

ADMINISTRATIVE PANEL DECISION

In the matter of a domain names dispute
Case No.: AIAC/DNDR-728-2019

Between

Moobility Telecom International Holding Ltd.
(d/b/a Virgin Mobile Middle East & Africa)

... Complainant

And

Ceres Telecom Sdn. Bhd.

... Respondent

1. The Parties

- 1.1 The Complainant is Moobility Telecom International Holding Ltd. (d/b/a Virgin Mobile Middle East & Africa)(BVI Company No.: 1037112), a company incorporated in the British Virgin Island having its registered address at ILS Fiduciary (BVI) Limited, Mill Mall, Suite 6, Wickhams Cay 1, P.O. Box 3085, Road Town, Tortola, British Virgin Island.
- 1.2 The Respondent is Ceres Telecom Sdn. Bhd. (Company No.: 959540-V), a company incorporated in Malaysia having its registered address at Level 7, Menara Milenium, Jalan Damansara, Pusat Bandar Damansara, Damansara Heights, 50490 Kuala Lumpur.

2. The Disputed Domain Names and The Registrar

- 2.1 The details of the disputed domain names are as follows:-

Disputed Domain Names	Registration No.	Registration Date	Registrar
friendimobile.my	D6A101686	10-07-2012	MYNIC Berhad
friendi.my	D6A101685	10-07-2012	MYNIC Berhad
friendimobile.com.my	D1A201986	10-07-2012	MYNIC Berhad
friendi.com.my	D1A201985	10-07-2012	MYNIC Berhad

(collectively the "Disputed Domain Names")

3. Procedural History


- 3.1 The Complaint was filed at the Asian International Arbitration Centre ("**Provider**"). The Provider 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 Supplementary Rules of the Asian International Arbitration Centre (the "**Supplemental Rules**") in respect of the Disputed Domain Names.
- 3.2 In accordance with Rules 5.2 and 5.3 of the Rules, the Provider formally notified the Respondent of the Complaint and the proceedings commenced on 16 July 2019. Pursuant to the Rules, the due date for the Respondent to submit its Response was 7 August 2019. No Response was submitted by the Respondent.
- 3.3 The Complainant has elected for a single member panel. On 13 August 2019, the Provider appointed Chew Kherk Ying as the sole panelist in this matter. The panelist has submitted the Declaration of Impartiality and Independence and the case file was transmitted to the Panel on 13 August 2019.

4. Factual Background

- 4.1 The Complainant, founded in 2006, offers mobile telecommunications services across the Middle East and North Africa region as a Mobile Virtual Network Operator.
- 4.2 The Complainant is the owner of the FRiENDi mark and has in its Complaint referred to the following trade mark registrations in Malaysia in lodging the Complaint:-

Trade mark	Jurisdiction	Registration No.	Class	Registration Date
	Malaysia	2012005059	38	28-03-2012
FRIENDI	Malaysia	2012005061	38	28-03-2012

(collectively the "**FRiENDi Marks**")

- 4.3 The Complainant also owns a trade mark registration no. 2012005060 registered on 28 March 2012 in Class 38 for the  device. Copies of the Complainant's trade marks registration certificates are attached as Tabs 5, 6 and 7 of the Appendix to the Complaint.

- 4.4 The Complainant has also referred to a number of trade marks registrations in other jurisdictions such as Bahrain, Egypt, Jordan, Kuwait, Lebanon, Morocco, Oman, Pakistan, Qatar, South Africa, the UAE and Yemen in Tab 8 of the Appendix.
- 4.5 The Complainant sets up operating companies in various countries to offer mobile telecommunications services under the FRiENDi brand.

5. Parties' Contentions

- 5.1 The following are the Complainant's contentions.
- 5.2 The Complainant claims that the Respondent was established in 2011 by the Complainant to act as the Complainant's operating company in Malaysia, at which point the Complainant owned a majority share in the Respondent via a 100% wholly owned subsidiary, Connect Mena Limited. The Complainant also asserts that the standard business practice is to register local domain names in the name of the local subsidiary company it establishes and control. As such, the Disputed Domain Names were registered through the Respondent in or around July 2012.
- 5.3 Further, the Complainant also claims that the administrative contact for the Disputed Domain Names was the CTO of the Complainant, Mr. Kim Askjaer despite the Respondent being the registrant for the Disputed Domain Names, to ensure the Complainant retained control of the Disputed Domain Names. The Complainant had arranged payment for all the administration and renewal cost of the Disputed Domain Names up to 15 July 2019.
- 5.4 On 15 June 2017, the Complainant sold its majority shares in the Respondent to Syncrosys (M) Sdn Bhd. The Complainant maintained the same registrant information (i.e. the Respondent) and administrative contact (i.e. of Mr. Kim Askjaer) for the Disputed Domain Names with a plan to transfer the Disputed Domain Names to a local proxy.
- 5.5 A Trademark Licensing Agreement was entered into between the Complainant and the Respondent some time in October 2017 ("**2017 Trademark Licensing Agreement**") which, *inter alia*, allows the Respondent a licence to use the FRiENDi Marks. The Respondent acknowledged that the Complainant is the legal and beneficial owner of the FRiENDi Marks and that it would not use, *inter alia*, a domain name which is substantially identical to the FRiENDi Marks without the prior written consent of the Complainant.
- 5.6 The Panel notes that it is unclear as to the status of the 2017 Trademark Licensing Agreement. There was an email from the Respondent to the Complainant on 26 January 2018 notifying that it had decided not to continue with the Trademark Licensing Agreement and that it would come up with a new brand. Thereafter, parties appeared to be negotiating for a transitional trademark licence agreement pending the Respondent's transition to a new brand. It appears that the Trademark Licensing Agreement came to a mutual end. There is no evidence from the documents provided that the transitional trademark licence was concluded. Based on the correspondence furnished, the Respondent never disputed the request from the Complainant to transfer the registration and control of the Disputed Domain Names and had in fact agreed to effect the said transfer and control.

- 5.7 Before the Complainant could carry out its plan to transfer the Disputed Domain Names to a local proxy, the Respondent changed the administrative contact for the Disputed Domain Names without the Complainant's authorization in or around November 2017.
- 5.8 When the Complainant contacted the Respondent regarding the matter, the Respondent promised to effect the transfer of the Disputed Domain Names to the Complainant. However, to-date, the Respondent has not transferred the Disputed Domain Names to the Complainant despite repeated requests and follow up from the Complainant. As such, the Complainant now files a formal complaint with the Provider.
- 5.9 The Complainant contends that the Complaint is premised on the usage of the Disputed Domain Names because the Respondent had been continuing the use of the Disputed Domain Names in bad faith and continues to take unfair advantage of the Complainant's FRiENDi Marks.
- 5.10 The Respondent did not submit a Response to the Complaint. The Panel will discuss each of the elements in turn below.

6. Discussions And Findings

- 6.1 Rule 17 of the Rules requires the Panel 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 and principles of law which are applied in Malaysia.
- 6.2 Paragraph 5.2 of the Policy provides that the Complainant must establish **BOTH** the following elements in the Complaint:-
- (i) the Disputed 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 Disputed Domain Name in bad faith.
- 6.3 With regard to the second element above, the Complainant does not need to prove that both the registration and the usage of the Disputed Domain Names have been done in bad faith. It suffices for the Complainant to prove either one by virtue of the words 'and/or' in paragraph 5 (ii) of the Policy.

Identical or confusingly similar

- 6.4 There is no doubt that of the Complainant is the owner of the FRiENDi Marks. This is formally acknowledged by the Respondent in the Trademark Licensing Agreement.
- 6.5 The generic Top-Level Domain (gTLD) suffix ".com" and the country code Top-Level Domain (ccLTD) suffix ".my" can be disregarded under the confusing similarity test (See *Volkswagen Group Singapore Pte. Ltd. v Webmotion Design*, Case No.: rca/dndr/2003/01(int)). The verbal element of the FRiENDi Marks is clearly reproduced in all of the Disputed Domain Names. The Panel has no difficulty in finding that <friendi.com.my> and <friendi.my> are identical to the FRiENDi Marks.

- 6.6 In respect of <friendimobile.com.my> and <friendimobile.my>, the disputed domain names comprise of two words: "friendi" and "mobile". The dominant feature of the disputed domains name is "friendi" which is entirely identical to the FRIENDI Mark and the word "mobile" is a generic term and only a descriptive suffix.
- 6.7 Accordingly, the Panel finds that the first element under Paragraph 5.2(i) of the Policy has been met by the Complainant.

Bad faith

- 6.8 The Panel notes that Paragraph 6.1 of the Policy provides examples of bad faith with respect to registration or use of a domain name. As the word "may" is employed in Paragraph 6.1 of the Policy, the Panel considers that the examples set out therein are not exhaustive of all the circumstances that can amount to evidence of bad faith.
- 6.9 The Panel further notes that the Respondent may rebut allegations of bad faith in the registration or use of a domain name by showing, amongst others, that it has rights and legitimate interests in the Disputed Domain Names. The failure of the Respondent to respond 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 Disputed Domain Names or that it has acquired any trade mark right in the same (See *Budget Rent A Car System Inc v Budget-Rent-A-Car Sdn Bhd* Case No. rca/dndr/2008/15).
- 6.10 On the evidence produced by the Complainant, the Panel is satisfied that the Respondent has used the Disputed Domain Names in bad faith. Though the Respondent has not furnished any Response, the Panel found ample evidence from the manner the Respondent conducted itself in respect of the use of the Disputed Domain Names that support the finding of bad faith:-
- (i) Based on the Memorandum of Association of Connect Mena Limited (Tab 9) and the Investment & Shareholders Agreement for Ceres Telecom Sdn. Bhd. (the Respondent)(Tab 10) dated 19 June 2012, the Panel finds that the Respondent was originally owned and controlled the Complainant some time in June 2012;
 - (ii) The Disputed Domain Names were registered on 10 July 2012. The Complainant had control over the Disputed Domain Names accounts and the Complainant had arranged to make payments for the Disputed Domain Names over the years with the most recent payment to renew the domain name registration up to 15 July 2019 (Tab 13);
 - (iii) Pursuant to Schedule 2 of the Trademark Licensing Agreement, the definition of 'Marks' included the FRiENDi Marks and the Disputed Domain Names. Based on the un-redacted parts of the Trademark Licensing Agreement, the Respondent had acknowledged that the Complainant is the legal and beneficial owner of, inter alia, the Disputed Domain Names. Whilst the legal status of the Trademark Licensing Agreement remains unclear, there was an email from the Respondent to the Complainant on 26 January 2018 notifying that it had decided not to continue with the Trademark Licensing Agreement and that it

would come up with a new brand. It appears that the Trademark Licencing Agreement came to a mutual end. It is also clear that the Complainant had repeatedly requested for the transfer of the registration and control of the Disputed Domain Names. The Respondent had never disputed this request and had in fact agreed to effect the said transfer and control;

- (iv) The administrative contact as at 12 September 2017 is Mr. Kim Askjaer of the Complainant with the email address of <ka@friendigroup.com>. On 14 November 2017, the administrative contact details were changed to Feroze Abd Karim of the Respondent with an email address of <f.karim@friendimobile.my>. The change was effected by application letter(s) received from the Respondent without the knowledge and consent of the Complainant (Tab 15); and
- (v) Upon such changes in the administrative contact, the Complainant has notified the Respondent to 'rectify' the changes, i.e. to revert to the original administrative contact details and has given the Respondent notices that the Complainant has proprietary rights over the FRiENDi Marks and the related domain names as early as in January 2018 up until October 2018 (Tabs 14 - 17).

6.11 The Respondent has in various occasions responded and acknowledged that they would transfer the registration of the domain names to the Complainant:-

- (i) On 16 January 2018, there was an email from Mikkel Vinter (on behalf of the Complainant) to David Wan (on behalf of the Respondent) requesting the Respondent to rectify the change in the administrative contact details and to return control of the Disputed Domain Names to the Complainant (Tab 14);
- (ii) On 5 April 2018, there was an email from David Wan (on behalf of the Respondent) acknowledging the Respondent's unauthorised change in the administrative contact details, *'Rest assure if Ceres is not continuing the Marks everything will be returned to VMMEA as originally was. Again, apologise on the not informing earlier on the domain changes.'* (Tab 15); and
- (iii) On 6 August 2018, there was an email by Lee Yean Chin (on behalf of the Respondent) confirming that the Respondent's technical team was working on the domain transfer (Tab 16).

6.12 Based on the above, the Panel finds that the Respondent was well aware that Disputed Domain Names belong to the Complainant. The Respondent had notified the Complainant that it had decided not to continue with the Trademark Licensing Agreement and that it would come up with a new brand. The Respondent was also well aware that the Complainant had requested for the registration and control of the Disputed Domain Names to be transferred back to the Complainant. The Respondent never disputed the Complainant's right to such a request and had always promised to assist with the said transfer of the registration and control of the Disputed Domain Names back to the Complainant.

6.13 The Respondent's act in effecting the unauthorized change in the administrative contact details and the unexplained delay in transferring the registration and control of the Disputed Domain Names was clearly to deprive the Complainant's use and control over the Disputed Domain Names.

- 6.14 The Respondent's continued use of the Disputed Domain Names has prevented and is still preventing the Complainant from using the FRiENDi Marks. As such, any continued use of the Disputed Domain Names would be in bad faith (See *BDMG Pte Ltd v ACME POSITIVE Sdn Bhd*, Case No.: RCA/DNDR/2008/16).

7. Conclusion

- 7.1 In accordance with the findings under paragraph 2, 6 and 7 of the Policy and Rule 17 of the Rules, the Panel directs that the Disputed Domain Names <friendi.com.my> , <friendi.my>, <friendimobile.com.my> and <friendimobile.my> be transferred to the Complainant.



Chew Kherk Ying
Sole Panelist
Date: 3 September 2019