

Administrative Panel Decision

In the matter of

Between

COBWEB SDN. BHD.

And

INFOTOUCH SOLUTION PROVIDER

Case No: RCA/DNDR/2010/21

1. The Parties

1.1 The Complainant is COBWEB SDN. BHD. (Company Registration No. 514351 M), a company incorporated under the laws of Malaysia on May 15, 2000, having a principal place of business at No. 143-A, Jalan Selang, Taman Saleng Jaya, 81400 Senai, Johor, Malaysia.

1.2 The Respondent is INFOTOUCH SOLUTION PROVIDER (Business Registration No. JM0414534-W), a business incorporated under the laws of Malaysia and having a principal place of business at No. 24, Jalan Tasek 55, Bandar Seri Alam, 81750 Masai, Johor, Malaysia.

2. The Domain Name and Registrar

2.1 The domain name in dispute is <bestoffer.my> (“**the Domain Name**”). It was registered on April 2, 2008 vide Registration No. D6A006787. The Registrar is Malaysian Network Information Centre (MYNIC) (“**the Registrar**”).

3. Procedural History

3.1 The Complaint was filed via e-mail on January 26, 2010 and a hard copy was submitted to the Regional Centre for Arbitration Kuala Lumpur (“**the Centre**”) on the same date.

3.2 The Complaint was acknowledged by the Centre on February 4, 2010. Thereafter, a request was sent by the Centre to MYNIC for verification of the identity of the holder of the Domain Name on April 2, 2010.

3.3 The Centre upon reviewing the Complaint, was satisfied that the formal requirements of the MYNIC’s (.my) Domain Name Dispute Resolution Policy (“**the MYDRP**”) (“**Policy**”), the Rules of the MYDRP (“**Rules**”) and the Supplemental Rules of the Regional Centre for Arbitration Kuala Lumpur (“**Supplemental Rules**”) have been complied with and therefore formally notified the Respondent of the Complaint on February 5, 2010 via e-mail. The proceeding (“**Proceeding**”) formally commenced on February 5, 2010.

3.4 The Response was submitted on March 1, 2010. No Reply was submitted by the Complainant.

3.5 The Complainant elected a single-member Panel (“**the Panel**”) to decide the Proceeding. I, the undersigned, was constituted by the Centre as the Panel. The notice of appointment of the Panel and communication of the appointment of the Panel to the parties was sent on April 15, 2010. The Panel submitted the Declaration of Impartiality and Independence on April 13, 2010.

4. Background Facts

4.1 The Complainant operates a business of promoting website development including domain name registration, web designing, web hosting, web management and sharing website system (“**Complainant’s services**”) in Malaysia.

4.2 The Complainant is the owner of the domain name <bestoffer.com.my> (“**Complainant’s domain name**”). Although the Complainant claims that it has been using its domain name extensively since 2002, the Complainant’s domain name appears to be registered on April 20, 2009.

4.3 There is no evidence on whether the Complainant has any trade mark registrations or pending applications for the mark “bestoffer” (“**bestoffer mark**”) in Malaysia.

4.4 The Respondent is a business registered under the Business Registration Act 1956. According to its Certificate of Renewal of Registration, the Respondent is in the business of internet services, website services, software development and mobile content provider. The Certificate of Renewal of Registration states that the Respondent’s business registration is renewed for a period of five years from February 12, 2010. There is no evidence that the Respondent commenced business prior to February 12, 2010.

5. Parties’ Contentions

The Complainant’s Contentions

5.1 The Complainant contends that the Domain Name is identical or confusingly similar to the Complainant’s Domain Name.

5.2 The Complainant claims that it is the proprietor of the bestoffer mark and has goodwill in its business by reference to the bestoffer mark through extensive use of the bestoffer mark since 2002.

5.3 The Complainant asserts that the Respondent had registered the Domain Name with intention to attract or divert for commercial gain Internet users to its web site (“**web site**”) and that this has created a possibility of confusion or deception that its web site is operated or authorized or otherwise connected with the Complainant.

5.4 The Complainant also asserts that use of the Domain Name by the Respondent is in bad faith.

The Respondent's Contentions

5.5 The Respondent denies that it has acted in bad faith.

5.6 The Respondent contends that it uses different domain names for different purposes. The Respondent further contends that it is prepared to use the Domain Name to provide sale and promotion information and that it expects the Domain Name to support its business and provide better service for its customers.

5.7 The Respondent states that the word "bestoffer" is a common word and when used as a keyword in a search engine produces numerous results. The Respondent asserts that it is not possible for internet users to locate a specific website using the word "bestoffer". The Respondent further states that there is no evidence of confusion.

5.8 The Respondent contends that there is no evidence that customers have confused the Complainant with it. The Respondent avers that all its advertising activities will clearly indicate its company name.

5.9 The Respondent also states that the Complainant did not show any interest in the Domain Name despite being given priority to apply to register it when the second level domain name ".my" was launched in 2007.

5.10 The Respondent further states that the Domain Name was registered before the Complainant's domain name.

6. Discussions and Findings

6.1 Rule 17 of the Rules states that the Panel is 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.

6.2 Paragraph 5.2 of the Policy provides that the Complainant must establish each 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

6.3 The Respondent does not deny that the Domain Name is identical or confusingly similar to the Complainant's domain name.

6.4 The Domain Name incorporates the bestoffer mark in its entirety. It is well established in domain name cases that the inclusion of gTLD and ccTLD is immaterial in determining whether the Domain Name is identical or confusingly similar to a Complainant's trade mark (**Volkswagen Group Singapore Pte Ltd** v

Webmotion Design Case No.: rca/dndr/2003/01 (int)). Accordingly, the Panel finds that the Domain Name is identical to the bestoffer mark.

6.5 The Panel had taken into consideration all the evidence including the Respondent's averment that the Domain Name was registered before the Complainant's domain name and finds that the Complainant has adduced prima facie evidence that it uses the bestoffer mark in relation to its services. Although it is not clear whether the bestoffer mark had in fact been used since 2002 as claimed by the Complainant, there is evidence of use since 2003. Accordingly, the Panel is satisfied that paragraph 5.2(i) of the Policy has been established.

6.6 The Panel states that the Complainant's failure to apply to register the Domain Name despite being given priority to apply to register it when the second level domain name ".my" was launched in 2007 is not a relevant consideration for the purposes herein and does not affect the Complainant's rights to the bestoffer mark.

6.7 As an observation, the Panel further states that global trade mark registrations is not a requirement for the purposes of the Policy (**UPIB, Inc. v Mr Muhammad Arshad** WIPO Case No. D2004-0428 and **Funskool (India) Ltd v funscholl.com Corporation** WIPO Case No. D2000-0796). In *Funskool (India) Ltd. v. funschool.com Corporation*, WIPO Case No. D2000-0796 it was decided that "If the intention had been that the Complainant's right to complain ... had to be limited to a trademark recognized by the law of the Respondent's country of incorporation or residence, the Policy would have said so expressly". The Panel notes that there is no such requirement in the Policy, the Rules and the Supplemental Rules.

Rights and legitimate interests

6.8 Paragraph 7.1 of the Policy provides that the registration and/or use of the Domain Name is not in bad faith if the Respondent establishes that he has rights and legitimate interests in the Domain Name.

6.9 Evidence of rights and legitimate interests may include any one of the following circumstances:-

- (i) before any notice 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 eventhough the Respondent has not acquired trade mark or service mark rights in the same; or
- (iii) the Respondent is using the Domain Name for legitimate, non-commercial and/or fair purposes and have no intention of using the same for profits or to deceive the public.

6.10 The language used by the Respondent in the Response suggests that the Domain Name has yet been used either in relation to its business activities, or at all. However, the Complainant seems to have admitted that there is use of the Domain Name by the Respondent at paragraph 5 of the Complaint although no evidence was

adduced in support of this contention by either party. Bearing this in mind, the Panel's findings are as follows.

6.11 Apart from statements in the Response, the Respondent failed to adduce any evidence to show that, prior to receiving notice of the Complaint it had used the Domain Name to make a genuine offering of goods and services.

6.12 There is also no evidence that the Respondent is commonly known by the domain name or that it was making legitimate non-commercial use of the domain name.

6.13 In **UPIB, Inc. v Mr. Muhammad Arshad** WIPO Case No. D2004-0428, the respondent relied on his statement that his rights and legitimate interests in the domain name are based on his claims that his computer business has been operating since 2000, and that he had applied for a trade mark in June 2001. The respondent did not provide any evidence on his computer business. The panel held that a mere statement was insufficient and accordingly, the respondent had not demonstrated that he had used of the domain name for offering bona fide goods and services before the date of his being informed of the Complainant's dispute. The respondent in that case also failed to adduce evidence that it is commonly known by the domain name or that he was making legitimate non-commercial use of the domain name.

6.14 In **Dr. Ing. H.c. F. Porsche AG v The Training Shed** WIPO Case No. D2003-0644, the panel held that the respondent has no rights or legitimate interests in the domain name on the ground that the respondent did not show that it was making any use of the domain name at all. Similarly, in **Telstra Corporation Limited v Mr. Andy Kang** WIPO Case No. D2002-0832, the panel held that the respondent has no rights or legitimate interests in the disputed domain name on the ground that there was no evidence that the Respondent has used the domain name in connection with a bona fide offering of goods or services; or is commonly known by the domain name or has made legitimate non-commercial use of the domain name.

6.15 Based on the above findings and observations, the Panel concludes that the Respondent has not established any rights and legitimate interests in the Domain Name under paragraphs 7.1 and 7.2 of the Policy.

Bad Faith

6.16 The Panel would like to point out that whilst establishing rights and legitimate interests in a domain name disproves bad faith, failure to do so does not prove bad faith. Accordingly, the Panel finds it necessary to determine whether or not the Respondent registered and/or used the Domain Name in bad faith.

6.17 It appears that the crux of the Complainant's complaint of bad faith falls within paragraph 6.1(iv) of the Policy. Paragraph 6.1(iv) of the Policy states that evidence of bad faith may include circumstances where the Respondent had registered and is using the Domain Name with the intention of attracting or diverting, for commercial gain, Internet users to the Respondent's web site by creating a possibility of confusion or deception that the Respondent's web site is operated or authorised by, or otherwise connected with the Complainant and/or its trade/service mark. The

Respondent denies this whilst the Complainant does not support this allegation with any evidence. The Panel finds that there is a lacunae of evidence in respect of this issue.

6.18 The Respondent has however adduced some evidence in support of its assertion that it had not registered nor is it not using the Domain Name with the intention of attracting or diverting, for commercial gain, Internet users to the Respondent's web site. This evidence are search results on the Google and Yahoo! search engines using the keyword "bestoffer", which appears to support the Respondent's contention that it is impossible to locate a specific website by using the keyword "bestoffer" as the results are numerous.

6.19 The Panel states that such evidence does not detract from the fact that the Domain Name is identical or confusingly similar to the bestoffer mark and the Complainant's Domain Name. It merely shows that the combination of the words "bestoffer" is common.

6.20 The possibility of confusion as to whether the Respondent's web site is authorised or connected with the Complainant and/or its trade/service mark although not obvious from searches conducted on internet search engines, could nevertheless exist in other circumstances. The Complainant had however, failed to provide any evidence of such other circumstances. In any case, evidence of confusion itself is not sufficient to prove bad faith under the Policy.

6.21 Based on the above, the Panel finds there to be no compelling evidence to establish paragraph 6.1(iv) of the Policy

6.22 The Panel also finds that the Complainant has not adduced any or sufficient evidence to prove bad faith under any of the other limbs set out in paragraph 6.1 of the Policy or otherwise.

6.23 In the circumstances, the Panel concludes that the Complainant has not met its burden of proof on the issue of bad faith registration and use.

6.24 At this juncture, the Panel finds it pertinent to highlight that the Policy is designed to prevent extortionate behaviour known as cyber squatting. It is not designed to prevent a trade mark owner from barring entry to online competitors or legitimate sellers (see **Dr. Ing. H.c. F. Porsche AG v Del Fabbro Laurent** WIPO Case No. D2004-0481).

6.25 The Panel would also like to highlight the decisions of **Petroliam Nasional Bhd v Khoo Nee Kiong** [2003] 4 MLJ 216 and **British Telecommunications plc and another v One In A Million Ltd and others** [1998] 4 All ER 476, where it was held that a person who registers well-known trade names as domain names is equipping himself with instruments of fraud and accordingly, such registrations are made with the purpose of appropriating the goodwill and property of the trade name owners and with an intention of threatening dishonest use of such trade names. It is pertinent to bear in mind what was said by Su Geok Yiam JC in **Petroliam Nasional Bhd v Khoo Nee Kiong** [2003] 4 MLJ 216, that any realistic use of domains names which are instruments of fraud would result in passing off. It is apposite to note that

there is no evidence that the Respondent is equipping himself with an instrument of fraud.

6.26 As a final observation, it would appear that the Complainant's real complaint is that registration and use of the Domain Name by the Respondent is an infringement of their trade/service mark rights and/or an attempt to pass off its goods and services as that of the Complainant's. The documents submitted by the Complainant do raise such issues in particular, the scope of the Complainant's alleged rights and the proximity of the type of services offered by the Parties. If indeed such is the dispute, neither this forum nor the Policy is appropriate to resolve it. (**UPIB, Inc. v Muhammad Arshad WIPO D2004-0428, The Bear Stearns Companies Inc. v Pacific Residential WIPO Case No. D2004-0314 and Credit Management Solutions, Inc. v Collex Resource Management WIPO Case No. D2000-0029).**

6.27 With due regard to the parameters of the Policy, the Rules and the Supplemental Rules, the Panel finds that the Complainant has failed to prove bad faith under paragraph 5.2(ii) of the Policy.

7. Conclusion

7.1 Based on the foregoing reasons, the Complaint is denied.

Michael Soo Chow Ming
Single-member Panel

Dated this May 5, 2010