

ADMINISTRATIVE PANEL DECISION

In the matter of KLRCA/DNDR-503-2017

Between

Tencent Holdings Limited
(Complainant)

And

Thai Amulet Technology
(Respondent)

Case No: KLRCA/DNDR-503-2017

1. The Parties

The Complainant is Tencent Holdings Limited, a company having its registered address at P.O. Box 2681 GT, Century Yard, Cricket Square, Hutchins Drive, George Town, Grand Cayman, Cayman Islands. For the purposes of local presence requirements, the Complainant has also identified a local presence registrant, IP Mirror (Malaysia) Sdn. Bhd.

The Respondent is Thai Amulet Technology, having its business address at Suite 9, MBE Nusa Bestari, Petronas Service Station Lot PTD 12351, Taman Tan Sri Yaakob, Mukim Pulai, 81200 Johor Bahru, Johor, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <wechatpay.my>, <wechatpay.com.my>, <tenpay.my>, <tenpay.com.my> and <weixin.com.my> are registered with MYNIC Berhad.

3. Procedural History

The Complaint was filed with the Kuala Lumpur Regional Centre for Arbitration (the "Centre") on June 6, 2017 by hand as well as by electronic mail.

The Centre verified that the Complaint 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"), in respect of the disputed domain names.

In accordance with the Rules, paragraphs 5.2 and 5.3, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on August 17, 2017. The Respondents were also directed to file their response on or before September 7, 2017, in accordance with paragraph 6.1 of the Rules. However, the Respondent did not submit a response.

The Complainant having elected for a single member panel, the Centre appointed Mr. Deepak Pillai A/L N Chandrasekaran as the sole panelist on September 15, 2017. The

panelist has submitted the Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rules, paragraph 9.3.

4. Factual Background

The following sets out the uncontested factual submissions made by the Complainant:

- 4.1 The Complainant is the leading provider of Internet value added services in China, providing social platforms and digital content services to meet the needs of Internet users including communication, information, entertainment, financial services and others. The Complainant's internet platforms include, amongst others, Weixin/WeChat, WeChat Pay and Tenpay.
- 4.2 As of the third quarter of 2016, the combined monthly active user accounts of Weixin/Wechat have reached more than 846 million users. Weixin/Wechat Pay was officially launched in China in August 2013 and became available to merchants in China in March 2014, whereas Tenpay is the second largest online payment platform in China, having been established in China since September 2015.
- 4.3 The Complainant has procured the registration of the trademarks WECHAT, WEIXIN, WECHATPAY and TENPAY across various jurisdictions including Hong Kong, European Union and the United States. In Malaysia, the Complainant has registered the trademarks under the following classes of goods and services with the Intellectual Property Corporation of Malaysia (MyIPO):

Trademark	Registration Number	Class	Registration Date (YYYY-MM-DD)
WECHAT	2011054425	9	2011-10-28
	2011055426	38	2011-10-28
WEIXIN	2013057714	9	2013-07-31
	2013057716	16	2013-07-31
WECHATPAY	2015056921	9	2015-05-06
	2015056923	36	2015-05-06
TENPAY	2014056350	9	2014-05-02
	2014056352	35	2014-05-02

Copies of the Complainant's trademark registration certificates were attached as Annexure 1 of the Complaint.

- 4.4 The Respondent registered the domain names in dispute in 2015 and 2016: wechatpay.com.my and wechatpay.my were registered on September 3, 2015;

tenpay.com.my and tenpay.my were registered on April 1, 2016; and weixin.com.my was registered on April 5, 2016. Copies of the WHOIS contact information for the disputed domain names were attached as Annexure 2 of the Complaint. As such, the Respondent only registered the disputed domain names several years after the majority of the Complainant's trademarks had been registered in Malaysia, and well after the Complainant had begun marketing and providing services around the world using the trademarks in 2011.

- 4.5 An online search by the Complainant revealed that three of the disputed domain names, i.e. wechatpay.my, wechatpay.com.my and weixin.com.my are currently re-directing Internet traffic to a commercial site at <http://no1wechatmarketingmalaysia.blogspot.com.my/>. Proof of the domain name forwarding was attached as Annexure 10 of the Complaint.
- 4.6 In addition, a check of the commercial site that Internet users are re-directed to in the paragraph above reveal that the Respondent is currently offering to sell the disputed domain names at RM5,000 each by way of advertisement on the commercial site. Screen captures of the commercial site and the advertisements offering the disputed domain names for sale were attached as Annexure 3 of the Complaint.
- 4.7 The Respondent has been a passive holder of the remaining two disputed domain names, i.e. tenpay.my and tenpay.com.my. An online search by the Complainant revealed that both sites currently resolve to an inactive site and are not being used. Screen captures of the passive websites were attached as Annexure 3 of the Complaint.

5. Parties' Contentions

5.1 Complainant

The Complainant contends that the registration of the disputed domain names should be transferred to the Complainant, for the following reasons:

- (a) The Complainant asserts that by virtue of their registration with MyIPO, the Complainant is the owner of the Complainant's trademarks WECHAT, WECHAT PAY, WEIXIN and TENPAY (the "Trademarks");
- (b) The Complainant contends that the disputed domain names are identical to the Complainant's Trademarks for the following reasons:-
 - (i) The disputed domain names contain the Complainant's Trademarks in its entirety; and
 - (ii) When determining the similarities between the disputed domain names to the Complainant's Trademarks, the inclusion of the ccTLDs ".my" and "com.my" are inconsequential;

- (c) The Complainant further contends that the Respondent had registered and/or used the disputed domain names in bad faith, relying on the following:
- (i) The Respondent has no rights or legitimate interest in the disputed domain names, as the Respondent is not commonly known by the disputed domain names and the Complainant has not licensed or authorised the Respondent in any way to register and use any domain names incorporating the Complainant's Trademarks, which demonstrates a lack of rights or legitimate interests;
 - (ii) The Respondent is not making a bona fide offering of goods or services or legitimate, noncommercial fair use of the disputed domain names, for the reasons set out in paragraphs 4.5 to 4.7 above;
 - (iii) The Complainant contends that its Trademarks are known internationally, with trademark registrations across numerous countries including Hong Kong, Malaysia, European Union and the United States. In addition, the Complainant asserts that it had been marketing and providing services using the Trademarks since 2011, well before the Respondent's registration of the disputed domain names in 2015 and 2016. As such, by registering domain names using the exact terms "wechat", "wechatpay", "weixin" and "tenpay", the Complainant asserts that the Respondent had demonstrated its knowledge of the Trademarks, brand and business;
 - (iv) The Respondent had registered numerous domain names, each one infringing upon the Complainant's Trademarks. By the sheer number of infringing domain names registered by the Respondent, the Complainant contends it has been demonstrated that the Respondent is engaging in a pattern of cybersquatting;
 - (v) Given the above, the disputed domain names can only be taken as intending to cause confusion among internet users as to the source of the disputed domain names; and
 - (vi) On balance of the facts above, it is more likely than not that the Respondent knew of and targeted the Complainant's Trademarks.

5.2 Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 17.1 of the Rules provide that the Panel is to decide the proceedings based on the documents and evidence submitted by the Parties, the Policy and the Rules as well as any other rules or principles of law which are applied in Malaysia.

Paragraph 5.2 of the Policy provides that the Complainant must establish both of the following elements in the Complaint:

- (a) The domain name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights; and
- (b) The Respondent has registered and/or used the domain name in bad faith.

Paragraph 7.2 of the Policy sets out the circumstances under which the Respondent can claim rights or legitimate interests in the domain name.

6.1 Identical or Confusingly Similar Trade Mark

The Panel is satisfied that the Complainant has adduced sufficient evidence to prove that it has rights in the Trademarks. The Panel agrees with the Complainant contention that as stated in *United Way of America v. Alex Zingaus*, FA 1036202 (NAF Aug.30, 2007, "Panels have long recognized Complainant's registration of a mark with a trademark authority is sufficient to confer rights in the mark pursuant to [UDRP] Policy 4(a)(i)". The Panel also makes reference to the multiple UDRP cases where it was found that where Complainants were able to provide evidence of trademark registration, such Complainant's rights in respect of the registered trademarks are established and undisputed. (*Prada S.A. v. Oleg Filipov-Guevreyan*, Case No DLA2004-0001; *Sparc° 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 Sa.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)).

The Complainant has provided evidence that their Trademarks are registered in Malaysia. Copies of the Complainant's trademark registration certificates were attached as Annexure 1 of the Complaint, and a summary of the Complainant's Trademark registrations have been tabulated in paragraph 4.3 above. As such, the Panel finds that the Complainant has established their rights over the Trademarks.

The disputed domain names have incorporated the Trademarks with the additions of a gTLD ".com" and a ccTLD ".my". The Panel agrees with the Complainant that the addition of top-level domains is immaterial when determining whether the disputed domain names are identical or confusingly similar with the Trademarks as the inclusion of top level domain names are a technical requirement, and are therefore inconsequential in order to determine the similarity of the domain name to the mark. This principle has been well established in domain name decisions, including *Google Inc v Digiattack*, Case No:rca/dndr/2009/17 (KLRCA April 24, 2009) and *Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 28, 2000) (finding that the top-level domain, such as ".net" or ".com", does not affect the domain name for the purpose of determining whether it is identical or confusingly similar). See also *Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 0153545 (NAF May 27, 2003) ("[t]he addition of a top-level domain is irrelevant when establishing whether or

not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name").

Following from the above, the Panel finds that without considering the top-level domains, the disputed domain names contain the Complainant's Trademarks in its entirety. The Panel has taken note that past panels have found that where a disputed domain name encompasses and captures a complainant's trademark in its entirety, the disputed domain name should be found to be confusingly similar to that trademark: *Uniroyal Engineered Products, Inc. v. Nauga Network Services, D2000-0503 (WIPO July 18, 2000)* where the Panel found that the disputed domain <nauga.net> was confusingly similar to the complainant's NAUGA trademark).

In consideration of all the above factors, the Panel finds that the disputed domain names are confusingly similar and identical to the Trademarks.

6.2 Rights and Legitimate Interests

Paragraph 7.2 of the Policy provides that the Respondent may prove its right and legitimate interest in the disputed domain names by substantiating with evidence that:

- (a) 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
- (b) 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
- (c) 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.

The Respondent has not replied to the Complainant's contentions or established its rights and legitimate interests in the disputed domain names. The Panel as such has no grounds for coming to a conclusion that the Respondent has made use or was preparing to make use of the disputed domain name for a genuine offering of goods or services, or that the dispute domain names being used for a legitimate, noncommercial and/or fair purpose with no intention of using the domain names for profit or to deceive the public. By contrast, the Complainant has adduced evidence that the Respondent had been using the disputed domain names for profits, the full facts of which have been set out in paragraphs 4.5 and 4.7 above.

Additionally, the Panel agrees with the Complainant that the Respondent is not commonly known by the disputed domain names and neither has the Complainant licensed or authorised the Respondent in any way to register and use any domain names incorporating the Complainant's Trademarks.

Accordingly, the Panel finds that the Respondent has failed to establish any right or legitimate interest in the disputed domain names in accordance with paragraph 7.2 of the Policy.

6.3 Registration and/or Use in Bad Faith

Paragraph 6.1 of the Policy provides that evidence of the registration and/or use of the domain name being in bad faith may include, among others, where the domain name was registered and/or used by the Registrant:

- (a) mainly to sell, rent or transfer the Domain Name for profit to the Complainant, its competitor or the owner of the trade mark or service mark; or
- (b) 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
- (c) to disrupt the business of the Complainant; or
- (d) for the purposes of and with the intention to attract or divert, for commercial gain, Internet users to:
 - (i) the Registrants web site; or
 - (ii) a web site of the Complainant's competitor; or
 - (iii) 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.

In the present proceedings, when accessing the disputed domain names the Complainant discovered that the Respondent was re-directing Internet traffic for three of the disputed domain names to a commercial site with the domain name no1wechatmarketingmalaysia.blogspot.my (the "said commercial site"), and on said commercial site the Respondent was offering the disputed domain names for sale at RM5,000 each. The Panel agrees with the Complainant that in doing so, the Respondent had registered the disputed domain names in bad faith as the Respondent had demonstrated an intent to sell the disputed domain names for profit, which constitutes bad faith under paragraph 6.1(a) of the Policy.

The Panel finds that given that the Complainant and its Trademarks are known internationally with trademark registrations across numerous countries, and also taking into account that the Complainant had been marketing and providing services using its Trademarks since 2011, in electing to register domain names with the exact terms as the Complainant's Trademarks and thereafter re-directing the Internet traffic to the disputed domain names to commercial sites owned by or affiliated with the Respondent, the Respondent had demonstrated their knowledge of the Complainant's Trademarks, brand and business. The Panel finds that the Respondent had been intending to use the Complainant's goodwill and reputation to attract or divert Internet users to the registrant's web site for commercial gain by creating a possibility of confusion or deception that the website is operated, authorised or otherwise connected with the Complainant and/or its trade mark, which constitutes bad faith under paragraph 6.1(d) of the Policy.

The Panel has also considered the Respondent's actions in registering numerous domain names, each infringing upon the Complainant's Trademarks. The Panel does not consider it possible that the Respondent should have coincidentally decided to register multiple domain names all of which are trademarks that the Complainant has registered and all of which are known internationally. The Panel agrees that such action constitutes "cybersquatting" which evidences bad faith registration and use. See *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc.*, D2000-0113 (WIPO Apr. 13, 2000) where the Panel stated thus: "...Respondent was in bad faith when it registered these ten (10) domain names with NSI beginning in February, 1999. To register so many domain names using so many combinations of Complainant's trademarks is a pattern and a calculated attempt by Respondent to foreclose Complainant from using its own trademarks in cyberspace (the Policy 4 (b)(ii)). This is classic cybersquatting".

In addition to the registration of multiple domain names each of which infringe upon the Complainant's Trademarks, the Panel agrees that the Respondent's action of registering two of the disputed domain names yet not making use the domain names for any purpose further indicates bad faith registration on the Respondent's part. It is established that passively holding a domain name can constitute a factor in finding bad faith registration and use (*Volkswagen Group Singapore Pte Ltd v Webmotion Design*, Case No: RCA/DNDR/2003/01(INT.) (KLRCA August 20, 2003) and *Telstra Corp. v. Nuclear Marshmallows*, D2000-0003 (WIPO Feb. 18, 2000) ("it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith"). See also *Twentieth Century Fox Film Corp. v. Risser*, FA 93761 (NAF May18, 2000) where the Panel found that "The requirement in the ICANN Policy that a complainant prove that domain names are being used in bad faith does not require that it prove in every instance that a respondent is taking positive action. Use in bad faith can be inferred from the totality of the circumstances even when the registrant has done nothing more than register the names").

In consideration of all the factors above, the Panel finds that the Respondent's actions in registering two of the disputed domain names yet leaving the sites inactive were registrations in bad faith, as when viewed together with the Respondent's actions in registering multiple domain names which infringe upon the Complainant's Trademarks, and the Respondent's offering of the inactive sites for sale, the Panel considers it likely that the Respondent had been passively holding onto the two domain names in order to prevent the Complainant from acquiring registration of the domain names so that the Complainant would have no other option but to purchase the domain names from the Respondent.

Accordingly, the Panel is satisfied that the element of bad faith as required by paragraph 5.2 of the Policy has been proven by the Complainant.

7. Conclusion

For all the foregoing reasons, in accordance with paragraph 12 of the Policy and paragraph 17.1 of the Rules, the Panel orders that the disputed domain names <wechatpay.my>, <wechatpay.com.my>, <tenpay.my>, <tenpay.com.my> and <weixin.com.my> be transferred to the Complainant.

DEEPAK A/L N CHANDRASEKARAN

SOLE PANELIST

6 OCTOBER 2017