

In the matter of

Between

Millennium & Copthorne Hotels plc

&

Millennium & Copthorne International Limited

(‘the Complainants’)

And

Everise Sales Sdn Bhd (Co. No.295183-T)

(‘the Respondent’)

Case No. : KLRCA/D/PFC-568-2018

1. The Parties

The Complainants are Millennium & Copthorne Hotels plc of Victoria House, Victoria Road, Horley, Surrey, United Kingdom and Millennium & Copthorne International Limited of Singapore, represented by Amica Law of Singapore.

The Respondent, Everise Sales Sdn Bhd, is unrepresented.

2. The Domain Name and Registrar

The disputed domain name <www.mhotel.com.my> is registered with the Malaysian Network Information Centre (MYNIC) (‘the Disputed Domain Name’).

3. Procedural History

The Complaint was filed with the Asian International Arbitration Centre, Kuala Lumpur (‘the Centre’) on 8 January 2018. On 8 January 2018, the Centre transmitted by e-mail to MYNIC a request for registrar verification in connection with the domain name at issue. On 14 February 2018, MYNIC transmitted by email to the Centre its verification response, confirming that the Respondent was listed as the registrant and provided the contact details for the administrative, billing and technical contact.

The Centre verified that the Complaint satisfied the formal requirements of MYNIC’S (.my) Domain Name Dispute Resolution Policy (‘the Policy’), the Rules for MYNIC’S (.my) Domain Name Dispute Resolution Policy (‘the Rules’), and the Supplemental Rules of the Centre (‘the Supplemental Rules’).

In accordance with the Rules, the Centre formally notified the Respondent of the Complaint and the proceedings commenced on 15 February 2018. In accordance with the Rules, the due date for Response was 12 March 2018. No response was filed by the Respondent.

The Centre appointed Hemalatha Parasa Ramulu as the sole panelist in this matter on 19 March 2018. The Panel finds that it was properly constituted. The Panel has

submitted the Declaration of Impartiality and Independence as required by the Centre to ensure compliance with the Rules.

4. Factual background

There are two Complainants to this Complaint, the first being Millennium & Copthorne Hotels plc and the second being Millennium & Copthorne International Limited. The First Complainant is a global hospitality management and real estate company which was incorporated under the laws of England and Wales in 1994. It has been listed on the London Stock Exchange since 1996 and is involved in the hotels, resorts, real estate and investment industries.

The Second Complainant is a wholly owned subsidiary of the First Complainant and functions, inter alia, as the management vehicle for the First Complainant for managing the First Complainant's hotels in Asia. The Second Complainant was incorporated in Singapore in 1996.

The First Complainant, through its subsidiaries such as the Second Complainant is the owner of M Hotel properties in Singapore, China, the United Arab Emirates and Saudi Arabia and Studio M Hotel in Singapore. The Complainants are part of the Millennium & Copthorne Group ('M & C Group').

The Second Complainant has registered and owns, inter alia, the M HOTEL, STUDIO

 M HOTEL, , and or HOTEL trade marks around the world and in Malaysia ('the M Family of Marks'). Amongst the various registrations that the Second Complainant has successfully acquired is Singaporean Trade Mark Number 40201515560R registered on 7 September 2015 for M HOTEL. The Second Complainant has also filed an application for M Hotel under application Nos. 2015009599 and 2015009600 for classes 35 and 43 respectively here in Malaysia which are still pending at this stage.

The Respondent is a private limited company incorporated in Malaysia since 1994. According to the entry on the Companies Commission of Malaysia the nature of their business includes trading in all kinds of computer hardware, software and other related products and as at the date of the complaint they appear to be still existing.

The Respondent registered the domain name <www.mhotel.com.my> on 28 June 2013.

5. Parties' Contentions





A. The Complainants

The Complainants collectively contend that the disputed domain name is identical to the Complainants' M Hotel World Marks and confusingly similar to the Complainants' M Hotel Malaysia Marks. They further contend that the disputed domain name is also confusingly similar to the M Family of Marks as a whole and each of them.

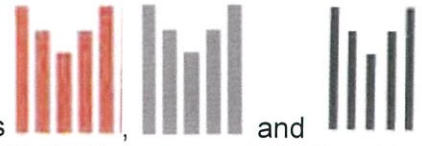
The Complainants claim that the Second Complainant has secured numerous trade mark registrations in Malaysia consisting of, or containing, the words 'M HOTEL' or the stylized letter 'M', all of which were applied for (in 1998 – 2009) before the Disputed Domain Name was registered in 2013. The Complainants further claim that the Second Complainant also owns numerous trade mark registrations around the world for the M HOTEL word marks, as well as for the M Family of Marks and that through these registrations the Complainants are clearly the owners of the M Hotel trade mark and M Family of Marks in Malaysia and around the world.

In further support of their argument, the Complainants rely on the Second Complainant's Malaysian Registered Trade Marks as set out in Table A as follows:

Table A

No.	Mark	Registration No.	Application date	Status	Class
1.		09010433	24.06.2009	Registered	35
2.		09010434	24.06.2009	Registered	43
3.		09010426	24.06.2009	Registered	43
4.		09010425	24.06.2009	Registered	35
5.	STUDIO M HOTEL	08025502	30.12.2008	Registered	43
6.	STUDIO M HOTEL	08025501	30.12.2008	Registered	35

In addition, the Complainants also claim that the Disputed Domain Name is also confusingly similar to the M Family of Marks, in particular those which have as their



key element the letter 'M', when stylized appears as , and , all of which were registered in Malaysia on 22.03.2007 under registration Nos. 07004993 (in class 35), 07004991 (in class 43) and 07004992 (in class 36) respectively in the name of the Second Complainant. The Complainants argue that since the M trade mark is wholly contained within the Disputed Domain Name, the addition of common, dictionary or descriptive terms, such as 'hotel' in this case will not be sufficient to prevent confusion.

The Complainants also argue amongst others that placing on the internet and use of the Disputed Domain Name has damaged the interests of the Complainants by injurious association, diversion of custom and tarnishment. In this regard the Complainants argue that registration of the Disputed Domain Name has the effect of diverting or distracting potential customers away from the Complainants' websites which have been registered as m-hotel.com (since 1999), mhotels.com.sg (since 2001), m-hotels.com (since 2002), mhotelchengdu.com (since 2011), mhotelsingapore.com (since 2012), m-hotelchengdu.com and mhotelchengdu.com (since 2013) all in the name of M & C Reservations Services Limited and mhotelchengdu.com.cn (since 2011) and m-hotel.cn (since 2012) in the name of Millennium & Copthorne Hotel Holdings (Hong Kong) Limited (collectively 'the Complainants' websites').

The Complainants' also rely on these websites (aside the M Hotel trade mark and the M Family of Marks) to further contend that the Respondent has registered and or used the Disputed Domain Name in bad faith since these websites were created even before the creation of the Disputed Domain Name and therefore the Respondent should have been aware accordingly.

The Complainants also argue that the Respondent has also used the Disputed Domain Name in bad faith as it resolves to a website providing a hotel service in direct competition with the Complainants. The Complainants argue that the Respondent is intentionally attempting to attract users to its website by creating a likelihood of confusion with the M Hotel trade mark and the M Family of Marks as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

B. Respondent

Although the Complaint was properly notified to the Respondent, as required by the Rules, the Respondent did not file a Response. In the absence of a Response, it is appropriate to accept as true all factual allegations of the Complaint. (*See Ticketmaster Corporation v Bill Hicks, WIPO Case No. D2004-0400, Elan Pharmaceuticals, Inc. v Randy Haag, WIPO Case No. D2001-0755*)

6. Discussion and Findings

Paragraph 5.2 of the Policy requires that the Complainant must prove each of the following:

- (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 Domain Name has been registered and/or is being used in bad faith.

Paragraph 6.1 of the Policy illustrates four circumstances that, if proved constitute evidence of bad faith as required by Paragraph 5.2.

A. Identical or Confusingly Similar

The Complainants have relied on a number of registered trade marks registered in the name of the Second Complainant for this purpose, including Malaysian Trade Mark Registration Nos. 09010433 and 09010434, where each of these trade marks appear



to have as a dominant feature the trade mark and a disclaimer to each of these registrations indicates that the protection afforded therein shall give no right to the exclusive use of the letter 'M' and the word 'Hotel' that suggests that these marks should be construed as a whole.



The non-textual element of these trade marks, being the trade mark, does not, in the Panel's opinion, detract in any way from the prominence of the word elements of the mark. As this non-textual element is incapable of representation in a domain name, it may be disregarded for the purpose of assessing identity or confusing similarity. As such, and also having regard that it is not the *entire* textual component of these Second Complainant's trademarks that have been disclaimed but in the letter 'M' and the word 'HOTEL' separately, and disregarding the ccTLD from the Disputed Domain Name, the Panel finds that the first element under the Policy has been established as the Disputed Domain Name has incorporated the Complainants' 'M Hotel' trade mark in its entirety. (See *Celik Motor Ticaret A.S. v ONUNO L.L.C*, WIPO Case No.D2015-0369)

Additionally, the Complainants have enjoyed common law rights in the 'M Hotel' trade mark which use, at least in Singapore, can be seen since 2002 from various articles that have appeared in the international press including the Business Times and the Travel Trade Gazette Asia where coverage was given on the establishment of its first hotel in the name of M Hotel in Singapore. This gave rise subsequently to the establishment of a number of hotels in the name of M Hotel including in Chengdu China and Dubai. Given that the term 'trade mark or service mark' in Paragraph 5.2(i) of the Policy envisages both registered and common law marks, this requirement has been further satisfied by the Complainants (*Uniroyal Engineered Products, Inc v Nauga Network Services*, WIPO Case No. D2000-0503, *Thaigem Global Marketing Limited v Sanchai Aree*, WIPO Case No.D2002-0358).

Furthermore, the Second Complainant has successfully acquired Singaporean Trade Mark Number 40201515560R registered on 7 September 2015 for 'M HOTEL' and has established that at the time the complaint was filed it has acquired registered trade mark rights over the same. (*Madrid 2012, S.A. v Scott Martin-MadridMan Websites*, WIPO Case No. D2003-0598, *Stoneygate 48 Limited and Wayne Mark Rooney v Huw Marshall*, WIPO Case No. 2006-0916)

Based on the Complainants' enjoyment of rights over the 'M Hotel' trade mark in Singapore by in itself satisfies the threshold requirement of having trade mark rights contemplated under Paragraph 5.2(i) of the Policy. (See *Hoffman-La Roche AG v Relish Enterprises*, WIPO Case No.D2007-1629, *RapidShare AG and Christian Schmid v majeed randi*, WIPO Case No. D2010-1089)

The Panel observes that although the Second Complainant has the necessary interest as a result of amongst others the registration of the trade marks referred above in its name, the Complaint has been filed together with the First Complainant. Although no documentary evidence has been produced with regard to the parent-subsidiary relationship between the First and Second Complainant, the Panel is prepared to accept this statement which is certified in the Complaint to be accurate and that the First Complainant has rights in the trade marks referred to which are either registered in the name of or are owned in common law by the Second Complainant, a wholly owned subsidiary of the former. (See *Grupo Televisa, S.A., Televisa, S.A. de C.V., Estrategia Televisa, S.A. de C.V., Videoserpel, Ltd. v Party Night Inc. a/k/a Peter Carrington*, WIPO Case No. D2003-0796)

B. Bad Faith

The next element which the Complainants must satisfy the Panel on in terms of Paragraph 5.2 of the Policy is that the Disputed Domain Name has been registered and or is being used in bad faith. For the purposes of satisfying this limb, the Policy provides a set of non-exclusive as well as merely illustrative situations that the Complainant might use to prove bad faith. Grounds other than those set out, while not codified might be used to establish bad faith as well. (See *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#)). The Complainants in the present complaint contend that they are able to satisfy both registration as well as use of the Disputed Domain Name in bad faith.

The Complainants argue that as the Disputed Domain Name was registered well after the Complainants had traded in and acquired trade mark rights in the 'M Hotel' trade mark and the M Family of Marks, such conduct by the Respondent in itself is sufficient for a finding of bad faith registration. It is also contended that the Complainants' websites have been in operation prior to even the creation of the Disputed Domain Name.

On the basis of the longstanding use and popularity of the 'M Hotel' trade mark and the M Family of Marks the Complainants suggest that it is likely that the Respondent was aware of the Complainants and their rights in the 'M Hotel' trade mark and the M Family of Marks when it registered the Disputed Domain name which it proposes constitutes bad faith. Alternatively, the Complainants argue that even if the Respondent was not so aware of the Complainants' trade mark rights, the Respondent clearly should have been so aware and any lack of awareness amounts to recklessness on the latter's part.

As for use in bad faith, the Complainants contend among other things that the Disputed Domain Name resolves to a website providing a hotel service in direct competition with the Complainants and that the Respondent is intentionally attempting to attract users to its website by creating a likelihood of confusion with the Complainants' 'M Hotel' trade mark and the M Family of Marks as to the source, sponsorship, affiliation or endorsement of the Respondent's website. This, they argue, diverts consumers away from the Complainant's official websites and allows the Respondent to reap unfair

commercial gain. The Complainants have adduced a copy of a web page dated 18.09.2017 to which the Disputed Domain Name resolved which shows the



complainant of in display, to support their arguments on bad faith. The Complainants have disclosed that the web page of the Disputed Domain Name when resolved discloses an entity at the bottom of its page i.e. one M Hospitality Group Sdn Bhd (Co. No. 980056-T) which is different from the Respondent. The Complainants have further disclosed that the Second Complainant has commenced a trade mark infringement action vide Kuala Lumpur High Court Civil Suit No. WA-22IP-27-06/2017 against M Hospitality Group Sdn Bhd, however it is for use of amongst



others the mark in respect of the operation, management and other business dealings of or in relation to their hotel which is claimed as having occurred after the registration of Malaysian Trade Mark Registration Nos. 09010433 and 09010434 on 24.06.2009. In this respect, the Complainants have provided a copy of the sealed Writ and Statement of Claim which claims that M Hospitality Group Sdn Bhd are carrying on business as an operator, manager and or owner of a hotel at its principal place of business in Puchong, Kuala Lumpur, Malaysia under the name 'M Hotel'. There appears to be no evidence as to whether the Respondent and M Hospitality Group Sdn Bhd are in any way related companies or for how long the said hotel has been in operation. There also appears to be no civil action commenced in respect of the Disputed Domain Name.

It is observed that the Complainants have relied entirely on the grounds that their 'M Hotel' trade mark and the M Family of Marks are widely known to substantiate their bad faith argument. Although the Complainants contend that the Disputed Domain Name is an unusual combination of words, thereby suggesting that their own 'M Hotel' trade mark is an unusual combination of words, the historical basis for this combination is actually much simpler. According to a statement made by the First Complainant's Chairman, Kwek Leng Beng in an article in the Business Times dated 9 July 2002, 'M Hotel' was created as an abbreviation of 'Millennium', a mark the Complainants and their affiliated companies had previously used for their hotels but were subsequently not permitted to do so following an action filed by one Pontiac Marina. At the time therefore, according to the article, the 'M Hotel' was not expected to be used outside of Singapore as the Chairman himself thought that they could come up with a better concept than 'M Hotel'. Since then, there have only been established three (3) other hotels bearing the 'M Hotel' trade mark outside of Singapore which include China, United Arab Emirates and Saudi Arabia. The Complainants have further conceded that in the near future there are only two (2) other properties slated for launch as an 'M Hotel' and a 'Studio M Hotel' which are to be constructed in Auckland, New Zealand and Suzhou China, respectively.

In respect of actual knowledge, the Complainants have not provided any evidence that the Respondent registered the disputed domain name with knowledge of the Complainants' possible rights in the term 'M Hotel'. The Complainants neither claim business activities in Malaysia in respect of the term 'M Hotel', where the Respondent is located, nor any other circumstances supporting the assumption that the Respondent should have been aware of the Complainants and its possible rights in the term 'M Hotel' in Malaysia at the time of the registration of the disputed domain name. (see *Leyton & Associés (SAS), Thésée (SAS), Leyton Consulting UK and Ireland Limited, Leyton Maroc, Leyton Belgium, Leyton UK Limited v. Drela Mateusz, Elephant Orchestra*, [WIPO Case No. D2009-1589](#))

Other than the registered trade marks relied on by the Complainants, there are no facts or compelling evidence in this proceeding indicating why the Respondent would identify the term 'M Hotel' with the Complainants. It is indisputable that the Complainants have neither hotels in Malaysia in the name of 'M Hotel' currently nor do they have plans to set up any in Malaysia in the said name in the near future.

The Complainants have on the other hand brought to the attention of this Panel that the Disputed Domain Name resolves to a web page that shows a hotel bearing the 'M Hotel' mark in fact exists. The Complainants claim that this hotel is owned by one M Hospitality Group Sdn Bhd and it is being operated and managed at its principal place of business in Puchong, Kuala Lumpur, Malaysia.

In respect of the evidence supplied to this Panel concerning the Respondent, it has been somewhat limiting and not entirely ideal. The Disputed Domain Name according to the printout from a search conducted on whois.mynic.my shows that it has been registered in the name of the Respondent since 28.06.2013. According to the entry on the Companies Commission of Malaysia the nature of their business as indicated earlier simply suggests that it trades in all kinds of computer hardware, software and other related products. There appears to be no evidence to determine how the Respondent, a computer hardware and software company, may be connected to M Hospitality Group Sdn Bhd. The printout details on the Disputed Domain Name show various other details including details of an individual, phone number and an e-mail address that has a different domain name (www.e-soft.com.my) but this Panel is not guided whether the Complainants explored or made use of that information to obtain further details concerning the Respondent which may have been of use for this Panel in making a determination as to how M Hospitality Group Sdn Bhd may have come about gaining use of the Disputed Domain Name from the Respondent.

It seems to this Panel at least that short of the evidence other than the 'M Hotel' trade mark and the M Family of Marks relied on, the Complainants claim that the Respondent had actual knowledge of the Complainants' 'M Hotel' trade mark and the M Family of Marks and therefore had registered the Disputed Domain Name as a result thereof has not been made out.

With regard to constructive notice however, the Panel notes that there a number of Panel decisions which have now addressed the application of paragraph 2 of the Policy and in particular the words under paragraph 2.3 which states that it is the sole responsibility of the Respondent to make sure that their registration and any subsequent renewal of the domain name does not infringe the rights of any third parties. There are cases where a finding of bad faith registration can indeed be confirmed by the specific circumstances of a respondent's so-called "wilful blindness", even if the respondent did not specifically know of the complainant or of its trademark rights when it registered the disputed domain name (see *Media General Communications, Inc. v. Rarenames, WebReg*, [WIPO Case No. D2006-0964](#); *Mobile Communication Service Inc. v. WebReg, RN*, [WIPO Case No. D2005-1304](#); *mVisible Technologies, Inc. v. Navigation Catalyst Systems, Inc.*, [WIPO Case No. D2007-1141](#); *Grundfos A/S v. Texas International Property Associates*, [WIPO Case No. D2007-1448](#); *Balglow Finance S.A., Fortuna Comércio e Franquias Ltda. v. Name Administration Inc. (BVI)*, [WIPO Case No. D2008-1216](#)).

The obligations imposed by paragraph 2 are an integral part of the Policy applicable to all registrants that cannot be ignored. (see *City Views Limited v. Moniker Privacy Services/Xander, Jeduyu, ALGEBRALIVE*, [WIPO Case No. D2009-0643](#)). In this case, it is uncertain whether the Respondent explored the possibility of third-party rights in any way before registering and using the Disputed Domain name. It is incumbent upon

a domainer to make reasonable good faith efforts to avoid registering and using domain names that are identical or confusingly similar to marks held by others.

It is uncertain what would have been the outcome had the Respondent conducted a search for the name 'M Hotel' on Google, Yahoo!, or other Internet search engines as the Panel has not been supplied with a list of hits resulting from such searches. While there has been reliance on the Complainants' websites, there appear to be no documents disclosing what the pages of those websites would have resolved to, in order to assist this Panel. The production of such evidence would have assisted this Panel in determining the Complainants' extent of use of the 'M Hotel' trade mark on the internet. Be that as it may, a search on the Malaysian Trade Mark Registry would have disclosed the various marks registered by the Second Complainant including Malaysian Trade Mark Registration Nos. 09010433 and 09010434 in the name of the Second Complainant. The Complainants have also produced web pages that refer to all four (4) hotels that currently use the 'M Hotel' trade mark in Singapore, Chengdu China, Dubai United Arab Emirates and Makkah Saudi Arabia. This would suggest that had the Respondent conducted the appropriate searches it would have been known to them that there was a potential infringement of the rights of third parties.

Furthermore, it is not disputed that the Disputed Domain Name registered by the Respondent now resolves to a site that discloses use of the 'M Hotel' mark by M Hospitality Group Sdn Bhd, a competitor of the Complainants. The Respondent, by maintaining the Disputed Domain Name in its name all of these years and having allowed use of it to M Hospitality Group Sdn Bhd is deriving some benefit from the arrangement that may include a financial benefit from web traffic diverted through the Disputed Domain Name. This Panel therefore finds, that the Respondent by registering the Disputed Domain Name did so, with an intention to attract or divert for commercial gain, Internet users to a website of the Complainants' competitors by creating a possibility of confusion or deception that the website is operated or authorised by or otherwise connected with the Complainants and or its trade marks. (See *NBC Universal Media, LLC v. Flying Stingrays Ltd, Jim Macallum*, WIPO Case No. D2012-1568)

The Panel notes that the Complainants have advanced the proposition that it may be appropriate to draw an inference of 'targeting' in the present case. To support this argument, the Complainants have again, relied only on their claim of popularity of the 'M Hotel' trade mark and the M Family of Marks.

It is to be observed that based on the decisions of earlier Panels, an inference of targeting is made where the complainant's mark is either inherently distinctive, famous, or well known, but that no such inference will normally be appropriate in other cases where there is no evidence of the respondent being aware of the complainant's trademark rights at the time of registration. No such inference would however be made in a case where the domain name is a dictionary word, or a descriptive or generic expression. (See *Grundfos A/S v. Texas International Property Associates*, WIPO Case No. D2007-1448) In the absence of any argument to the contrary, this Panel is prepared to find that the Disputed Domain Name is either inherently distinctive, famous, or well known and particularly given the findings of wilful-blindness on the part of the Respondent and their further breach under paragraph 6.1(iv)(b) of the Policy, that targeting of the Complainants' 'M Hotel' trade mark has been committed.

Accordingly the Panel is able to find that the Complainants have met their burden of proof to establish that it is more likely than not the Respondent had registered and used the Disputed Domain Name in bad faith.

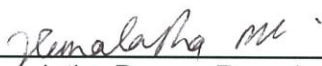
C. Rights and legitimate interest

Unlike the Uniform Domain Name Dispute Resolution Policy ('UDRP') which provides that the complainant has the burden of proof to establish that the respondent has no right or legitimate interest in respect of the domain name, paragraph 7.1 of the Policy shifts the onus on to the respondent, once the complainant has satisfied the requirements of Paragraph 5.2 of the Policy, to lead evidence that the respondent has a right or legitimate interest in respect of that name. Paragraph 7.2 of the Policy offers a number of non-exhaustive defences that the Respondent could advance and avail itself to in resisting an allegation that it had registered and used the Disputed Domain Name in bad faith.

For the completeness of this decision and having regard to the fact that the Respondent is a computer hardware and software company this Panel is unable to find that the Respondent would be able to rely on any of the defences under paragraph 7.2 of the Policy. The failure of the Respondent to respond to this Complaint also weighs heavily against the Respondent in this regard.

7. Decision

For all the foregoing reasons, and in accordance with Paragraphs 3.1 of the Policy and 17 of the Rules, the Panel orders that the Disputed Domain Name <www.mhotel.com.my> be transferred to the Complainants.



Hemalatha Parasa Ramulu
Single Panellist
Dated this 6th day of April 2018