

Administrative Panel Decision

In the matter of AIAC/DNDR-807-2020

Between

Telekom Malaysia Berhad
[Complainant]

And
Derick NG/CA Merchant Services Sdn Bhd
[Respondent]

Case No. AIAC/DNDR-807-2020

GROUND OF DECISION

1. The Parties

The Complainant is Telekom Malaysia Berhad, represented by Lim Zhi Jian of Lee Hishamuddin Allen & Gledhill, Kuala Lumpur, Malaysia.

The Respondent is CA Merchant Services Sdn Bhd.

2. The Domain Name and the Registrar

The disputed domain name is www.streamyx.my (“the disputed domain name”) and the Registrar is the Malaysian Network Information Centre (“MYNIC”).

3. Procedural History

The Complainant submitted its Complaint dated 10 January 2020 with the Asian International Arbitration Centre (“AIAC”) pursuant to MYNIC’s (.my) Domain Name Dispute Resolution Policy (“the Policy”) and the Rules for MYNIC’s (my.) Domain Name Dispute Resolution Policy (“the Rules”) and the Supplemental Rules of AIAC (“the Supplemental Rules”) in respect of the disputed domain name.

The Respondent did not submit any response by the deadline of 18 February 2020.



An examination of the material confirms that all technical requirements for the initiation of this proceeding have been satisfied. Having verified that the Complaint satisfied the formal requirements, the proceedings formally commenced on 28 January 2020.

The Complainant having elected for a single member Panel, the Centre appointed Wong Jin Nee as the sole panellist in conformity with the Policy and the Rules. The Panellist has submitted a statement of Declaration of Impartiality and Independence as required by the Centre.

4. Factual Background

The Complainant

- 4.1 The Complainant, Telekom Malaysia Berhad, has been a leading telecommunications service provider in Malaysia for many years and one of the largest in South East Asia with a group operating revenue of RM12.09 billion for the year 2017. It has a wide business portfolio ranging from content production to hosting of online web portals to the provision of wireless and broadband services. The Complainant has a strong international and local business presence, winning numerous awards including “Telecom Service Provider of the Year” award during the 2017 Frost & Sullivan Malaysian Excellence Awards, “Malaysia’s leading ICT, BPO Provider” in Gartner market guide for year 2017, “Service Partner and Managed Service Provider of the Year by Cisco in 2017 and “Industry Excellence Award for Main Board Company in Trading and Services Category” for the 21st consecutive year during the National Annual Corporate Report Awards 2017.
- 4.2 The Complainant asserted that it was one of the pioneering companies in facilitating Malaysia’s entry into the Internet age with Streamyx, its broadband service introduced since 2001. The Complainant was awarded the Reader’s Digest Platinum award as the most trusted Internet Service Provider, when it received the highest number of votes from thousands of Reader’s Digest readers for its high-speed, reliability and co-effective broadband access.
- 4.3 The Complainant introduced the new 8Mbps bandwidth speed for Streamyx and Business Broadband packages in January 2013. In January 2014, the Complainant held “The Best Ever Hypp-Normous Deal” campaign, offering Streamyx customers the opportunity to upgrade their broadband speeds up to 20 times.
- 4.4 The Complainant is the registered proprietor of the trademark “STREAMYX” (in ordinary block letters as well as in different fonts and formats) and “STREAMYX”-formative marks covering a wide range of goods and services in Classes 9, 38 and 42 in Malaysia. A summary of the Complainant’s relevant trademark registrations in Malaysia as adduced by the Complainant in its complaint is set out below (“the STREAMYX Marks”):

Trademark	Registration No.	Class
STREAMYX	2012011191	9
STREAMYX	2017012771	9
<i>streamyx</i> <i>streamyx</i>  	07017799	38
STREAMYX	2012011192	38
STREAMYX	2017012772	38
STREAMYX	2017012772	42

4.5 It is obvious that the members of the trade and public have come to associate the STREAMYX Marks with the Complainant exclusively.

4.6 The Complainant has accordingly acquired a substantial goodwill and reputation in the STREAMYX Marks through its extensive and continuous use and promotion.

4.7 In light of the information provided and documents adduced by the Complainant to support its Complaint, the Panel is satisfied that the Complainant has established its rights and title as the registered proprietor and/or common law owner of the STREAMYX Marks in Malaysia in relation to a wide range of goods and services including those covered by the registrations in Classes 9, 38 and 42.

The Respondent

4.8 The Panel takes the view and position that the correct Respondent is CA Merchant Services Sdn Bhd (Co. Registration No. 200401002542 (641045-V)) being the registrant of the disputed domain name, not Derick Ng. The Respondent is a company incorporated under the laws of Malaysia with its registered address at 2986 (1st Floor), Jalan Sejahtera, Taman Selesa, Alma Bukit Mertajam, 14000 Pulau Pinang, Malaysia and registered the disputed domain name on 23 July 2015 [as per the Whois extract as shown in Annexure 3 of the Complainant's Complaint]. Derick Ng is, if any, a representative of the Respondent.

4.9 The Respondent entered into an agreement dated 1 July 2015 ("the said agreement") for the appointment of TM Authorised Dealer with Telekom Sales & Services Sdn Bhd ("TSSSB"), a subsidiary of the Complainant

appointing the Respondent to market, promote and sell various TM Products and Services (defined in the said agreement to mean the products and services owned and/or provided by TM as specified in Schedule 1) at its outlet. TM in the said agreement referred to the Complainant.

4.10 The Respondent had written an email dated 12 September 2018 attaching a letter dated 1 September 2018 stating that it would cease the business operation with effect from 15 September 2018.

4.11 TSSSB, in its letter dated 19 September 2018, accepted the termination of the said agreement by the Respondent with effect from 14 October 2018.

5. The Parties' Contentions

The Complainant

5.1 The Complainant contends that the registration of the disputed domain name should be transferred to the Complainant.

5.2 The Complainant relies on the adduced facts and evidence and contends that it has fulfilled the requisite elements of paragraph 5.2 of the Policy, in particular:

5.2.1 the disputed domain name is identical to and/or confusingly similar with the Complainant's trademarks to which the Complainant has rights; and

5.2.2 the Respondent has registered and used the disputed domain name in bad faith.

5.3 In support of these contentions, the Complainant asserts and maintains various points including the following:

5.3.1 The disputed domain name is identical or confusingly similar to a trademark which the Complainant has rights, being the registered proprietor, owner and/or beneficial owner of the STREAMYX Marks in various classes in Malaysia as outlined above.

5.3.2 The Complainant stated that the Respondent has wrongfully, illegally and/or unlawfully registered the disputed domain name which consists of the word "STREAMYX" with the country code TLD (.my). The disputed domain name is likely to mislead the public into believing that it belongs to or is related to the Complainant and/or associated with the Complainant's corporate group of companies. The Complainant further explained that the choice of the disputed domain name by the Respondent is not a mere coincidence but its modus operandi is

obviously to mislead the public and to take unfair advantage of the Complainant's substantial goodwill in the STREAMYX Marks.

- 5.3.3 The Complainant contended that the disputed domain name incorporating the mark "STREAMYX" and alluding to the Complainant's registrations as set out in Annexure 4 of the Complaint is identical and/or nearly resembling and/or is confusingly similar to the STREAMYX Marks and the public would likely be deceived and confused as to the origins of the goods and/or services provided by the Respondent. Accordingly, the Respondent ought not be allowed, in fact and in law, to register the disputed domain name.
- 5.3.4 The Complainant reiterated that it has used the STREAMYX Marks since 2001 and by virtue of its continuous and extensive use, the Complainant has acquired substantial goodwill in the STREAMYX Marks. Accordingly, the Complainant has prior rights in the STREAMYX Marks which preceded the registration of the disputed domain name by the Respondent.
- 5.3.5 The Complainant claimed that at all material times it has not authorised and/or consented to the Respondent's use of the STREAMYX Marks or for the Respondent to use or register the disputed domain name.
- 5.3.6 The purported registration of the disputed domain name is unlawful, illegal and/or mala fide on the part of the Respondent. The wrongful registration of the disputed domain name has infringed the Complainant's intellectual property rights and legal rights. In this respect, the disputed domain name in the name of the Respondent will cause confusion to the public who may be misrepresented by such unlawful registration that the Respondent is in some manner associated with the Complainant, which is contrary to reality.
- 5.3.7 The Complainant further stated that the Respondent's misrepresentation or erroneous claim via the disputed domain name damages the Complainant's business, goodwill and reputation and also amounts to false designation of origin and/or false description and/or dilution of the Complainant's house brands and trademarks.
- 5.3.8 The Respondent did not file any response to the Complainant's Complaint.

6. Discussions and Findings

- 6.1 Rule 17.1 of the Rules provides that the Panel will decide the proceeding based on the documents and evidence submitted by the Parties, the Policy and Rules as well as any other rules and principles of law which are applied in Malaysia. Accordingly, the Panel will proceed to decide based on the

documents and evidence adduced in accordance with the Rules, Supplemental Rules, Policy and principles of applicable law in Malaysia.

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

- (i) The disputed domain name is identical or confusingly similar to a trademark 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 The Panel will deal with each of the requirements of the Policy, namely as follows:

- (a) the disputed domain name is identical or confusingly similar to the STREAMYX Marks;
- (b) the Complainant has rights over the STREAMYX Marks; and
- (c) the Respondent has registered and/or used the disputed domain name in bad faith.

Identical or Confusingly Similar

6.4 The Panel finds that the Complainant has adduced significant and sufficient evidence to demonstrate that it has statutory and common law rights in the STREAMYX Marks. The Complainant has adduced evidence to show that it has registered the STREAMYX Marks in Malaysia for many years and averred that it has used the STREAMYX Marks since 2001. The Complainant's earliest registration for the STREAMYX Marks adduced in Annexure 4 was since 11 September 2007, at least 8 years prior to the registration of the disputed domain name by the Respondent.

6.5 The Panel finds that the disputed domain name, www.streamyx.my is identical to the STREAMYX Marks. This is so notwithstanding the presence of the suffix ".my" which should be disregarded (as it is a technical requirement of registration) when determining if the disputed domain name is identical or confusingly similar to the Complainant's STREAMYX Marks.

6.6 The Respondent did not make the effort to respond to offer any explanation or justification for choosing and adopting the word "Streamyx".

6.7 Based on the comparison of the disputed domain name with the STREAMYX Marks, the Panel considers the disputed domain name to be identical with the Complainant's STREAMYX Marks.

Complainant has rights over the STREAMYX Marks

6.8 Based on the information and documents submitted in the proceeding, including the MyIPO printouts attached to the Complaint and the summary set out in paragraph 4.4 above, the Panel is satisfied that the Complainant is the rightful owner of the registrations of the STREAMYX Marks in Malaysia. The Panel is also satisfied that these registrations are still valid and subsisting.

Bad Faith

6.9 Paragraph 6.1 of the Policy provides that the evidence of bad faith registration and/or use of the disputed domain name may include amongst others, the circumstances identified from (i) to (iv). The phrase “may include” clearly suggests that the circumstances identified in this paragraph 6.1 are not exhaustive and may extend to other circumstances not covered by this paragraph, as long as they are within the concept of “bad faith” registration and/or use.

6.10 The Complainant has contended that the choice of the word “STREAMYX” by the Respondent is not a mere coincidence. The Panel believes that the Respondent was clearly aware of the Complainant’s rights in the STREAMYX Marks, given that the Respondent was in a contractual relationship with TSSSB, a subsidiary of the Complainant, as an authorized dealer to market, promote and sell various TM Products and Services.

6.11 Further, Clause 17.2 of the said agreement expressly provided that the Respondent would recognize and acknowledge the validity and ownership of TSSSB as well as the Complainant’s name and trademarks and all other TSSSB and/or the Complainant’s registered or common law trademarks worldwide. Under Clause 17.2 of the said agreement, the Respondent had agreed not to register the Complainant’s name or any of its registered or common law trademarks.

6.12 By registering the disputed domain name on 23 July 2015, after signing the said agreement dated 1 July 2015, the Respondent was clearly in breach of the said provision in the said agreement. The adoption of the word “STREAMYX” in the disputed domain name by the Respondent could not have been a mere coincidence but was with the intent to take advantage of the goodwill and reputation of the Complainant in the

STREAMYX Marks or to mislead the trade and public into thinking that some form of business connection exists between the parties. In any event, the Respondent's relationship with the Complainant pursuant to the said agreement had been duly terminated with effect from 14 October 2018.

- 6.22 Based on all the evidence submitted by the Complainant, the facts and circumstances of the case coupled with the Respondent's lack of response, the Panel finds that the disputed domain name has been registered and/or used in bad faith.

Rights and Legitimate Interests

- 6.9 Paragraph 7 of the Policy provides that in order for the Respondent to rebut the allegation that the disputed domain name was registered and has been used in bad faith, the Respondent may prove that it has rights and legitimate interests in the disputed domain name. Paragraph 7.2 of the Policy identified several types of evidence that could be adduced by the Respondent to support its case and they include:

(a) before the date of the communication of the Complaint, the Respondent has used or made preparations to use the disputed domain name in relation to a genuine offering of goods or services; or

(b) the Respondent is commonly known by the disputed domain name; or

(c) the Respondent is using the disputed domain name for legitimate, non-commercial and/or fair purposes and have no intention of using the same for profits or to deceive the public.

- 6.10 The Respondent did not make any effort to provide any response to the Complaint by adducing any evidence to demonstrate its rights and legitimate interests in the disputed domain name. The Complainant on the other hand has adduced sufficient unchallenged evidence to show that the Respondent does not have the rights and legitimate interests in the disputed domain name. The Respondent's lack of right and legitimate interests in the disputed domain name is reaffirmed by the Complainant's registrations of the STREAMYX Marks in relation to various goods and services in Malaysia as well as the terms of the said

agreement. The Panel therefore finds the Respondent does not have any rights and legitimate interests in respect of the disputed domain name.

7. Conclusion

7.1 Based on all the facts and evidence adduced and upon the reasoning provided above, the Panel decides that:

- (a) the disputed domain name is identical to the “STREAMYX Marks” to which the Complainant has rights; and
- (b) the Respondent has registered and/or used the disputed domain name in bad faith.

7.2 Accordingly the Panel directs that the disputed domain name streamyx.my be transferred to the Complainant.



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Wong Jin Nee
Sole Panellist
Date: 10 March 2020