

ADMINISTRATIVE PANEL DECISION

In the matter of a Domain Name Dispute

Between

PUSPAKOM SDN BHD

(Complainant)

And

CERAH MAJU MARKETING

(Respondent)

AIAC Case No. AIAC/DNDR-759-2019

1. The Parties

- 1.1 The complainant is Puspakom Sdn Bhd (Company No.: 285985-U), a company incorporated under the laws of Malaysia and having its registered address at Level 5, Wisma DRB-HICOM, No. 2, Jalan Usahawan U1/8, Section U1, 40150 Shah Alam, Selangor Darul Ehsan, Malaysia (“Complainant”).
- 1.2 The respondent is Cerah Maju Marketing (Business Registration No.: 73210), a business incorporated under the laws of Malaysia, with an address at 1st Floor, Lot 5500, Block 225, KNLD (S/L 4, Ph 5) 4, Kuching City Mall Commercial Centre, 93250 Kuching, Sarawak (“Respondent”).

2. The Domain Name and Registrar

The domain name in dispute is <puspakom.my> (“the disputed domain name”). The Respondent registered the disputed domain name with the Malaysian Network Information Centre (“MYNIC”) on 9 August 2018.

3. Procedural History

- 3.1 Pursuant to MYNIC's (.my) Domain Name Dispute Resolution Policy ("the Policy"), the Complainant filed its Complaint with the Asian International Arbitration Centre ("the Centre") on 26 September 2019 both through e-mail and hard copy ("the Complaint").
- 3.2 Based on Rule 5.6 of the Rules of MYNIC's (.my) Domain Name Dispute Resolution Policy ("the Rules") and Paragraph 5 of the Supplemental Rules of the Centre ("the Supplemental Rules"), the formal date of commencement of this proceeding is 7 October 2019.
- 3.3 AIAC has duly notified the Respondent of the Complaint in accordance with the Rules. The Respondent was given 15 working days from the date of commencement to submit a Response to the Complaint. The Respondent was to file its Response by 29 October 2019.
- 3.4 There was no response filed by the Respondent.
- 3.5 In view of the Complainant having elected to have the Complaint determined by a single member panel, the Centre appointed Ms. Karen Abraham on 4 November 2019 as a panelist in the instant case ("the Panel"). The Panel has submitted a Declaration of Impartiality and Independence, as required by the Center pursuant to Rule 9.3 of the Rules.
- 3.6 Consequent upon the receipt of the Panel's Declaration of Impartiality and Independence, the Centre transmitted to the parties a Notification of Appointment of Panelist through a Notification letter dated 5 November 2019.

4. Factual Background

A. Complainant

- 4.1 The Complainant was incorporated on 6 January 1994 as Pusat Pemeriksaan Kendaraan Berkomputer Sdn Bhd and was known by its contracted form 'PusPaKom'. On 20 July 2007, due to the contracted form of its registered name being so strongly associated with its services and serving as an indication of origin, the Complainant formally changed their registered name

to that contracted form, thus being registered as Puspakom Sdn Bhd and has continued using that name to indicate the origin of their services since.

4.2 The Complainant is the registered proprietor of the following marks:



4.2.1 Trade mark no. 09019012 registered on 30 October 2009 for “PUSPAKOM” in the name of PUSPAKOM SDN BHD in respect of goods in Class 16;



4.2.2 Trade mark no. 09019014 registered on 30 October 2009 for “PUSPAKOM” in the name of PUSPAKOM SDN BHD in respect of goods in Class 25; and



4.2.3 Trade mark no. 09019013 registered on 30 October 2009 for “PUSPAKOM” in the name of PUSPAKOM SDN BHD in respect of services in Class 42.

4.2.4 The above marks are hereinafter collectively referred to as the Complainant’s Marks.

4.3 The Complainant’s name, Puspakom Sdn Bhd, wholly or partially incorporates the Complainant’s Marks.

4.4 The Complainant has also been the registered domain name owner of <puspakom.com.my> since 8 October 1999.

4.5 The Respondent registered the disputed domain name <puspakom.my> with MYNIC on 9 August 2018. The disputed domain name will expire on 9 August 2020.

5. Parties’ Contentions

A. Complainant

- 5.1 The Complainant contends that in light of its long-standing marks, the Complainant's rights in respect of the Complainant's Marks are established and undisputed, referring to the decision of *U Mobile Sdn Bhd v Web ID Management*, AIAC Case No. AIAC/D-602-2018 where the panel held 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*".
- 5.2 The Complainant contends that the disputed domain name is identical to the dominant part of the Complainant's "PUSPAKOM" trade marks, disregarding the gTLD and ccTLD. The disputed domain name also forms the registered company name of the Complainant.
- 5.3 The Complainant further asserts that the addition of gTLD or ccTLD (in this case ".my") is immaterial when determining the identity or similarity between trade marks and domain names, making reference to the decision of *Volkswagen Group Singapore Pte. Ltd. v Webmotion Design*, AIAC Case No. rca/dndr/2003/01 (int) where the panel held that "*inclusion of top level domain names, such as gTLD's and ccTLD's are a technical requirement which have no significance when determining the similarity of the domain name to the mark*".
- 5.4 The Complainant states that the Respondent registered the disputed domain name on 9th August 2018, almost nineteen years after the Complainant registered the disputed domain name, and almost after eleven years after the registration date of the Complainant's Marks. The Complainant states the Respondent has no right or legitimate interests in respect of the disputed domain name for the following reasons:-
- 5.4.1 The Respondent is neither affiliated with the Complainant in any way, nor was it authorized or licensed to use the Complainant's Marks or authorized to register any domain name incorporating the Complainant's Marks;
- 5.4.2 The Complainant had registered and used the Complainant's Marks and the "PUSPAKOM" trade name for many years prior to the registration of the disputed domain name;
- 5.4.3 There is no evidence whatsoever to suggest that the Respondent is commonly known by the "PUSPAKOM" trade name;

- 5.4.4 The Respondent does not offer any product or services under the name “PUSPAKOM”;
- 5.4.5 The Respondent has no trademark protecting that name;
- 5.4.6 The disputed domain name is identical with or so confusingly similar to the Complainant’s Marks and it is unlikely that the Respondent could be ignorant of this fact; and
- 5.4.7 The disputed domain name is being offered for sale, thus the Respondent cannot assert that it has made or is making any legitimate, non-commercial or fair use of the disputed domain name without intent for commercial gain or to deceive the public.
- 5.5 The Complainant further contends that there is no plausible reason which the Respondent could possibly claim that his usage of the disputed domain name can be anything other than trying to take advantage of the Complainant’s goodwill and reputation.
- 5.6 The Complainant states that the disputed domain name has been registered in bad faith by the Respondent as the Complainant contends that the disputed domain name resolves to a website with the header ‘*Domain Names For Sales [sic]*’ and includes the disputed domain name as one of the domain names for sale. The Respondent then links his email address for the purposes of ‘*further discussion*’, which is the same email address used to register the disputed domain name.
- 5.7 The Complainant contends that given the long-term use and popularity of the Complainant’s Marks, the Respondent knew or ought to have known of the Complainant’s well-known marks prior to registering.
- 5.8 The Complainant further contends that the Respondent’s knowledge of the Complainant’s Marks is imputed from the fact that the Respondent chose to also register other third party domain names and offer them for sale, showing a pattern of domain name abuse. The other domain names listed for sale also resolve to identical pages for the sale of domain names, including offering the disputed domain name for sale. The Complainant asserts that this clearly evinces a bad faith pattern of conduct to profit through registration of third party’s protected trade marks and domain names.

- 5.9 Specific reference is made by the Complainant to the case of *Facebook Inc. v Joey Lee and E-Web Solutions*, AIAC Case No. KLRCA/DNDR-382-2016 where the Panel had stated that “*the respondents are in a habit of registering many domain names infringing rights of many parties*” in making a finding of bad faith. The Complainant also refers to a previous decision of *Apple Inc. v Eppies Internet*, AIAC Case No. rca/dndr/2007/12 where the Panel held that the Respondent’s pattern of conduct of registering domain names utilizing well-known marks in which the Respondent has no rights or legitimate interests falls within the meaning of “*among others*” set out in Paragraph 6 of the Policy and provides basis to lead to a finding of bad faith. The Complainant states that the Respondent’s conduct is a deliberate attempt to stifle the Complainant’s ability to register its domain names and expand its online presence, breaching the representations under Paragraph 2 of the Policy.
- 5.10 Further or in the alternative, the Complainant also contends that the Respondent has a duty under Paragraph 2.3 of the Policy to ensure that their registration and any subsequent renewal of the domain name does not infringe the rights of any third party as the Respondent could easily have discovered the existence of both the Complainant and the use and fame of the Complainant’s Marks. The Complainant makes specific reference to the decision of *Millenium & Copthorne International Limited v Everise Sales Sdn Bhd*, AIAC Case No. KLRCA/D/PFC-568-2018 where the panel held that “*a finding of bad faith registration can indeed be confirmed by the specific circumstances of a respondent’s so-called “willful blindness”, even if the respondent did not specifically know of the complainant or of its trademark rights when it registered the disputed domain name.*”
- 5.11 Hence the Complainant states that there had never been any real intention by the Respondent to use the disputed domain name in a manner consistent with the Policy and Rules but the Defendant had in fact registered the disputed domain name purely to sell it back to the Complainant, or an unauthorized third party, at a profit while at the same time preventing the Complainant from using the disputed domain name.
- 4.14 In accordance with Paragraph 12(1)(i) of the Policy, the Complainant requests that the disputed domain name <puspakom.my> be transferred to the Complainant.

B. Respondent

The Respondent has not submitted any response under Rule 6 of the Rules.

6. Discussions and Findings

6.1 As provided by Rule 17.1 of the Rules, the Panel hereby gives its decision based on the documents and evidence submitted by the Parties, the Policy and the Rules as well as any other relevant rule and principle of law applied in Malaysia.

6.2 Paragraph 5.2 of the Policy provides that the Complainant must establish the following two 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.

Respondent's default in submitting a response

6.3 The Panel reiterates that the Respondent has not submitted any response or evidence in this matter.

6.4 In *China Vanke Co. Ltd v Evergrande Construction (M) Sdn Bhd*, *AIAC Case No. AIAC/DNDR-709-2019*, based on the contemporaneous documents produced by the complainant and the respondent's silence, the panel accepted as true all factual contentions of the complainant. Similarly, the Panel in *U Mobile Sdn Bhd v Web ID Management*, *AIAC Case No: AIAC/D-602-2018* held 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 complainant.

6.5 Therefore the Panel is guided by the above decisions and holds that in the absence of a response by the Respondent in this case, the Panel accepts the Complainant's contentions and evidence as true.

Whether the Complainant has rights to the Registered Trade Marks

- 6.6 The Complainant asserts that it is the owner of the Complainant's Marks in Malaysia. The Panel finds that the Complainant has adduced sufficient evidence to demonstrate that it is the registered proprietor of the Complainant's Marks in Malaysia.
- 6.7 The Complainant has provided evidence of its trademark registrations in Malaysia. Whilst the Certificates of Registration of the Complainant's Marks state that the registrations have expired on 30 October 2019, the Panel's own check of the Malaysian Intellectual Property Office ("MyIPO") online database shows that the registrations of the Complainant's Marks are valid and subsisting until 30 October 2029.
- 6.8 It is the finding of the Panel that based on the valid and subsisting registrations of the Complainant's Marks under the **Trade Marks Act 1976**, the Complainant has established its proprietary rights in respect of the Complainant's Marks: *U Mobile Sdn Bhd v Web ID Management, ALAC Case No: ALAC/D-602-2018*.

Whether the Disputed Domain Name is Identical or Confusingly Similar to the Registered Trade Marks in Question

- 6.9 In assessing the similarity between both the Complainant's Marks and the Respondent's disputed domain name, it is permissible to disregard the ".my" component of the disputed domain name, as the inclusion of gTLD and ccTLD is immaterial in determining whether the disputed domain name is identical or confusingly similar to a Complainant's trade mark: *Volkswagen Group Singapore Pte Ltd v Webmotion Design, ALAC Case No.: rca/dndr/2003/01 (int)*.
- 6.10 The disputed domain name <puspakom.my> incorporates a dominant and essential part of the Complainant's Marks, namely the word "PUSPAKOM", which is also the Complainant's registered company name and trade name. Thus the Panel finds that the disputed domain name is identical and/or confusingly similar to the Complainant's Marks: *U Mobile Sdn Bhd v Web ID Management, ALAC Case No: ALAC/D-602-2018* at para 6.2, page 5.

Whether the Respondent has Rights and Legitimate Interests in the Disputed Domain Name

- 6.11 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. In order to demonstrate that the Respondent does have the requisite rights or legitimate interest that would merit its entitlement to the disputed domain name, the Respondent must prove the following in accordance to Paragraph 7.2 of the Policy:
- (i) before the date of communication of the Complaint, it has used or made preparations to use the disputed domain name or a name corresponding to the disputed domain name in relation to a genuine offering of goods or services; or
 - (ii) it is commonly known by the disputed domain name even though it has acquired no trade mark or service mark rights in the same; or
 - (iii) it is using the disputed 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.
- 6.12 There has been no response by the Respondent in the matter and therefore, there is no assertion or evidence adduced to demonstrate any rights and legitimate interest on the part of the Respondent. In light of the Respondent's failure to offer any explanation and justification, the Panel finds that there is no evidence on record to demonstrate that the Respondent has any rights or legitimate interests in respect of the disputed domain name or that it has acquired any trade mark rights in the same.
- 6.13 Had the Respondent been legitimately interested in the disputed domain name, the Respondent would have at least attempted to defend its registration and/or use of the disputed domain name by filing a response to refute the Complainant's assertions and contentions. Accordingly, the Panel takes the view that the Complainant has adduced sufficient unchallenged evidence to show that the Respondent does not have the requisite rights or legitimate interest in the disputed domain name as described in Paragraph 7 of the Policy.

Whether the Respondent had Registered or Used the Disputed Domain Name in Bad Faith

6.14 Paragraph 6.1 of the Policy stipulates the evidence of bad faith registration and/or use of the domain name, which may include amongst others, the following circumstances:-

- (i) registration and/or use of the Domain Name 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
- (ii) registration and/or use of the domain name 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
- (iii) registration and/or use of the domain name to disrupt the business of the Complainant; or
- (iv) registration and/or use of the domain name for the purposes of and with the intention to attract or divert, for commercial gain, Internet users to:-
 - (a) the Respondent's web site;
 - (b) a web site of the Complainant's competitor; or
 - (c) 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.

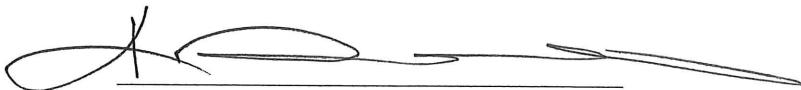
6.15 As for item (i), the Complainant asserted that the disputed domain name resolves to a website with the header '*Domain Names For Sales [sic]*' and includes the disputed domain name as one of the domain names for sale. The Complainant has produced evidence to show this attempt to offer the disputed domain name for sale by the Respondent or its representatives, along with several other ".my" domain names. The Respondent's conduct is clear evidence of its intention to exploit the Complainant's Marks for profit, which is in itself evidence of bad faith.

6.16 The Complainant's Marks were valid and subsisting at the time of the Respondent's registration of the disputed domain name. The Panel agrees with the Complainant's contention that the Complainant's Marks, especially the word "PUSPAKOM" is established and well-known throughout the country due to the service it provides as the main inspection center for commercial vehicles in Malaysia, and the Respondent would have been aware of the Complainant's existence prior to registering the disputed domain name. The Panel finds it very difficult to believe that it is pure coincidence that the Respondent registered the disputed domain name using the word "PUSPAKOM".

6.17 In view of all the evidence submitted by the Complainant, the facts and circumstances, and the Respondent's failure to respond or refute the Complainant's contentions, the Panel finds that the disputed domain name has been registered and used in bad faith.

7. Conclusion

7.1 Upon an evaluation and consideration of the circumstances and the evidence of the case, and in accordance with Policy, Rules and principles of law applies in Malaysia, the Panel orders for the registration of the disputed domain name <puspakom.my> to be transferred to the Complainant.



Karen Abraham

Sole Panelist

Dated: 25 November 2019