

Further, in view of the goodwill and reputation garnered by the Complainant in respect of the GOOGLE Trade Marks, any use of the disputed domain name by the Respondent may indirectly create an instance of confusion and deception that the website and/or online location is operated or authorised by, or otherwise connected with the Complainant and/or the Complainant's trade mark and service marks, which the Complainant would not have control over the use of the disputed domain name. (*Red Bull GmbH v. Gutch*, WIPO Case no. D2000-0766)

The registration of the disputed domain name would lead the unsuspecting user to the mistaken belief that the disputed domain name is associated/related to the Complainant. Further, this would also lead unsuspecting user to the mistaken belief that the disputed domain name is a variation/extension to the Complainant's trade dress and get up.

6. Decision

Rule 17 of the 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 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 is sufficient 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 is satisfied that the Complainant has adduced sufficient evidence to show that it has rights in the GOOGLE Trade Marks. In many UDRP cases, the Complainant's rights on the trade mark are readily established and undisputed in cases where the Complainant provides evidence of trade marks registration. (*Prada S.A. v. Oleg Filipov-Guevreyan*, Case No DLA2004-0001; *Sparco S.p.A. v. Oleg Filipov-Guevreyan*, Case No DLA2003-0001; *Microsoft Corporation v. Maganda Industries and/or Douglas Morris a.k.a Douglas Morrison*, DPH2004-0001; *Helmut Lang S.a.r.l.v. Oleg Filipov-Guevreyan*, Case No DLA2003-0004; *Consitex S.A., Lanificio Ermenegildo Zegna & Figil S.p.A., Ermenegildo Zegna Corporation v. Oleg Filipov-Guevreyan*, DLA2003-0002; *Consitex S.A., Lanificio Ermenegildo Zegna & Figil S.p.A., Ermenegildo Zegna Corporation v. Oleg Filipov-Guevreyan*, DLA2003-0005; *Viacom International Inc. v Elitist Technologies Co Ltd*, Case No SDRP-2002/0001(F); *Google Inc. v Googles Entertainment*, Case No SDRP-2002-0003(F))

In the present proceedings, the Complainant has provided evidence of trade mark registration in Malaysia. Given that GOOGLE is a well-known trade mark, the registration of the GOOGLE marks in the following classes of goods and services further reaffirm the Complainant's undisputed rights in the trade marks.

ITEM NO	TRADE MARK	TRADE MARK NO	CLASS
1.	GOOGLE	2003/12776	9
2.	GOOGLE	2003/12777	42
3.	GOOGLE	2005/10745	16
4.	GOOGLE	2005/10747	25

The Panel also finds that the disputed domain name www.google.my incorporates the Complainant's GOOGLE trade marks. There is a general consensus that the relevant test is whether the domain name incorporates the dominant and distinguishing part of the complainant's mark. (*Volkswagen Group Singapore Pte. Ltd and Webmotion Design*, Case No: rca/dndr/2003/01; *Yahoo! Inc v. Yahoo Computer Services*, Case No: DPH2001-0001; *Volkswagen Group Singapore Pte. Ltd and Webmotion Design*, Case No: rca/dndr/2003/01; *Hugo Boss AG and Eppies Internet*, Case No: rca/dndr/2004/02; *Google Inc. v Googles Entertainment*, Case No SDRP-2002-0003(F); *Viacom International Inc. v Elitist Technologies Co Ltd*, Case No SDRp-2002/0001(F); *Koninklijke Phillips Electronics NV v. Park Kyoung Seok*, Case No: DPH2000-0001) Accordingly, the Panel has no difficulty in

finding that the disputed domain name www.google.my is identical or confusingly similar to the Complainant's trade mark GOOGLE.

Rights and Legitimate Interest

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.

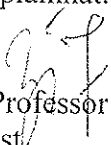
In the present proceeding, the Respondent stated that the Respondent purchased the domain name from MYNIC BERHAD at the price of RM100.00. As such, the domain name was legally brought by the Respondent. The Panel does not find this argument as convincing. The act of registering a domain name does not give the registrant a right or legitimate interest in the domain name. (*Hamlet Group, Inc. v. James Lansford*, WIPO Case no. D2000-0073; *Robert Chiappetta dba Discount Hydrophonics v. C.J. Morales*, WIPO Case no. D2002-1103). See also Paragraph 2 of MYNIC Agreement for Registration of Domain Names which expressly states that 'the registrant agrees that the registrant does not own the registered domain name.'

Bad Faith

Given that GOOGLE is a well-known mark, the Panel is willing to accept the contentions put forth by the Complainant's solicitors in relation to bad faith. As such, the Panel finds it difficult to agree with the Respondent that The Respondent could not possibly misappropriate and usurp the Complainant's goodwill, reputation and commercial advantage in the use of the name GOOGLE because the Respondent did not use the domain name commercially. Apart from the scenario of classic cybersquatters who cunningly register multiple domain names for commercial gain, inactive holding domain names also amounts to bad faith use. (*Volkswagen Group Singapore Pte. Ltd and Webmotion Design*, Case No: rca/dndr/2003/01). The Panel is persuaded to follow the decision in *Google Inc. v Googles Entertainment*, Case No SDRP-2002-0003(F) that bad faith use is not limited to positive action, but such use could be inferred from the respondent's passive holding of the domain names. See also *Telstra Corporation Limited v. Nuclear Marshmallows*, Case no D2000-0003; *Koninklijke Philips Electronics NV v. Park Kyoung Seok*, DPH2000-0001.

7. Conclusion

Accordingly, the Panel directs that the disputed domain name www.google.my be transferred to the Complainant.


Associate Professor Dr. Zinatul Ashiqin Zainol

Sole Panelist

Date: 24th April 2009