

## ADMINISTRATIVE PANEL DECISION

In the matter of

Between

U MOBILE SDN BHD ("**Complainant**")  
(Company No. 223969-U)

And

WEB ID MANAGEMENT ("**Respondent**")  
(Business Registration No. 002657102-A)

Case ID.: AIAC/D-602-2018

### 1. The Parties

- 1.1 The complainant is U Mobile Sdn Bhd (Company No.: 223969-U), a company having its registered address at Unit 30-01, Level 30, Tower A, Vertical Business Suite, Avenue 3, Bangsar South, No. 8, Jalan Kerinchi, Kuala Lumpur, 59200 Wilayah Persekutuan, Malaysia ("**Complainant**").
- 1.2 The respondent is Web ID Management (Business Registration No.: 002657102-A), a partnership with an address at 18-1, Jalan Tasik Utama 5, The Trillium Lakefields, Sg. Besi 57000 Kuala Lumpur, Wilayah Persekutuan, Malaysia ("**Respondent**").

### 2. The Domain Name and Registrar

The disputed domain name <umobile.com.my> was registered on 22 August 2017 ("**Respondent's Domain Name**").

### 3. Procedural History

The Complaint was filed at the Asian International Arbitration Centre ("**AIAC**") (formerly known as Kuala Lumpur Regional Centre for Arbitration) under the MYNIC's (.my) Domain Name Dispute Resolution Policy ("**MYDRP**") on 9 July 2018 by hand as well as by electronic mail.

The AIAC has verified that the Complaint lodged is in compliance with the formal requirements set out in the MYDPR, the Rules of the MYNIC's (.my) Domain Name Dispute Resolution Policy ("**Rules**") and the Supplemental Rules of the AIAC ("**Supplemental Rules**") and the same has been assigned with a case ID.: AIAC/D-602-2018 ("**Complaint**").

Pursuant to Rule 6 of the Rules and Paragraph 6 of the Supplemental Rules, the last day for the Respondent to submit its response to the Complainant and to the Centre was on 9 August 2018. The Respondent, however, has failed to submit its response within the stipulated timeframe.

The Complainant having elected for a single member panel, the AIAC has appointed Mr. Brian Law Yew Foo as the sole panellist on 15.08.2018 ("**Panel**"). The Panel has

submitted the Declaration of Impartiality and Independence, as required by the AIAC to ensure compliance with Paragraph 9.3 of the Rules.

#### 4. Factual Background

The following sets out the facts as submitted by the Complainant:

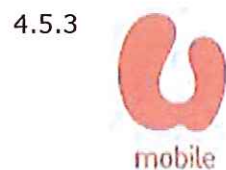
- 4.1 The Complainant is one of the major telecommunications providers in Malaysia.
- 4.2 The Complainant is a full-fledge mobile operator which offers data, voice and messaging services to individuals and corporate customers via prepaid, post-paid and broadband plans. The Complainant operates telecommunications network infrastructure which supports, among others, high-speed mobile broadband.
- 4.3 The Complainant has been providing its telecommunications services under the famous UMOBILE House Mark for over a decade now since the launch of its telecommunications services in September 2007.
- 4.4 The Complainant is the registrant of the following domain names:

| No. | Domain Name     | Creation / Registration Date |
|-----|-----------------|------------------------------|
| 1.  | umobile.my      | 4 March 2008                 |
| 2.  | umobile.net.my  | 6 February 2008              |
| 3.  | u-mobile.my     | 4 March 2008                 |
| 4.  | u-mobile.com.my | 6 February 2008              |
| 5.  | u-mobile.net.my | 8 January 2008               |
| 6.  | u.my            | 4 March 2008                 |
| 7.  | u.net.my        | 6 February 2008              |
| 8.  | u.com.my        | 6 February 2008              |

See: EXHIBIT 2 of the Complaint.

- 4.5 The Complainant is the legal and common law owner of the "umobile" trade mark and the "U" device mark as below in Malaysia as, which the Complaint has collectively referred to as the **"UMOBILE House Marks"**.

4.5.1 **umobile**



- 4.6 The Complainant is the registered proprietor of the UMOBILE House Marks in various classes of goods and services in Malaysia as set out in paragraph 5.4 of the Complaint.  
See: EXHIBITS 3 & 4 of the Complaint.
- 4.7 The Complainant has also registered other trade marks incorporating the UMOBILE House Marks.  
See: EXHIBIT 4 of the Complaint.
- 4.8 The Complainant asserts that the UMOBILE House Marks are well-known due to their extensive use in Malaysia.  
See: Paragraph 6.6 of the Complaint.
- 4.9 The Respondent had registered the Respondent's Domain Name on 22 August 2017.  
See: EXHIBIT 1 of the Complaint – Printouts of the Whois Database search and the CCM search on the Respondent.
- 4.10 As such, the Respondent had only registered the Respondent's Domain Name years after the Complainant's domain names and trade marks were registered in Malaysia.
- 4.11 An online search by the Complainant revealed that the website with the Respondent's Domain Name is a parking page that contains links to <http://irmaweb.com/>. The Complaint's position is that from the screenshot of the said page that it is an inactive site and was and is merely redirecting Internet traffic to <http://irmaweb.com/>.  
See: EXHIBIT 20 of the Complaint.

## **5. Parties' Contentions**

- 5.1 The Complainant contends that the Respondent's Domain Name is identical to the UMOBILE House Marks for the following reasons:
- 5.1.1 the Respondent's Domain Name incorporates the Complainant's UMOBILE House Marks in its entirety with the addition of a gTLD ".com" and a ccTLD ".my".
- 5.1.2 the distinguishing and relevant part of the Respondent's Domain Name <umobile> is identical to the Complainant's UMOBILE House Marks in all aspects.
- 5.2 The Respondent is an inactive holder of the Respondent's Domain Name as the website under the Respondent's Domain Name is a parking page that contains links to <http://irmaweb.com/>. The Complainant contends that nonetheless the Respondent had acted on bad faith in registering and using the Respondent's Domain Name for the following reasons:
- 5.2.1 An online search on the Respondent revealed the blog of Mohamad Shukri, one of the owners of the Respondent – <http://blog.domainreit.com.my/>.
- 5.2.2 Two (2) site visits to the Respondent's address as listed on the Respondent's business profile as per the CCM search dated 20 March 2018 and 29 March 2018 revealed that the Respondent's purported place



of business was closed and dark, and appeared to be inhabited by squatters.

- 5.3 The Complainant therefore contends that the Respondent is not making any legitimate fair use of the Respondent's Domain Name other than to register the same. The website under the Respondent's Domain Name is a parking page that contains links to <http://irmaweb.com/> and a notice that it will be used in respect of a new website powered by Irmaweb.com that is under construction. The Complainant claims that such inactive holding of the Respondent's Domain Name constitutes bad faith in relation to the registration and/or use of the Respondent's Domain Name.
- 5.4 Further or alternatively, the Complainant contends that the Respondent's Domain Name is registered and/or used mainly to sell, rent or transfer the Respondent's Domain Name for a profit as the same redirects Internet users who click on the link "Contact Sales" displayed on the website to a page related to the Respondent which enables any inquiry to be submitted to the "Sales Department", including an inquiry of the possibility of purchasing the Respondent's Domain Name.  
See: EXHIBIT 21 of the Complaint.
- 5.5 Further or alternatively, the Complainant contends that the Respondent has registered and/or is using the Respondent's Domain Name for the purposes of and with the intention to attract or divert Internet users for commercial gain:
- 5.5.1 The Respondent's Domain Name redirects Internet users who click on the links "Go to IrmaWeb.com", "Support & Resource Center", "Contact Sales" or "Star Website" displayed on the website of the Respondent's Domain Name to <http://irmaweb.com/> that appears to be associated with the Respondent.
- 5.5.2 From the website under <http://irmaweb.com/>, the operator claims to be offering various services relating to domain names and websites including domain registration, web hosting, web development, e-commerce hosting and email marketing.  
See: EXHIBIT 22 of the Complaint.
- 5.5.3 The registrant of <http://irmaweb.com/> shares the same address as the Respondent.  
See: EXHIBIT 23 of the Complaint.
- 5.5.4 The Complainant hence contends that the Respondent's registration and use of the Respondent's Domain Name is in bad faith and purely intends to divert Internet users to an alternative website to which the Respondent is related to, thereby building traffic with the ultimate intention of selling the Respondent's Domain Name for a profit.
- 5.6 The Complainant contends that the Respondent has no legitimate interests in respect of the Respondent's Domain Name. The consent of the Complainant was not obtained at any time nor was the Respondent at any time associated with the Complainant or their registered trade marks and domain names.
- 5.7 The Complainant contends the registration of the Respondent's Domain Name should be transferred to the Complainant.
- 5.8 The Respondent did not reply to the Complainant's Complaint.

## **6. Discussion and Findings**

Paragraph 17.1 of the Rules provides 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 applicable 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 The Respondent defaulted in submitting a response**

6.1.1 It is important at this juncture to note that the Respondent did not reply to the Complainant's case nor has the Respondent submitted any evidence to rebut the Complainant's case.

6.1.2 The panel in *Alibaba Group Holding Limited v Microit Technology (M) Sdn Bhd* (Case No RCA/DNDR/2012/28) found that as there was no response from the Respondent, the facts proffered in support of the Complaint must therefore be accepted as unchallenged. Similarly, the panel in *Paypal, Inc v Webpod.com* (Case No. KLRCA/DNDR/2011/24) found that in the absence of the Respondent's side of the story, there is no conceivable reason to dispute the assertions of the Complainant.

6.1.3 Guided by the above decisions, the Panel holds that in the absence of the Respondent's reply and/or evidence, the facts and evidence asserted by the Complainant must be accepted when considering the merit of the Complaint.

### **6.2 Identical or Confusingly Similar Trade Mark**

The Panel is satisfied that the Complainant has adduced sufficient evidence to prove its ownership in the registered domain names and the trade marks.  
See: EXHIBITS 2 to 4 of the Complaint.

The Panel is also satisfied that by making reference to the multiple UDRP cases where it was found that where Complainant was able to provide evidence of trade mark registration, such Complainant's rights in respect of the trade mark are established and undisputed (*Prada S.A. v. Oleg Filipov-Guevreyan*, Case No DLA20040001; *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 FilipovGuevreyan*, Case No DLA2003-0004; *Consitex S.A., Lanificio Ermenegildo Zegna & Figil S.p.A., Ermenegildo Zegna Corporation v. Oleg FilipovGuevreyein*, 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 used the term "UMOBILE House Mark" to describe three (3) trade marks collectively as stated in paragraph 5.3 of the Complaint whereby two (2) of them are composite marks consisting the word "umobile" and a "U" device (see paragraphs 5.3.1 and 5.3.3) and the other mark consisting the "U" device in series (see paragraph 5.3.2). In the Complaint, the Complainant has made comparison between the Respondent's Domain Name and the "UMOBILE House Mark" and this should be discouraged.

The Panel has taken note that the word mark "umobile" is registered as a trade/service mark under various registrations as stated in paragraph 5.4 of the Complaint.

To determine if the Respondent's Domain Name has used an identical or confusingly similar trade mark, the precise comparison should and ought to be made between the Complainant's mark "umobile" as shown in paragraph 5.4. no. (i) to (xv) and the Respondent's Domain Name <umobile.com.my> and not the "U" device as asserted by the Complainant under the defined term "UMOBILE House Mark".

The Respondent's Domain Name <umobile.com.my> has therefore clearly incorporated the mark "umobile" with the additions of a gTLD ".com" and a ccTLD ".my". It is trite that the addition of top-level domains is immaterial when determining whether the disputed domain name is identical or confusingly similar with the relevant trade mark as the inclusion of top level domain names is a technical requirement and is therefore inconsequential in order to determine the similarity of the domain name to the mark. This principle has been well established in a number of domain name decisions, including Google Inc v Digiattack, Case No:rca/dndr/2009/17 (KLRC April 24, 2009) and Rollerblade, Inc. v. McCrady, D2000-0429 (WIPO June 28, 2000), where it was found 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.

Following from the above, the Panel finds that without considering the top-level domains, the Respondent's Domain Name contains the Complainant's "umobile" mark in its entirety. The Panel has taken note that the past panels have found that where a disputed domain name encompasses and captures a complainant's trade mark in its entirety, the disputed domain name should be and ought to be found to be confusingly similar to that trade mark (Uniroyal Engineered Products, Inc. v. Nauga Network Services, D2000-0503 (WIPO July 18, 2000)).

Premised on the above, the Panel finds that the disputed domain name is confusingly similar and identical to the Complainant's registered "umobile" mark.

## **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 preparation 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 failure of the Respondent in responding to the Complaint effectively means that the Respondent has failed to proffer any explanations and justifications. Therefore, there is no evidence on record to demonstrate that the Respondent has rights or legitimate interests in respect of the Respondent's Domain Name or it has acquired any trade mark right in the same (Budget Rent A Car System Inc v Budget-Rent-A-Car Sdn Bhd (rca/dndr/2008/15)).

Accordingly, the Panel finds that the Respondent has failed to establish any right or legitimate interest in the Respondent's Domain Name 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 registrant's 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, the Complainant contends that the Respondent was directing Internet traffic for the Respondent's Domain Name to <http://irmaweb.com/> and on this site, the Respondent was offering the Respondent's Domain Name for sale.

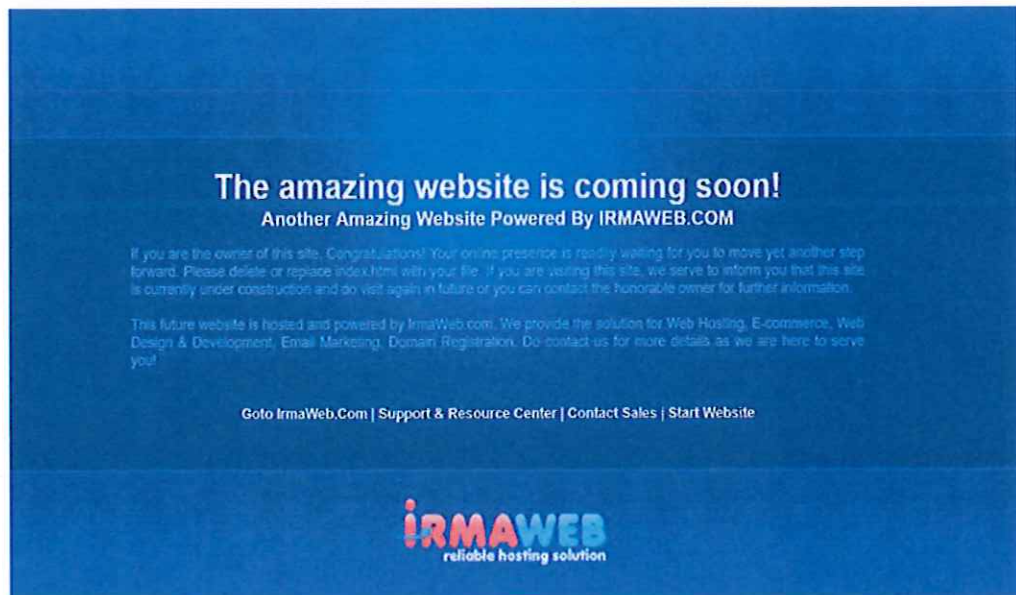
The Panel has examined the wordings as showed in the screenshot of the website under the Respondent's Domain Name – see last page of EXHIBIT 18 of the Complaint: -

*"If you are the owner of this site, Congratulations! Your online presence is readily waiting for you to move yet another step forward. Please delete or replace index.html with your file. If you are visiting this site, we serve to inform*

*you that this site is currently under construction and do visit again in the future or you can contact the honorable owner for further information.*

*This future website is hosted and powered by IrmaWeb.com. We provide the solution for Web Hosting, E-Commerce, Web Design & Development, Email, Marketing, Domain Registration. Do contact is for more details as we are here to service you!"*

Below is the representation of the website under the Respondent's Domain Name extracted from Exhibit 18 of the Complaint: -



Based on the reading of the wordings, in particular, the words "*the future website is hosted and powered by IrmaWeb.com*" clearly indicate that the website is a parking page and if anyone has an interest to own or purchase the website with the Respondent's Domain Name, such person is asked to contact <http://irmaweb.com/> for more details. Should anyone click on the link "Goto IrmaWeb.Com", such person will then be directed to <http://irmaweb.com/> as shown in Exhibits 21 and 22 of the Complaint where various enquiries can be made, and very likely - enquiry to purchase the Respondent's Domain Name can also be made.

Further, the Panel finds that given that the Complainant's "umobile" mark is extensively used in Malaysia and also taking into account that the Complainant has been marketing and providing services using the same mark since 2007, in electing to register the Respondent's Domain Name with the exact word as the Complainant's "umobile" mark and thereafter directing the Internet traffic to the Respondent's Domain Name to the Respondent's site, the Respondent had demonstrated its knowledge of the Complainant's "umobile" mark, brand and business.

In light of the above, it is the Panel's findings that:-

- a. it is a convincing conclusion that the registration of the Respondent's Domain Name is mainly with the intention and/or for the purposes of selling, renting, transferring the same for profit to the Complainant or its



competitors or some other interested parties and hence, such action constitutes bad faith under Paragraph 6.1(a) of the Policy.

- b. that the Respondent has been intending to use the Complainant's goodwill and reputation to attract or divert Internet users to the registrant's website 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 trademark, which constitutes bad faith under Paragraph 6.1(d) of the Policy.


The Panel agrees that the Respondent's action of registering the disputed domain name yet not making use the domain names for any purpose further indicates bad faith 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.) Further, the use in bad faith can be inferred from the totality of the circumstances even when the registrant has done nothing more than registering the names (Twentieth Century Fox Film Corp. v. Risser, FA 93761 (NAF May18, 2000)).

In view of the aforesaid, the Panel finds that the Respondent's actions in registering the Respondent's Domain Name which infringes the Complainant's "umobile" mark yet leaving the site inactive were registration in bad faith.

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**

Premised on the above, in accordance with Paragraph 12 of the Policy and Paragraph 17.1 of the Rules, the Panel orders that the disputed domain names <umobile.com.my> be transferred to the Complainant.



BRIAN LAW YEW FOO  
SOLE PANELLIST  
5 SEPTEMBER 2018